

EXPOSURE DRAFT

2016-2017

The Parliament of the
Commonwealth of Australia

HOUSE OF REPRESENTATIVES/THE SENATE

EXPOSURE DRAFT

Intellectual Property Laws Amendment Bill 2017

No. , 2017

(Industry, Innovation and Science)

**A Bill for an Act to amend legislation relating to
intellectual property, and for related purposes**

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A Bill for an Act to amend legislation relating to intellectual property, and for related purposes

The Parliament of Australia enacts:

1 Short title

This Act is the *Intellectual Property Laws Amendment Act 2017*.

2 Commencement

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

Commencement information		
Column 1	Column 2	Column 3
Provisions	Commencement	Date/Details
1. Sections 1 to 3 and anything in this Act not elsewhere covered by this table	The day this Act receives the Royal Assent.	
2. Schedule 1, Parts 1 and 2	A single day to be fixed by Proclamation. However, if the provisions do not commence within the period of 12 months beginning on the day this Act receives the Royal Assent, they commence on the day after the end of that period.	
3. Schedule 1, Part 3	Immediately after the commencement of the provisions covered by table item 2.	
4. Schedule 1, Parts 4 to 15	At the same time as the provisions covered by table item 2.	
5. Schedule 1, Parts 16 and 17	Immediately after the commencement of the provisions covered by table item 3.	

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Commencement information		
Column 1	Column 2	Column 3
Provisions	Commencement	Date/Details
6. Schedule 1, Part 18	The day after this Act receives the Royal Assent.	
7. Schedule 1, Part 19	At the same time as the provisions covered by table item 2.	
8. Schedule 1, Part 20	The day after this Act receives the Royal Assent.	
9. Schedule 1, Part 21	Immediately after the commencement of the provisions covered by table item 5.	
10. Schedule 1, Parts 22 and 23	The day after this Act receives the Royal Assent.	
1	Note:	This table relates only to the provisions of this Act as originally enacted. It will not be amended to deal with any later amendments of this Act.
2		
3		
4	(2)	Any information in column 3 of the table is not part of this Act.
5		Information may be inserted in this column, or information in it
6		may be edited, in any published version of this Act.
7	3 Schedules	
8		Legislation that is specified in a Schedule to this Act is amended or
9		repealed as set out in the applicable items in the Schedule
10		concerned, and any other item in a Schedule to this Act has effect
11		according to its terms.

Schedule 1—Amendments

Part 1—Renewals and terminology

Division 1—Amendments

Designs Act 2003

1 Subsection 47(2)

Omit “after the filing date of the design application in which the design was first disclosed”.

2 Subsection 47(3)

Omit “is in the form”, substitute “satisfies the requirements”.

3 At the end of section 47

Add:

(4) To avoid doubt, if:

(a) the registered owner of a registered design applies for renewal of the registration of the design; and

(b) the application is made within the period prescribed for the purposes of subsection (2) and the application satisfies the requirements prescribed for the purposes of subsection (3); and

(c) the Registrar renews the registration of the design; and

(d) the renewal occurs after the end of the period mentioned in paragraph 46(1)(a);

then the registration of the design does not cease during the period beginning on the day after the end of the period mentioned in paragraph 46(1)(a) and ending on the day the renewal occurs.

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Schedule 1 Amendments

Part 1 Renewals and terminology

Patents Act 1990

4 Paragraph 142(2)(d)

Omit “continuation fee for the application”, substitute “continuation fee (if applicable) for the application, in relation to an anniversary of the date that would be the date of the patent if a patent had been granted on the application,”.

5 After subsection 142(2)

Insert:

(2A) If a complete application for a standard patent lapses because of paragraph (2)(d), the application lapses at the end of the anniversary concerned.

6 Section 143

Before “A”, insert “(1)”.

7 Paragraph 143(a)

Omit “renewal fee for the patent”, substitute “renewal fee (if applicable) for the patent, in relation to an anniversary of the date of the patent,”.

8 At the end of section 143

Add:

(2) If a standard patent ceases because of paragraph (1)(a), the patent ceases at the end of the anniversary concerned.

9 Section 143A

Before “An”, insert “(1)”.

10 Paragraph 143A(d)

Omit “renewal fee for the patent”, substitute “renewal fee (if applicable) for the patent, in relation to an anniversary of the date of the patent,”.

11 At the end of section 143A

Add:

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Amendments **Schedule 1**
Renewals and terminology **Part 1**

- 1 (2) If an innovation patent ceases because of paragraph (1)(d), the
2 patent ceases at the end of the anniversary concerned.

3 ***Plant Breeder's Rights Act 1994***

4 **12 Subsection 22(4)**

5 Omit “ceases”, substitute “ends”.

6 **13 At the end of subsection 22(4)**

7 Add:

8 Note: PBR in a plant variety ends, for example, if the PBR is revoked under
9 section 50 or if the PBR ceases under subsection 51(2).

10 **14 Section 30 (heading)**

11 Repeal the heading, substitute:

12 **30 Acceptance or refusal of applications**

13 **15 Subsections 30(1) and (3)**

14 Omit “reject”, substitute “refuse”.

15 **16 Subsection 30(5)**

16 Omit “to reject”, substitute “to refuse”.

17 **17 Paragraphs 30(5)(a) and (b)**

18 Omit “rejection” (wherever occurring), substitute “refusal”.

19 **18 Subsection 30(5) (note)**

20 Omit “reject”, substitute “refuse”.

21 **19 Section 51 (heading)**

22 Repeal the heading, substitute:

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Schedule 1 Amendments

Part 1 Renewals and terminology

51 Ceasing of PBR

20 Subsection 51(2)

Omit “annual fee for the renewal of the right by the last day for payment of that fee, the holder is taken to have surrendered the right”, substitute “renewal fee for the PBR, in relation to an anniversary of the day of grant of the PBR, within the prescribed period, the PBR ceases. The PBR ceases at the end of that anniversary”.

21 Paragraphs 51(3)(a) and (b)

Omit “surrender”, substitute “cessation”.

22 Section 52

Repeal the section, substitute:

52 Revocation on surrender of PBR

- (1) The holder of PBR in a plant variety may, at any time, offer to surrender that right. The offer must be in the approved form and be made to the Registrar.
- (2) The Registrar may accept the offer, revoke that right and amend the Register accordingly. The revocation takes effect on the day it is made.
- (3) If relevant proceedings in relation to the PBR in the plant variety are pending, the Registrar must not accept the offer to surrender that right unless:
 - (a) the court or AAT consents; or
 - (b) all the parties to the proceedings consent.
- (4) If a licence under section 19 is in force in relation to the plant variety, the Registrar must not accept the offer to surrender that right.
- (5) If the Registrar decides not to revoke that right, the Registrar must notify the holder of that right of the decision and of the reasons for the decision.

Note: A decision under this section to revoke, or not to revoke, that right is reviewable by the AAT under section 77.

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Amendments **Schedule 1**
Renewals and terminology **Part 1**

1 **23 Subparagraph 77(1)(b)(v)**

2 Omit “reject”, substitute “refuse”.

3 **24 At the end of paragraph 77(1)(b)**

4 Add:

5 (xvii) under section 52 to revoke, or not to revoke, PBR in a
6 plant variety; or

7 ***Trade Marks Act 1995***

8 **25 Readers guide (Summary of this Act)**

9 After “amended,”, insert “revoked,”.

10 **26 Readers guide (Appendix)**

11 Omit “rejecting it (see section 31)”, substitute “refusing it (see
12 section 31)”.

13 **27 Readers guide (Appendix)**

14 Omit “opportunity to be heard before an application is rejected”,
15 substitute “opportunity to be heard before an application is refused”.

16 **28 Readers guide (Appendix)**

17 Omit “**Rejection**”, substitute “**Refusal**”.

18 **29 Readers guide (Appendix)**

19 Omit “The Registrar will reject an application”, substitute “The
20 Registrar will refuse an application”.

21 **30 Paragraph 11(1)(a)**

22 Omit “rejected”, substitute “refused”.

23 **31 Paragraph 31(b)**

24 Omit “rejecting”, substitute “refusing”.

25 **32 Section 33 (heading)**

26 Repeal the heading, substitute:

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Schedule 1 Amendments

Part 1 Renewals and terminology

1 **33 Application accepted or refused**

2 **33 Paragraph 33(1)(b)**

3 Omit “rejecting”, substitute “refusing”.

4 **34 Paragraph 33(3)(b)**

5 Omit “rejecting”, substitute “refusing”.

6 **35 Subsections 33(3) and (4)**

7 Omit “reject”, substitute “refuse”.

8 **36 Paragraph 35(b)**

9 Omit “reject”, substitute “refuse”.

10 **37 Division 2 of Part 4 (heading)**

11 Repeal the heading, substitute:

12 **Division 2—Grounds for refusing an application**

13 **38 Subsections 39(1) and (2)**

14 Omit “rejected”, substitute “refused”.

15 **39 Section 40**

16 Omit “rejected”, substitute “refused”.

17 **40 Subsection 41(1)**

18 Omit “rejected”, substitute “refused”.

19 **41 Sections 42 and 43**

20 Omit “rejected”, substitute “refused”.

21 **42 Subsection 44(1)**

22 Omit “rejected”, substitute “refused”.

23 **43 Subsection 44(1) (note 4)**

24 Omit “rejected”, substitute “refused”.

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Amendments **Schedule 1**
Renewals and terminology **Part 1**

1 **44 Subsection 44(2)**

2 Omit “rejected”, substitute “refused”.

3 **45 Subsection 44(2) (note 4)**

4 Omit “rejected”, substitute “refused”.

5 **46 Subsection 44(4)**

6 Omit “reject”, substitute “refuse”.

7 **47 Section 57 (heading)**

8 Repeal the heading, substitute:

9 **57 Registration may be opposed on same grounds as for refusal**

10 **48 Section 57**

11 Omit “rejected”, substitute “refused”.

12 **49 Subsection 58A(1) (note)**

13 Omit “rejection”, substitute “refusal”.

14 **50 Paragraph 63(2)(c)**

15 Omit “rejected”, substitute “refused”.

16 **51 Section 76**

17 Repeal the section.

18 **52 Subsection 84(1)**

19 Repeal the subsection, substitute:

- 20 (1) The registered owner of a trade mark may, by written notice to the
21 Registrar, offer to surrender the registration of the trade mark.

22 Note: For **registered owner** see section 6.

- 23 (1A) The Registrar must accept the offer, and cancel the registration of
24 the trade mark, in the circumstances prescribed by the regulations.

25 **53 Subsection 84C(5)**

26 Omit “rejecting”, substitute “refusing”.

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Schedule 1 Amendments

Part 1 Renewals and terminology

1 **54 Section 176 (heading)**

2 Repeal the heading, substitute:

3 **176 Acceptance or refusal of application**

4 **55 Paragraph 176(1)(b)**

5 Omit “rejecting”, substitute “refusing”.

6 **56 Subsection 176(1)**

7 Omit “reject”, substitute “refuse”.

8 **57 Subsection 176(1A)**

9 Omit “rejecting”, substitute “refusing”.

10 **58 Section 177 (heading)**

11 Repeal the heading, substitute:

12 **177 Additional ground for refusing an application or opposing**
13 **registration—certification trade mark not distinguishing**
14 **certified goods or services**

15 **59 Subsection 177(1)**

16 Omit “rejected” (wherever occurring), substitute “refused”.

17 **60 Subsection 177(1) (note 3)**

18 Omit “rejecting”, substitute “refusing”.

19 **61 Section 187 (heading)**

20 Repeal the heading, substitute:

21 **187 Additional grounds for refusing application for registration or**
22 **opposing registration**

23 **62 Section 187**

24 Omit “rejected” (wherever occurring), substitute “refused”.

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Amendments **Schedule 1**
Renewals and terminology **Part 1**

63 Section 187 (note)

Omit “rejecting”, substitute “refusing”.

Division 2—Application and transitional provisions

64 Designs

- (1) The amendments of subsections 47(2) and (3) of the *Designs Act 2003* made by this Part apply in relation to applications for renewal made on or after the commencement of this item.
- (2) Regulations in force for the purposes of subsection 47(3) of the *Designs Act 2003* immediately before the commencement of this item continue in force on and after that commencement for the purposes of that subsection (as amended by this Part).

65 Patents

The amendments of the *Patents Act 1990* made by this Part apply in relation to each anniversary occurring on or after the commencement of this item, being an anniversary in respect of which neither a continuation fee nor a renewal fee had been paid before that commencement.

66 Plant breeder’s rights

- (1) The amendments of section 30 of the *Plant Breeder’s Rights Act 1994* made by this Part apply in relation to:
 - (a) applications made on or after the commencement of this item; and
 - (b) applications made before the commencement of this item that were pending immediately before that commencement.
- (2) The amendments of subsection 51(2) of the *Plant Breeder’s Rights Act 1994* made by this Part apply in relation to each anniversary occurring on or after the commencement of this item, being an anniversary in respect of which the annual fee had not been paid before that commencement.
- (3) The amendments of paragraphs 51(3)(a) and (b) of the *Plant Breeder’s Rights Act 1994* made by this Part apply in relation to PBR that ceases on or after the commencement of this item.

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Schedule 1 Amendments

Part 1 Renewals and terminology

- 1 (4) The repeal and substitution of section 52 of the *Plant Breeder's Rights*
2 *Act 1994* made by this Part applies in relation to offers made on or after
3 the commencement of this item.

4 67 Trade marks

5 *Trade marks*

- 6 (1) The amendments of sections 11, 31, 33, 39, 40, 41, 42, 43, 44 and 63 of
7 the *Trade Marks Act 1995* made by this Part apply in relation to:
8 (a) applications for registration of a trade mark that are made on
9 or after the commencement of this item; and
10 (b) applications for registration of a trade mark that were made
11 before the commencement of this item and that had not been
12 decided by the Registrar immediately before that
13 commencement.
- 14 (2) For the purposes of paragraph (1)(b), any report referred to in section 31
15 of the *Trade Marks Act 1995* made before the commencement of this
16 item that set out the Registrar's belief that there were grounds for
17 rejecting an application, or any response made by the applicant before
18 that commencement, is taken on and after that commencement to be a
19 report or response in relation to grounds for refusing the application.
- 20 (3) The amendment of section 35 of the *Trade Marks Act 1995* made by
21 this Part applies in relation to decisions of the Registrar made on or
22 after the commencement of this item.
- 23 (4) The amendment of section 84 of the *Trade Marks Act 1995* made by
24 this Part applies in relation to offers made on or after the
25 commencement of this item.
- 26 (5) If:
27 (a) before the commencement of this item, a person made a
28 request under subsection 84(1) of the *Trade Marks Act 1995*
29 for the registration of a trade mark to be cancelled; and
30 (b) the request was pending immediately before that
31 commencement;
32 then on and after that commencement the request is taken to be an offer
33 to surrender the registration of the trade mark.
-

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Amendments **Schedule 1**
Renewals and terminology **Part 1**

1 (6) For the purposes of subitem (5), any notification referred to in
2 subsection 84(2) of the *Trade Marks Act 1995* given before the
3 commencement of this item in relation to the request, or any response
4 made before that commencement, is taken on and after that
5 commencement to be a notification or response in relation to an offer to
6 surrender the registration of the trade mark.

7 (7) The amendment of section 84C of the *Trade Marks Act 1995* made by
8 this Part applies in relation to:
9 (a) a revocation of acceptance of an application, where the
10 revocation occurs on or after the commencement of this item;
11 and
12 (b) a revocation of acceptance of an application, where the
13 revocation occurred before the commencement of this item
14 and where, after that revocation, no decision in relation to the
15 application had been made by the Registrar immediately
16 before that commencement.

Certification trade marks

17
18 (8) The amendments of sections 176 and 177 of the *Trade Marks Act 1995*
19 made by this Part apply in relation to:
20 (a) applications for registration of a certification trade mark that
21 are made on or after the commencement of this item; and
22 (b) applications for registration of a certification trade mark that
23 were made before the commencement of this item and that
24 had not been decided by the Registrar immediately before
25 that commencement.

26 (9) For the purposes of paragraph (8)(b), any report referred to in section 31
27 of the *Trade Marks Act 1995* made before the commencement of this
28 item that set out the Registrar's belief that there were grounds for
29 rejecting an application, or any response made by the applicant before
30 that commencement, is taken on and after that commencement to be a
31 report or response in relation to grounds for refusing the application.

Defensive trade marks

32
33 (10) The amendments of section 187 of the *Trade Marks Act 1995* made by
34 this Part apply in relation to:

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Schedule 1 Amendments

Part 1 Renewals and terminology

- 1 (a) applications for registration of a trade mark as a defensive
2 trade mark that are made on or after the commencement of
3 this item; and
4 (b) applications for registration of a trade mark as a defensive
5 trade mark that were made before the commencement of this
6 item and that had not been decided by the Registrar
7 immediately before that commencement.
- 8 (11) For the purposes of paragraph (10)(b), any report referred to in
9 section 31 of the *Trade Marks Act 1995* made before the
10 commencement of this item that set out the Registrar's belief that there
11 were grounds for rejecting an application, or any response made by the
12 applicant before that commencement, is taken on and after that
13 commencement to be a report or response in relation to grounds for
14 refusing the application.

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Amendments **Schedule 1**
Examination, re-examination and reconsideration **Part 2**

Part 2—Examination, re-examination and reconsideration

Division 1—Amendments

Designs Act 2003

68 Section 5 (definition of *examination*)

Omit “65”, substitute “63”.

69 Section 5

Insert:

re-examination, in relation to a design, means re-examination of the design under section 68A.

70 Section 5 (definition of *relevant parties*)

Repeal the definition, substitute:

relevant parties, in relation to the examination or re-examination of a design under Chapter 5, means:

- (a) the registered owner of the design; and
- (b) if a person requested the examination or re-examination—that person; and
- (c) each person who is entered on the Register as having an interest in the design.

71 Section 9

After “in examining”, insert “or re-examining”.

72 After subsection 48(1)

Insert:

(1A) The registration of a design ceases if:

- (a) the Registrar gives the registered owner of the design one or more notifications under subsection 68E(1); and

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Schedule 1 Amendments

Part 2 Examination, re-examination and reconsideration

- 1 (b) at the end of the prescribed period in relation to the latest
2 notification, the registered owner has not filed a request
3 under paragraph 68E(2)(c); and
4 (c) at the end of that period, the Registrar remains satisfied that a
5 ground for revocation of the registration of the design has
6 been made out; and
7 (d) at the end of that period, no relevant proceedings in relation
8 to the registered design are pending.
9 The registration of the design ceases at the end of that period.

73 Subsection 48(4)

After “subsection (1)”, insert “or (1A)”.

74 Chapter 5 (heading)

Repeal the heading, substitute:

Chapter 5—Examination and re-examination of designs

75 Section 62

After “with the examination”, insert “or re-examination”.

76 Section 62

Omit:

Designs may be examined after registration on the request of any person or on the Registrar’s initiative.

substitute:

A design may be examined after registration on the request of any person, on the Registrar’s initiative or upon a court order.

After a certificate of examination has been issued under Part 3 in relation to a design, the design may be re-examined on the request of any person, on the Registrar’s initiative or upon a court order.

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Amendments **Schedule 1**
Examination, re-examination and reconsideration **Part 2**

1 **77 Section 62**

2 After “In examining”, insert “or re-examining”.

3 **78 Part 2 of Chapter 5 (heading)**

4 Repeal the heading, substitute:

5 **Part 2—When examination is to be conducted**

6 **79 After subsection 63(2)**

7 Insert:

8 (2A) Subsections (1) and (2) do not apply in relation to a registered
9 design if a certificate of examination has been issued under Part 3
10 in relation to the design.

11 Note: A re-examination of the registered design may occur under Part 3A.

12 **80 Part 3 of Chapter 5 (heading)**

13 Repeal the heading, substitute:

14 **Part 3—How examination is to be conducted**

15 **81 After Part 3 of Chapter 5**

16 Insert:

17 **Part 3A—Re-examination**

18
19 **68A Re-examination of registered design after issue of certificate of**
20 **examination**

21 *Registrar’s own initiative*

22 (1) The Registrar may, on his or her own initiative, re-examine a
23 registered design if a certificate of examination has been issued
24 under Part 3 in relation to the design.

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Schedule 1 Amendments

Part 2 Examination, re-examination and reconsideration

Request or court order for re-examination

- (2) The Registrar must re-examine a registered design if:
- (a) a certificate of examination has been issued under Part 3 in relation to the design; and
 - (b) any person requests that the Registrar re-examine the design or a court orders that the Registrar re-examine the design.

No re-examination if relevant proceedings pending

- (3) If relevant proceedings in relation to a registered design are pending, the Registrar must not re-examine the registered design unless a court orders that the Registrar re-examine the registered design.
- (4) If:
 - (a) the Registrar has started to re-examine a registered design; and
 - (b) relevant proceedings in relation to the registered design are started;the Registrar must not continue to re-examine the registered design (including considering a request for amendments under section 68E) unless a court orders that the Registrar continue to re-examine the registered design.

68B Requirements for request for re-examination of registered design

A request by a person that the Registrar re-examine a registered design must satisfy any requirements prescribed by the regulations.

68C What Registrar must do in re-examining registered design

- (1) If the Registrar re-examines a registered design, the Registrar must consider whether a ground for revocation, of the registration of the design, under subsection (2) exists.
- (2) The following are grounds for revocation of the registration of a registered design for the purposes of this Part:
 - (a) the design is not a registrable design;
 - (b) any other ground prescribed by the regulations.

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Amendments **Schedule 1**
Examination, re-examination and reconsideration **Part 2**

68D No ground for revocation exists

Re-examination other than upon request

- (1) If the Registrar is satisfied, in the course of re-examining a registered design (except at the request of a person), that no ground for revocation of the registration of the design has been made out, the Registrar must:
- (a) make a determination to that effect; and
 - (b) notify the relevant parties of the determination.

Re-examination upon request

- (2) If the Registrar is satisfied, in the course of re-examining a registered design at the request of a person, that no ground for revocation of the registration of the design has been made out, the Registrar must notify the relevant parties to that effect.
- (3) A relevant party may file a statement, within the prescribed period, disputing the finding in a notification under subsection (2).
- (4) The Registrar may give a copy of the statement to each other relevant party.
- (5) If:
- (a) no statement is filed under subsection (3); or
 - (b) both:
 - (i) a statement is filed under subsection (3); and
 - (ii) the Registrar, after taking the statement into account and giving the relevant parties a reasonable opportunity to be heard, remains satisfied that no ground for revocation of the registration of the design has been made out;
- the Registrar must:
- (c) determine that the Registrar is satisfied that no ground for revocation of the registration of the design has been made out; and
 - (d) notify the relevant parties of the determination.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 2 Examination, re-examination and reconsideration

1 *Appeal*

- 2 (6) An appeal lies to the Federal Court or the Federal Circuit Court
3 against a determination of the Registrar under subsection (1) or (5).

4 **68E Ground for revocation exists**

- 5 (1) If the Registrar is satisfied, in the course of re-examining a
6 registered design, that a ground for revocation of the registration of
7 the design has been made out, the Registrar must notify the
8 relevant parties to that effect.
- 9 (2) The registered owner of the design may then do one or more of the
10 following:
11 (a) file a statement disputing the ground for revocation;
12 (b) request that the Registrar amend the Register;
13 (c) file a request for a hearing.

14 *Statement disputing the ground for revocation*

- 15 (3) If the registered owner files a statement disputing the ground for
16 revocation, the Registrar must reconsider whether the ground for
17 revocation exists, taking into account the statement. If, after that
18 reconsideration, the Registrar remains satisfied that the ground for
19 revocation exists, the Registrar may notify, and seek further
20 information from, the registered owner.

21 *Request for amendment of Register*

- 22 (4) A request under paragraph (2)(b) must be made in accordance with
23 the regulations.
- 24 (5) The Registrar must consider and deal with the request in the
25 manner prescribed by the regulations.
- 26 (6) An amendment must not be such as to:
27 (a) increase the scope of the design registration; or
28 (b) alter the scope of the registration by the inclusion of matter
29 that was not in substance disclosed in the original design
30 application, representations or other documents.

EXPOSURE DRAFT

Amendments **Schedule 1**
Examination, re-examination and reconsideration **Part 2**

- 1 (7) If the Registrar is satisfied that the ground for revocation would not
2 be removed if the Register were amended as proposed in the
3 request by the registered owner of the design, the Registrar may
4 notify each other relevant party (if any) of the details of the
5 proposed amendments.

6 **68F Amendment of Register**

- 7 (1) If:
8 (a) the Registrar, in the course of re-examining a registered
9 design, gives the relevant parties a notification under
10 subsection 68E(1); and
11 (b) the registration of the design has not ceased under
12 subsection 48(1A); and
13 (c) the Registrar is satisfied that the ground for revocation would
14 be removed if the Register were amended as proposed in a
15 request made under paragraph 68E(2)(b) by the registered
16 owner of the design;
17 the Registrar must notify each other relevant party (if any) of the
18 details of the proposed amendments.
- 19 (2) If, after giving the relevant parties a reasonable opportunity to be
20 heard, the Registrar remains satisfied as mentioned in
21 paragraph (1)(c), the Registrar must:
22 (a) record on the Register those amendments; and
23 (b) notify the relevant parties of those amendments.
- 24 (3) An appeal lies to the Federal Court or the Federal Circuit Court
25 against a decision of the Registrar under paragraph (2)(a).

26 **68G Revocation of registration**

27 *Registered owner requests a hearing*

- 28 (1) If:
29 (a) the Registrar, in the course of re-examining a registered
30 design, gives the registered owner of the design a notification
31 under subsection 68E(1); and
32 (b) before the end of the prescribed period, the registered owner
33 of the design files a request under paragraph 68E(2)(c); and
-

EXPOSURE DRAFT

Schedule 1 Amendments

Part 2 Examination, re-examination and reconsideration

- 1 (c) after giving the relevant parties a reasonable opportunity to
2 be heard, the Registrar is satisfied that the ground for
3 revocation has been made out;
4 the Registrar must:
5 (d) notify the relevant parties that the registration of the design is
6 revoked; and
7 (e) make an entry in the Register under section 115.

8 *Registered owner requests amendment of the Register*

- 9 (2) If:
10 (a) the Registrar, in the course of re-examining a registered
11 design, gives the registered owner of the design a notification
12 under subsection 68E(1); and
13 (b) at the end of the prescribed period, the registered owner has
14 not filed a request under paragraph 68E(2)(c); and
15 (c) the registration of the design has not ceased under
16 subsection 48(1A); and
17 (d) the Registrar has, under subsection 68F(1), given notification
18 of proposed amendments of the Register; and
19 (e) after giving the relevant parties a reasonable opportunity to
20 be heard, the Registrar is satisfied that the ground for
21 revocation would not be removed if the Register were
22 amended as proposed;
23 the Registrar must:
24 (f) notify the relevant parties that the registration of the design is
25 revoked; and
26 (g) make an entry in the Register under section 115.

27 *Public notice*

- 28 (3) If, under this section, the Registrar revokes the registration of a
29 design, the Registrar must publish a notice, in accordance with
30 section 148A, stating that the registration of the design has been
31 revoked and that the design is taken never to have been registered.
32 The notice must include the details prescribed by the regulations.

EXPOSURE DRAFT

Amendments **Schedule 1**
Examination, re-examination and reconsideration **Part 2**

1 *Exception*

2 (4) The Registrar must not, under this section, revoke the registration
3 of a design while relevant proceedings in relation to that design are
4 pending.

5 *Appeal*

6 (5) An appeal lies to the Federal Court or the Federal Circuit Court
7 against a decision of the Registrar under this section to revoke the
8 registration of a design.

9 **82 At the end of subsection 69(1)**

10 Add “or a request under paragraph 68A(2)(b) that the design be
11 re-examined”.

12 **83 At the end of subsection 69(4)**

13 Add “or re-examine a design under Part 3A”.

14 **84 Paragraph 115(a)**

15 Omit “or 68”, substitute “, 68 or 68G”.

16 ***Patents Act 1990***

17 **85 After subsection 97(3)**

18 Insert:

19 (3AA) If under subsection (3) a court directs the Commissioner to
20 re-examine the complete specification, the court may also direct
21 the Commissioner to end the re-examination.

22 **86 At the end of subsection 97(3A)**

23 Add “The regulations may make provision in relation to when the
24 re-examination ends.”.

25 **87 Subsection 97(5)**

26 Repeal the subsection.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 2 Examination, re-examination and reconsideration

88 Section 98 (heading)

Repeal the heading, substitute:

98 Reports on re-examination

89 Section 98

Before “On”, insert “(1)”.

90 At the end of section 98

Add:

- (2) There may be more than one report under this section in relation to the re-examination of a complete specification.

Note 1: Since the applicant for the patent or patentee can, under section 99, file a statement disputing a report under this section, this may result in the Commissioner considering the statement and making another report under this section.

Note 2: A copy of a report under this section must be given to the applicant for the patent or patentee: see section 212.

91 Section 99

Repeal the section, substitute:

99 Statement by applicant or patentee

- (1) If, in a report under section 98, the Commissioner reports adversely on a complete specification, the applicant for the patent or patentee may, before the re-examination ends, file a statement disputing the whole or any part of the report.

- (2) The applicant for the patent or patentee may file a statement under this section whether or not the applicant or patentee also:

- (a) asks the Commissioner, under subsection 104(1), for leave to amend the complete specification; or
(b) files a statement of amendments in accordance with a direction under section 106 or 107.

92 Subsection 100A(2)

After “unless”, insert “the re-examination has ended and”.

EXPOSURE DRAFT

Amendments **Schedule 1**
Examination, re-examination and reconsideration **Part 2**

93 Subsection 101(2)

After “unless”, insert “the re-examination has ended and”.

94 At the end of subsection 101G(1A)

Add “The regulations may set out when the re-examination ends.”.

95 At the end of section 101G

Add:

- (5) There may be more than one report under this section in relation to the re-examination of a complete specification.

Note 1: Since the patentee can, under section 101H, file a statement disputing a report under this section, this may result in the Commissioner considering the statement and making another report under this section.

Note 2: A copy of a report under this section must be given to the patentee: see section 212.

96 Section 101H

Repeal the section, substitute:

101H Statement by patentee

- (1) If, in a report under section 101G, the Commissioner reports that a ground for the revocation of the patent has been made out, the patentee may, before the re-examination ends, file a statement disputing the whole or any part of the report.
- (2) The patentee may file a statement under this section whether or not the patentee also:
- (a) asks the Commissioner, under subsection 104(1), for leave to amend the complete specification; or
 - (b) files a statement of amendments in accordance with a direction under section 106.

97 Subsection 101J(3)

After “unless”, insert “the re-examination has ended and”.

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Schedule 1 Amendments

Part 2 Examination, re-examination and reconsideration

98 After subsection 101K(1)

Insert:

(1A) If under subsection (1) a court directs the Commissioner to re-examine the complete specification, the court may also direct the Commissioner to end the re-examination.

99 Subsection 101K(3)

Repeal the subsection, substitute:

(3) If an opposition, under Part 3, to an innovation patent is pending, the Commissioner must not re-examine the complete specification relating to the patent.

100 Section 101L

Omit “under paragraph 101G(2)(b)”, substitute “under section 101G”.

Plant Breeder’s Rights Act 1994

101 Subsection 3(1)

Insert:

relevant proceedings, in relation to PBR in a plant variety, means proceedings in a court or in the AAT relating to:

- (a) the grant of the PBR; or
- (b) the infringement of the PBR; or
- (c) a decision to revoke, or not to revoke, the PBR.

102 Paragraph 37(1)(c)

Omit “revocation”, substitute “re-examination”.

103 Subparagraph 37(1)(d)(iii)

Omit “revocation”, substitute “re-examination”.

104 Paragraph 37(2B)(b)

Omit “revocation”, substitute “re-examination”.

EXPOSURE DRAFT

Amendments **Schedule 1**
Examination, re-examination and reconsideration **Part 2**

1 **105 Subsection 37(2B) (note)**

2 Omit “revocation”, substitute “re-examination”.

3 **106 Paragraph 37(5)(c)**

4 Omit “revocation”, substitute “re-examination”.

5 **107 Paragraph 48(2)(a)**

6 Omit “applying for a revocation of the rights under section 50”,
7 substitute “requesting a re-examination of the right under section 49A”.

8 **108 After Division 1 of Part 4**

9 Insert:

10 **Division 1A—Re-examination of Plant Breeder’s Right**

11 **49A Re-examination of PBR**

12 *Registrar’s own initiative*

- 13 (1) Subject to this section, if PBR in a plant variety has been granted,
14 the Registrar may, on his or her own initiative, re-examine the PBR
15 in the plant variety.

16 *Request for re-examination*

- 17 (2) Subject to this section, if:
18 (a) PBR in a plant variety has been granted; and
19 (b) a person whose interests are affected by the grant of the PBR
20 in the plant variety makes a request to the Registrar, in the
21 approved form, for re-examination of the PBR in the plant
22 variety; and
23 (c) the request is accompanied by the prescribed fee;
24 the Registrar must re-examine the PBR in the plant variety.

25 *No re-examination if relevant proceedings pending*

- 26 (3) If relevant proceedings in relation to the PBR in the plant variety
27 are pending, the Registrar must not re-examine the PBR in the
28 plant variety.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 2 Examination, re-examination and reconsideration

1 *When re-examination ends*

- 2 (4) The regulations may set out when a re-examination ends.

3 **49B Reports on re-examination**

4 *Report—re-examination on Registrar’s own initiative*

- 5 (1) If the Registrar re-examines the PBR in a plant variety on the
6 Registrar’s own initiative, the Registrar must:
- 7 (a) conduct the re-examination in relation to such of those
8 matters referred to in paragraph 44(1)(b) as the Registrar
9 considers appropriate; and
 - 10 (b) in relation to those matters, ascertain and report on whether
11 the Registrar is satisfied that facts existed that, if known
12 before the grant of that right, would have resulted in the
13 refusal to grant that right.

14 *Report—re-examination on request*

- 15 (2) If the Registrar re-examines the PBR in a plant variety on the
16 request of a person, the Registrar:
- 17 (a) must conduct the re-examination in relation to such of those
18 matters referred to in paragraph 44(1)(b) as the person
19 specifies in the request; and
 - 20 (b) may conduct the re-examination in relation to such other
21 matters referred to in paragraph 44(1)(b) as the Registrar
22 considers appropriate; and
 - 23 (c) in relation to the matters for which the re-examination is
24 conducted, must ascertain and report on whether the
25 Registrar is satisfied that facts existed that, if known before
26 the grant of that right, would have resulted in the refusal to
27 grant that right.

28 *Multiple reports*

- 29 (3) There may be more than one report under this section in relation to
30 the re-examination of the PBR in a plant variety.

31 Note: Since the grantee of the PBR can, under section 49C, give the
32 Registrar a statement disputing a report under this section, this may

EXPOSURE DRAFT

Amendments **Schedule 1**
Examination, re-examination and reconsideration **Part 2**

1 result in the Registrar considering the statement and making another
2 report under this section.

3 *Giving of copies of report*

- 4 (4) The Registrar must give a copy of a report under this section to:
5 (a) the grantee of the PBR in the plant variety; and
6 (b) if the re-examination was on the request of a person—that
7 person.

8 **49C Statement by grantee**

- 9 (1) If, in a report under section 49B, the Registrar reports adversely on
10 the PBR in a plant variety, the grantee of that right may, within the
11 prescribed period, give the Registrar a statement disputing the
12 whole or any part of the report.
- 13 (2) If the re-examination was on the request of a person, the Registrar
14 must give a copy of the statement to that person.

15 **109 Subsection 50(1)**

16 Repeal the subsection, substitute:

- 17 (1) Subject to this section, the Registrar must revoke PBR in a plant
18 variety if:
19 (a) after a re-examination, under Division 1A, of the PBR in the
20 plant variety has ended, the Registrar is satisfied that facts
21 existed that, if known before the grant of that right, would
22 have resulted in the refusal to grant that right; or
23 (b) the grantee has failed to pay a fee payable in respect of that
24 right (except the renewal fee referred to in subsection 51(2))
25 within 30 days after having been notified that the fee has
26 become payable.
- 27 (1A) Subject to this section, the Registrar must revoke a declaration that
28 a plant variety is essentially derived from another plant variety if:
29 (a) the Registrar becomes satisfied that facts existed that, if
30 known before the making of that declaration, would have
31 resulted in the refusal to make that declaration; or

EXPOSURE DRAFT

Schedule 1 Amendments

Part 2 Examination, re-examination and reconsideration

- 1 (b) the grantee has failed to pay a fee payable in respect of that
2 declaration within 30 days after having been notified that the
3 fee has become payable.

4 **110 Subsection 50(8)**

5 Repeal the subsection.

6 **111 Subsection 50(9A)**

7 Omit “(8) or”.

8 **112 Subsection 50(10)**

9 Omit “not to revoke PBR in a plant variety in accordance with an
10 application under subsection (8) or”.

11 **113 At the end of section 50 (before the note)**

12 Add:

13 (11) If:

- 14 (a) the Registrar decides not to revoke PBR in a plant variety
15 where paragraph (1)(a) applies; and
16 (b) a person had requested the re-examination concerned;
17 the Registrar must, within 7 days of making that decision, notify
18 that person of the decision and of the reasons for the decision.

19 **114 Subparagraph 77(1)(b)(viia)**

20 Omit “revocation”, substitute “re-examination”.

21 ***Trade Marks Act 1995***

22 **115 At the end of section 38**

23 Add:

24 *Revocation on Registrar’s own initiative*

- 25 (3) A revocation, under subsection (1), of the acceptance of the
26 application for registration of the trade mark may be on the
27 Registrar’s own initiative.

EXPOSURE DRAFT

Amendments **Schedule 1**
Examination, re-examination and reconsideration **Part 2**

Revocation on request

- (4) A person may request the Registrar to revoke, under subsection (1), the acceptance of the application for registration of the trade mark. The request:
- (a) must be in the approved form; and
 - (b) must set out the grounds on which the revocation is sought.
- (5) If the request complies with subsection (4), the Registrar must consider whether to revoke, under subsection (1), the acceptance.

Notification of decision

- (6) If, under subsection (1), the Registrar revokes the acceptance of the application for registration of the trade mark, the Registrar must notify the following persons of the revocation and the reasons for the revocation:
- (a) the applicant for registration of the trade mark;
 - (b) if the revocation was on the request of a person—that person.
- (7) If:
- (a) a person requests the Registrar to revoke the acceptance of the application for registration of the trade mark; and
 - (b) the Registrar refuses the request;
- the Registrar must notify the person of the refusal and the reasons for the refusal.

116 Subsection 84A(6)

Repeal the subsection, substitute:

Revocation on Registrar's own initiative

- (6) A revocation, under this section, of the registration of a trade mark may be on the Registrar's own initiative.

Revocation on request

- (7) A person may request the Registrar to revoke, under this section, the registration of a trade mark. The request:
- (a) must be in the approved form; and
 - (b) must set out the grounds on which the revocation is sought.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 2 Examination, re-examination and reconsideration

- 1 (8) If the request complies with subsection (7), the Registrar must
2 consider whether to revoke, under this section, the registration.

3 *Notification of decision*

- 4 (9) If, under this section, the Registrar revokes the registration of a
5 trade mark, the Registrar must notify the following persons of the
6 revocation and the reasons for the revocation:

- 7 (a) the registered owner of the trade mark;
8 (b) any person recorded under Part 11 as claiming a right in
9 respect of, or an interest in, the trade mark;
10 (c) if the revocation was on the request of a person—that person.

- 11 (10) If:

- 12 (a) a person requests the Registrar to revoke the registration of a
13 trade mark; and

- 14 (b) the Registrar refuses the request;

15 the Registrar must notify the person of the refusal and the reasons
16 for the refusal.

17 **Division 2—Application, saving and transitional**
18 **provisions**

19 **117 Designs**

- 20 (1) Part 3A of Chapter 5 of the *Designs Act 2003*, as inserted by this Part,
21 applies in relation to registered designs, whether the designs were
22 registered before, on or after the commencement of this item.

- 23 (2) Subsection 63(2A) of the *Designs Act 2003*, as inserted by this Part,
24 does not apply in relation to:

- 25 (a) a request or order referred to in subsection 63(1) of that Act
26 that was made before the commencement of this item; or
27 (b) an examination referred to in subsection 63(2) of that Act
28 that was initiated by the Registrar before that
29 commencement.

30 **118 Patents**

31 The amendments of the *Patents Act 1990* made by this Part apply in
32 relation to the following:

EXPOSURE DRAFT

Amendments **Schedule 1**

Examination, re-examination and reconsideration **Part 2**

- 1 (a) re-examinations instituted by the Commissioner, under
2 section 97 or 101G of that Act, on his or her own initiative on
3 or after the commencement of this item;
4 (b) re-examinations instituted by the Commissioner, under
5 section 97 or 101G of that Act, on or after the
6 commencement of this item as a result of a request under that
7 section made on or after that commencement;
8 (c) re-examinations instituted by the Commissioner, under
9 section 97 of that Act, on or after the commencement of this
10 item as a result of a direction by a court under
11 subsection 97(3) of that Act on or after that commencement;
12 (d) re-examinations instituted by the Commissioner, under Part 2
13 of Chapter 9A of that Act, on or after the commencement of
14 this item as a result of a direction by a court under
15 subsection 101K(1) of that Act on or after that
16 commencement.

17 **119 Plant breeder's rights**

- 18 (1) Division 1A of Part 4 of the *Plant Breeder's Rights Act 1994*, as
19 inserted by this Part, applies in relation to PBR in a plant variety
20 granted before, on or after the commencement of this item.
- 21 (2) Despite the amendments of section 50 of the *Plant Breeder's Rights Act*
22 *1994* made by this Part, that Act, as in force immediately before the
23 commencement of this item, continues to apply on and after that
24 commencement in relation to:
25 (a) a notice of a kind mentioned in paragraph 50(1)(b) of that
26 Act that was given before that commencement; or
27 (b) particulars given to a person under paragraph 50(4)(a) of that
28 Act before that commencement; or
29 (c) an application made under subsection 50(8) or (9) of that Act
30 before that commencement.
- 31 (3) The amendments made by this Part do not affect the validity of a
32 revocation made under subsection 50(1) of the *Plant Breeder's Rights*
33 *Act 1994* before the commencement of this item.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 2 Examination, re-examination and reconsideration

1 **120 Trade marks**

- 2 (1) The amendment of section 38 of the *Trade Marks Act 1995* made by
3 this Part applies in relation to acceptances that occur on or after the
4 commencement of this item, whether the applications for registration
5 were made before, on or after that commencement.
- 6 (2) The amendment of section 84A of the *Trade Marks Act 1995* made by
7 this Part applies in relation to trade marks that are registered by the
8 Registrar on or after the commencement of this item.

EXPOSURE DRAFT

Amendments **Schedule 1**
Extensions of time and protection of third parties **Part 3**

Part 3—Extensions of time and protection of third parties

Division 1—Amendments

Designs Act 2003

121 Section 5

Insert:

new day, in relation to a relevant act, has the meaning given by paragraph 137A(2)(b).

original day, in relation to a relevant act, means the day before the end of which the relevant act was originally required to be done.

relevant act means an action (other than a prescribed action) in relation to:

- (a) a registered design; or
- (b) an application for registration of a design; or
- (c) any proceedings under this Act (other than court proceedings).

122 Subsection 33(2)

Omit “section 137”, substitute “Part 5 of Chapter 11”.

123 Paragraph 136(1)(g)

Omit “137”, substitute “137A”.

124 Section 137 (heading)

Repeal the heading, substitute:

137 Extensions of time—errors/omissions by Registrar etc.

125 Subsection 137(1)

Omit “(1)”.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 3 Extensions of time and protection of third parties

126 Subsections 137(2) to (7)

Repeal the subsections.

127 After section 137

Insert:

137A Application for extensions of time

- (1) A person may apply to the Registrar for an extension of time for doing a relevant act that is required to be done within a certain time if the act is not, or cannot be, done within that time.

Note: For **relevant act** see section 5.

- (2) An application must:

- (a) be in accordance with the regulations; and
- (b) specify the day (the **new day**) before the end of which the applicant seeks to do the relevant act; and
- (c) set out the ground on which the application is made, which must be that the relevant act was not, or cannot be, done within the certain time:
 - (i) because of an error or omission by the applicant or the applicant's agent; or
 - (ii) because of circumstances beyond the applicant's control; and
- (d) include a statement justifying the extension sought; and
- (e) be made within the prescribed period; and
- (f) be accompanied by the prescribed fee.

137B Application for extension of time—extension sought is 3 months or less

- (1) If a person applies under section 137A for an extension of time for doing a relevant act and the period, beginning on the day after the original day and ending at the end of the new day, is 3 months or less, the Registrar must publish, in accordance with section 148A:
- (a) details of the relevant act; and
 - (b) the fact that an application has been made to extend the time for doing the relevant act; and

EXPOSURE DRAFT

Amendments **Schedule 1**
Extensions of time and protection of third parties **Part 3**

- 1 (c) the length of the extension sought; and
2 (d) such other details as the Registrar considers appropriate.

3 Note: For **original day**, **new day** and **relevant act** see section 5.

4 Example: A relevant act is originally required to be done before the end of
5 31 March (the **original day**). A person applies for an extension of time
6 for doing the relevant act and specifies 31 May as the day before the
7 end of which the person seeks to do the relevant act (the **new day**).

8 Since the period beginning on 1 April and ending at the end of 31 May
9 is less than 3 months, the application must be dealt with under this
10 section.

11 The person applies for a further extension of time for doing the
12 relevant act and specifies 31 July as the day before the end of which
13 the person seeks to do the relevant act (the **new day**).

14 Since the period beginning on 1 April and ending at the end of 31 July
15 is more than 3 months, the application must be dealt with under
16 section 137C.

17 (2) A person may object to the grant of an extension by giving the
18 Registrar a notice of objection in accordance with the regulations.

19 (3) The Registrar must give the applicant a copy of any notice of
20 objection as soon as practicable.

21 *No objections*

22 (4) If no notice of objection is given in accordance with subsection (2),
23 the Registrar must:

- 24 (a) grant, or refuse to grant, an extension; and
25 (b) if the Registrar grants an extension—specify the period of the
26 extension (which may be less than the period sought by the
27 applicant).

28 (5) The Registrar must notify the applicant of the Registrar's decision
29 on the application.

30 *Objections*

31 (6) If one or more notices of objection are given in accordance with
32 subsection (2), the Registrar must:

- 33 (a) give the applicant, and each person who gave a notice of
34 objection, an opportunity to be heard; and

EXPOSURE DRAFT

Schedule 1 Amendments

Part 3 Extensions of time and protection of third parties

- 1 (b) grant, or refuse to grant, an extension; and
2 (c) if the Registrar grants an extension—specify the period of the
3 extension (which may be less than the period sought by the
4 applicant).

- 5 (7) The Registrar must notify the applicant, and each person who gave
6 a notice of objection, of the Registrar's decision on the application.

7 *Grounds for extension*

- 8 (8) The Registrar must, under subsection (4) or (6), extend the time for
9 doing the relevant act that is required to be done within a certain
10 time if the Registrar is satisfied that the relevant act is not, or
11 cannot be, done within that time because of:

- 12 (a) an error or omission by the applicant or the applicant's agent;
13 or
14 (b) circumstances beyond the applicant's control.

- 15 (9) The Registrar must, under subsection (4) or (6), refuse to extend
16 the time for doing the relevant act that is required to be done within
17 a certain time if the Registrar is not satisfied as mentioned in
18 subsection (8).

19 *Beginning of extension*

- 20 (10) A period of extension granted under this section begins on the day
21 after the original day.

22 **137C Application for extension of time—extension sought is more** 23 **than 3 months**

- 24 (1) Subject to subsection (4), if a person applies under section 137A
25 for an extension of time for doing a relevant act and the period,
26 beginning on the day after the original day and ending at the end of
27 the new day, is more than 3 months, the Registrar must publish, in
28 accordance with section 148A:

- 29 (a) details of the relevant act; and
30 (b) the fact that an application has been made to extend the time
31 for doing the relevant act; and
32 (c) the length of the extension sought; and
33 (d) such other details as the Registrar considers appropriate.
-

EXPOSURE DRAFT

Amendments **Schedule 1**
Extensions of time and protection of third parties **Part 3**

- 1 Note: For **original day**, **new day** and **relevant act** see section 5.
- 2 Example: A relevant act is originally required to be done before the end of
- 3 31 March (the **original day**). A person applies for an extension of time
- 4 for doing the relevant act and specifies 20 July as the day before the
- 5 end of which the person seeks to do the relevant act (the **new day**).
- 6 Since the period beginning on 1 April and ending at the end of 20 July
- 7 is more than 3 months, the application must be dealt with under this
- 8 section.
- 9 The person applies for a further extension of time for doing the
- 10 relevant act and specifies 15 September as the day before the end of
- 11 which the person seeks to do the relevant act (the **new day**).
- 12 Since the period beginning on 1 April and ending at the end of
- 13 15 September is more than 3 months, the application must be dealt
- 14 with under this section.
- 15 (2) A person may oppose the grant of an extension by giving the
- 16 Registrar a notice of opposition in accordance with the regulations.
- 17 (3) The Registrar must give the applicant a copy of any notice of
- 18 opposition as soon as practicable.
- 19 (4) If the Registrar is satisfied that an extension would not be granted,
- 20 even in the absence of any opposition to the application:
- 21 (a) the Registrar must not make a publication under
- 22 subsection (1); and
- 23 (b) the Registrar must refuse to grant an extension.
- 24 *No opposition*
- 25 (5) If there is a publication under subsection (1) and no-one opposes
- 26 the grant of an extension in accordance with subsection (2), the
- 27 Registrar must:
- 28 (a) grant, or refuse to grant, an extension; and
- 29 (b) if the Registrar grants an extension—specify the period of the
- 30 extension (which may be less than the period sought by the
- 31 applicant).
- 32 (6) The Registrar must notify the applicant of the Registrar's decision
- 33 on the application.

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Schedule 1 Amendments

Part 3 Extensions of time and protection of third parties

Opposition

- (7) If there is a publication under subsection (1) and one or more persons oppose the grant of an extension in accordance with subsection (2), the Registrar must:
- (a) grant, or refuse to grant, an extension; and
 - (b) if the Registrar grants an extension—specify the period of the extension (which may be less than the period sought by the applicant).

Note: The regulations deal with the opposition process.

- (8) The Registrar must notify the applicant, and each person who opposed the grant of an extension, of the Registrar's decision on the application.

Grounds for extension

- (9) The Registrar must, under subsection (5) or (7), extend the time for doing the relevant act that is required to be done within a certain time if the Registrar is satisfied that the relevant act is not, or cannot be, done within that time because of:
- (a) an error or omission by the applicant or the applicant's agent; or
 - (b) circumstances beyond the applicant's control.
- (10) The Registrar must, under subsection (5) or (7), refuse to extend the time for doing the relevant act that is required to be done within a certain time if the Registrar is not satisfied as mentioned in subsection (9).

Beginning of extension

- (11) A period of extension granted under this section begins on the day after the original day.

137D Extensions before or after time for doing relevant act expired

The time for doing a relevant act may be extended under section 137, 137B or 137C, whether before or after that time has ended.

Note: For **relevant act** see section 5.

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Amendments **Schedule 1**
Extensions of time and protection of third parties **Part 3**

1 **137E Giving notice of extension**

2 If, under section 137, 137B or 137C, the Registrar extends the time
3 for doing a relevant act, the Registrar must publish, in accordance
4 with section 148A, such details of the extension as the Registrar
5 considers appropriate.

6 Note: For *relevant act* see section 5.

7 **128 Paragraph 138(1)(a)**

8 Omit “(within the meaning of section 137)”.

9 **129 At the end of subsection 138(1)**

10 Add:

11 Note: For *relevant act* see section 5.

12 **130 Subsection 139(1)**

13 Omit “(within the meaning of section 137)”.

14 **131 At the end of subsection 139(1)**

15 Add:

16 Note: For *relevant act* see section 5.

17 ***Patents Act 1990***

18 **132 Section 3 (list of definitions)**

19 Insert “new day”.

20 **133 Section 3 (list of definitions)**

21 Insert “original day”.

22 **134 Section 3 (list of definitions)**

23 Insert “relevant act”.

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Schedule 1 Amendments

Part 3 Extensions of time and protection of third parties

135 Subsection 41(4)

Omit “, and such provisions as are prescribed have effect for the protection or compensation of persons who availed themselves, or took definite steps by way of contract or otherwise to avail themselves, of the invention during that period”.

136 At the end of section 41 (before the note)

Add:

Protection of third parties

- (5) A person (the **initial person**) who started to exploit, or who took definite steps by way of contract or otherwise to exploit, the invention concerned during the period mentioned in paragraph (4)(c) may, at any time after so starting or after taking the definite steps, do either or both of the following:
- (a) exploit the invention concerned;
 - (b) dispose of the right to exploit the invention concerned to another person.
- (6) However, paragraph (5)(a) ceases to apply in relation to the initial person if the initial person disposes of the right to exploit the invention concerned to another person.
- (7) A person (the **later person**) who, under subsection (5) or this subsection, acquires the right to exploit the invention concerned, may, at any time after the acquisition, do either or both of the following:
- (a) exploit the invention concerned;
 - (b) dispose of the right to exploit the invention concerned to another person.
- (8) However, paragraph (7)(a) ceases to apply in relation to the later person if the later person disposes of the right to exploit the invention concerned to another person.
- (9) The initial person, or the later person, must not grant a licence to another person to exploit the invention concerned.

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Amendments **Schedule 1**
Extensions of time and protection of third parties **Part 3**

- 1 (10) If, apart from this subsection, the doing of a thing in accordance
2 with subsection (5) or (7) would infringe a patent for the invention
3 concerned, then the doing of the thing does not infringe the patent.

4 **137 Subsection 42(3)**

- 5 Omit “section 223”, substitute “sections 223 to 223H (about
6 extensions)”.

7 **138 Subsection 150(4)**

- 8 Repeal the subsection.

9 **139 At the end of section 150**

- 10 Add:

11 *Protection of third parties*

- 12 (6) If an application is restored under this section, a person (the **initial**
13 **person**) who started to exploit, or who took definite steps by way
14 of contract or otherwise to exploit, the invention concerned:

- 15 (a) after the day on which the application lapsed; and
16 (b) before the day on which the application’s restoration was
17 notified in the *Official Journal*;

18 may, at any time after so starting or after taking the definite steps,
19 do either or both of the following:

- 20 (c) exploit the invention concerned;
21 (d) dispose of the right to exploit the invention concerned to
22 another person.

- 23 (7) However, paragraph (6)(c) ceases to apply in relation to the initial
24 person if the initial person disposes of the right to exploit the
25 invention concerned to another person.

- 26 (8) A person (the **later person**) who, under subsection (6) or this
27 subsection, acquires the right to exploit the invention concerned,
28 may, at any time after the acquisition, do either or both of the
29 following:

- 30 (a) exploit the invention concerned;
31 (b) dispose of the right to exploit the invention concerned to
32 another person.

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Schedule 1 Amendments

Part 3 Extensions of time and protection of third parties

- 1 (9) However, paragraph (8)(a) ceases to apply in relation to the later
2 person if the later person disposes of the right to exploit the
3 invention concerned to another person.
- 4 (10) The initial person, or the later person, must not grant a licence to
5 another person to exploit the invention concerned.
- 6 (11) If, apart from this subsection, the doing of a thing in accordance
7 with subsection (6) or (8) would infringe a patent for the invention
8 concerned, then the doing of the thing does not infringe the patent.

140 Section 223 (heading)

9 Repeal the heading, substitute:

11 223 Extensions of time—errors/omissions by Commissioner etc.

12 141 At the end of subsection 223(1)

13 Add:

14 Note: For *relevant act* see Schedule 1.

15 142 Subsections 223(2) to (11)

16 Repeal the subsections.

17 143 After section 223

18 Insert:

19 223A Application for extensions of time

- 20 (1) A person may apply to the Commissioner for an extension of time
21 for doing a relevant act that is required to be done within a certain
22 time if the act is not, or cannot be, done within that time.

23 Note: For *relevant act* see Schedule 1.

- 24 (2) An application must:

- 25 (a) be in the approved form; and
26 (b) specify the day (the *new day*) before the end of which the
27 applicant seeks to do the relevant act; and

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Amendments **Schedule 1**
Extensions of time and protection of third parties **Part 3**

- 1 (c) set out the ground on which the application is made, which
2 must be that the relevant act was not, or cannot be, done
3 within the certain time:
4 (i) because of an error or omission by the applicant or the
5 applicant's agent or attorney; or
6 (ii) because of circumstances beyond the applicant's
7 control; and
8 (d) include a statement justifying the extension sought; and
9 (e) be accompanied by a declaration if the approved form
10 requires this; and
11 (f) be made within the prescribed period; and
12 (g) be accompanied by the prescribed fee.

13 **223B Application for extension of time—extension sought is 3**
14 **months or less**

- 15 (1) If a person applies under section 223A for an extension of time for
16 doing a relevant act and the period, beginning on the day after the
17 original day and ending at the end of the new day, is 3 months or
18 less, the Commissioner must publish in the *Official Journal*:
19 (a) details of the relevant act; and
20 (b) the fact that an application has been made to extend the time
21 for doing the relevant act; and
22 (c) the length of the extension sought; and
23 (d) such other details as the Commissioner considers appropriate.

24 Note: For **original day**, **new day** and **relevant act** see Schedule 1.

25 Example: A relevant act is originally required to be done before the end of
26 31 March (the **original day**). A person applies for an extension of time
27 for doing the relevant act and specifies 31 May as the day before the
28 end of which the person seeks to do the relevant act (the **new day**).

29 Since the period beginning on 1 April and ending at the end of 31 May
30 is less than 3 months, the application must be dealt with under this
31 section.

32 The person applies for a further extension of time for doing the
33 relevant act and specifies 31 July as the day before the end of which
34 the person seeks to do the relevant act (the **new day**).

35 Since the period beginning on 1 April and ending at the end of 31 July
36 is more than 3 months, the application must be dealt with under
37 section 223C.

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Schedule 1 Amendments

Part 3 Extensions of time and protection of third parties

1 (2) A person may object to the grant of an extension by giving the
2 Commissioner a notice of objection, in the approved form, within
3 the prescribed period.

4 (3) The Commissioner must give the applicant a copy of any notice of
5 objection as soon as practicable.

6 *No objections*

7 (4) If no notice of objection is given in accordance with subsection (2),
8 the Commissioner must:

9 (a) grant, or refuse to grant, an extension; and

10 (b) if the Commissioner grants an extension—specify the period
11 of the extension (which may be less than the period sought by
12 the applicant).

13 (5) The Commissioner must notify the applicant of the
14 Commissioner's decision on the application.

15 *Objections*

16 (6) If one or more notices of objection are given in accordance with
17 subsection (2), the Commissioner must:

18 (a) give the applicant, and each person who gave a notice of
19 objection, an opportunity to be heard; and

20 (b) grant, or refuse to grant, an extension; and

21 (c) if the Commissioner grants an extension—specify the period
22 of the extension (which may be less than the period sought by
23 the applicant).

24 (7) The Commissioner must notify the applicant, and each person who
25 gave a notice of objection, of the Commissioner's decision on the
26 application.

27 *Grounds for extension*

28 (8) The Commissioner must, under subsection (4) or (6), extend the
29 time for doing the relevant act that is required to be done within a
30 certain time if the Commissioner is satisfied, on the balance of
31 probabilities, that the relevant act is not, or cannot be, done within
32 that time because of:

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- 1 (a) an error or omission by the applicant or the applicant's agent
2 or attorney; or
3 (b) circumstances beyond the applicant's control.

- 4 (9) The Commissioner must, under subsection (4) or (6), refuse to
5 extend the time for doing the relevant act that is required to be
6 done within a certain time if the Commissioner is not satisfied as
7 mentioned in subsection (8).

8 *Beginning of extension*

- 9 (10) A period of extension granted under this section begins on the day
10 after the original day.

11 **223C Application for extension of time—extension sought is more**
12 **than 3 months**

- 13 (1) Subject to subsection (3), if a person applies under section 223A
14 for an extension of time for doing a relevant act and the period,
15 beginning on the day after the original day and ending at the end of
16 the new day, is more than 3 months, the Commissioner must
17 publish in the *Official Journal*:
18 (a) details of the relevant act; and
19 (b) the fact that an application has been made to extend the time
20 for doing the relevant act; and
21 (c) the length of the extension sought; and
22 (d) such other details as the Commissioner considers appropriate.

23 Note: For **original day**, **new day** and **relevant act** see Schedule 1.

24 Example: A relevant act is originally required to be done before the end of
25 31 March (the **original day**). A person applies for an extension of time
26 for doing the relevant act and specifies 20 July as the day before the
27 end of which the person seeks to do the relevant act (the **new day**).

28 Since the period beginning on 1 April and ending at the end of 20 July
29 is more than 3 months, the application must be dealt with under this
30 section.

31 The person applies for a further extension of time for doing the
32 relevant act and specifies 15 September as the day before the end of
33 which the person seeks to do the relevant act (the **new day**).

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Schedule 1 Amendments

Part 3 Extensions of time and protection of third parties

1 Since the period beginning on 1 April and ending at the end of
2 15 September is more than 3 months, the application must be dealt
3 with under this section.

- 4 (2) A person may, as prescribed by the regulations, oppose the grant of
5 an extension.
- 6 (3) If the Commissioner is satisfied, on the balance of probabilities,
7 that an extension would not be granted, even in the absence of any
8 opposition to the application:
- 9 (a) the Commissioner must not make a publication under
10 subsection (1); and
- 11 (b) the Commissioner must refuse to grant an extension.

12 *No opposition*

- 13 (4) If there is a publication under subsection (1) and no-one opposes
14 the grant of an extension in accordance with subsection (2), the
15 Commissioner must:
- 16 (a) grant, or refuse to grant, an extension; and
 - 17 (b) if the Commissioner grants an extension—specify the period
18 of the extension (which may be less than the period sought by
19 the applicant).
- 20 (5) The Commissioner must notify the applicant of the
21 Commissioner's decision on the application.

22 *Opposition*

- (6) If there is a publication under subsection (1) and one or more persons oppose the grant of an extension in accordance with subsection (2), the Commissioner must:
- (a) grant, or refuse to grant, an extension; and
 - (b) if the Commissioner grants an extension—specify the period of the extension (which may be less than the period sought by the applicant).

30 Note: The regulations deal with the opposition process.

- 31 (7) The Commissioner must notify the applicant, and each person who
32 opposed the grant of an extension, of the Commissioner's decision
33 on the application.

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Amendments **Schedule 1**
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Grounds for extension

- (8) The Commissioner must, under subsection (4) or (6), extend the time for doing the relevant act that is required to be done within a certain time if the Commissioner is satisfied, on the balance of probabilities, that the relevant act is not, or cannot be, done within that time because of:
- (a) an error or omission by the applicant or the applicant's agent or attorney; or
 - (b) circumstances beyond the applicant's control.
- (9) The Commissioner must, under subsection (4) or (6), refuse to extend the time for doing the relevant act that is required to be done within a certain time if the Commissioner is not satisfied as mentioned in subsection (8).

Beginning of extension

- (10) A period of extension granted under this section begins on the day after the original day.

223D Extensions before or after time for doing relevant act expired

The time for doing a relevant act may be extended under section 223, 223B or 223C, whether before or after that time has ended.

Note: For **relevant act** see Schedule 1.

223E Giving notice of extension

If, under section 223, 223B or 223C, the Commissioner extends the time for doing a relevant act, the Commissioner must publish in the *Official Journal* such details of the extension as the Commissioner considers appropriate.

Note: For **relevant act** see Schedule 1.

223F Restoration of patent application or patent

- (1) If:

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Part 3 Extensions of time and protection of third parties

- 1 (a) a patent application (other than a provisional patent
2 application) lapses, or a patent ceases, because of a failure to
3 do a relevant act within the time allowed; and
4 (b) the time for doing the act is extended;
5 the application, or patent, is taken to have been restored on the day
6 on which the extension is granted.

7 Note: For **relevant act** see Schedule 1.

- 8 (2) The Commissioner must:
9 (a) notify the applicant, or patentee, that the application, or
10 patent, has been restored; and
11 (b) publish in the *Official Journal* the fact that the application, or
12 patent, has been restored.
- 13 (3) Infringement proceedings cannot be brought in respect of an
14 infringement committed:
15 (a) between the day on which the patent application lapses and
16 the day on which it is restored; or
17 (b) between the day on which the patent ceases and the day on
18 which it is restored.

19 **223G Provisional patent application treated as not lapsing**

- 20 (1) If:
21 (a) a provisional patent application lapses under subsection 142(1)
22 at the end of the period prescribed for the purposes of
23 section 38; and
24 (b) that period is extended;
25 the application must be treated as if it had not lapsed.
- 26 (2) The Commissioner must:
27 (a) notify the applicant that the application is treated as if it had
28 not lapsed; and
29 (b) publish in the *Official Journal* the fact that the application is
30 treated as if it had not lapsed.

31 **223H Protection of third parties**

- 32 (1) This section applies if:
-

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Amendments **Schedule 1**
Extensions of time and protection of third parties **Part 3**

- 1 (a) because of an application under 223A for an extension of
2 time, the Commissioner grants:
3 (i) an extension of more than 3 months for doing a relevant
4 act; or
5 (ii) an extension of time for doing a prescribed relevant act
6 in prescribed circumstances; and
7 (c) as a result of the extension, a patent application, or a patent,
8 is restored under section 223F.

9 Note: For **relevant act** see Schedule 1.

- 10 (2) A person (the **initial person**) who started to exploit, or who took
11 definite steps by way of contract or otherwise to exploit, the
12 invention concerned:
13 (a) after the day on which the patent application lapsed or after
14 the day on which the patent ceased; and
15 (b) before the day on which details in relation to the application
16 for an extension of time are published under
17 subsection 223B(1) or 223C(1);
18 may, at any time after so starting or after taking the definite steps,
19 do either or both of the following:
20 (c) exploit the invention concerned;
21 (d) dispose of the right to exploit the invention concerned to
22 another person.
- 23 (3) However, paragraph (2)(c) ceases to apply in relation to the initial
24 person if the initial person disposes of the right to exploit the
25 invention concerned to another person.
- 26 (4) A person (the **later person**) who, under subsection (2) or this
27 subsection, acquires the right to exploit the invention concerned,
28 may, at any time after the acquisition, do either or both of the
29 following:
30 (a) exploit the invention concerned;
31 (b) dispose of the right to exploit the invention concerned to
32 another person.
- 33 (5) However, paragraph (4)(a) ceases to apply in relation to the later
34 person if the later person disposes of the right to exploit the
35 invention concerned to another person.

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Schedule 1 Amendments

Part 3 Extensions of time and protection of third parties

1 *No grant of licences*

2 (6) The initial person, or the later person, must not grant a licence to
3 another person to exploit the invention concerned.

4 *No infringement of patent*

5 (7) If, apart from this subsection, the doing of a thing in accordance
6 with subsection (2) or (4) would infringe a patent for the invention
7 concerned, then the doing of the thing does not infringe the patent.

8 **144 Paragraph 224(1)(a)**

9 Omit “or 223”, substitute “, 223, 223B or 223C”.

10 **145 Schedule 1**

11 Insert:

12 ***new day***, in relation to a relevant act, has the meaning given by
13 paragraph 223A(2)(b).

14 ***original day***, in relation to a relevant act, means the day before the
15 end of which the relevant act was originally required to be done.

16 ***relevant act*** means an action (other than a prescribed action) in
17 relation to a patent, a patent application or any proceedings under
18 this Act (other than court proceedings), and includes the making of
19 a Convention application within the time allowed for making such
20 applications.

21 ***Plant Breeder’s Rights Act 1994***

22 **146 Subsection 3(1)**

23 Insert:

24 ***new day***, in relation to a relevant act, has the meaning given by
25 paragraph 76C(2)(b).

26 ***original day***, in relation to a relevant act, means the day before the
27 end of which the relevant act was originally required to be done.

28 ***relevant act*** means an action (other than a prescribed action) in
29 relation to:

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- 1 (a) PBR in a plant variety; or
2 (b) an application for PBR in a plant variety; or
3 (c) any proceedings under this Act (other than court
4 proceedings).

5 **147 Subsection 34(1)**

6 Omit “or within such further period as the Secretary allows for the
7 purpose,”.

8 **148 Subsection 34(1) (note)**

9 Omit “this subsection”, substitute “section 76D”.

10 **149 Paragraph 40(8)(b)**

11 Omit “or such longer period as the Secretary allows”.

12 **150 Subsection 40(8) (note)**

13 Omit “this subsection”, substitute “section 76D”.

14 **151 Subsection 44(6)**

15 Omit “or such longer period as the Secretary considers to be reasonable
16 in the circumstances,”.

17 **152 At the end of subsection 44(6)**

18 Add:

19 Note: A decision under section 76D to refuse to extend the period of 30 days
20 is reviewable by the AAT under section 77.

21 **153 After section 76A**

22 Insert:

23 **76B Extensions of time where error or omission by Registrar or**
24 **person assisting Registrar**

- 25 (1) The Registrar must:
26 (a) extend the time for doing a relevant act that is required to be
27 done within a certain time if the act is not, or cannot be, done
28 within that time because of an error or omission by:
29 (i) the Registrar; or
-

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Schedule 1 Amendments

Part 3 Extensions of time and protection of third parties

- 1 (ii) a person who is engaged under the *Public Service Act*
2 1999 or otherwise for or on behalf of the
3 Commonwealth and whose duties involve providing
4 assistance to the Registrar; and

- 5 (b) determine the period of the extension.

6 Note: For **relevant act** see subsection 3(1).

- 7 (2) The Registrar must notify such persons as the Registrar considers
8 appropriate of the Registrar's decision under subsection (1).

9 **76C Application for extensions of time**

- 10 (1) A person may apply to the Registrar for an extension of time for
11 doing a relevant act that is required to be done within a certain time
12 if the act is not, or cannot be, done within that time.

13 Note: For **relevant act** see subsection 3(1).

- 14 (2) An application must:

- 15 (a) be in the approved form; and
16 (b) specify the day (the **new day**) before the end of which the
17 applicant seeks to do the relevant act; and
18 (c) set out the ground on which the application is made, which
19 must be that the relevant act was not, or cannot be, done
20 within the certain time:
21 (i) because of an error or omission by the applicant or the
22 applicant's agent; or
23 (ii) because of circumstances beyond the applicant's
24 control; and
25 (d) include a statement justifying the extension sought; and
26 (e) be made within the prescribed period; and
27 (f) be accompanied by the prescribed fee.

- 28 (3) Paragraph (2)(f) does not apply if:

- 29 (a) the relevant act is the giving of a detailed description of a
30 plant variety required under section 34; or
31 (b) the relevant act is prescribed for the purposes of this
32 paragraph.

76D Extensions of time where application for extension

- (1) Subject to subsection (4), if a person applies under section 76C for an extension of time for doing a relevant act, the Registrar must give public notice of:
- (a) details of the relevant act; and
 - (b) the fact that an application has been made to extend the time for doing the relevant act; and
 - (c) the length of the extension sought; and
 - (d) such other details as the Registrar considers appropriate.

Note: For **relevant act** see subsection 3(1).

- (2) A person may object to the grant of an extension by giving the Registrar a notice of objection, in the approved form, within the prescribed period.
- (3) The Registrar must give the applicant a copy of any notice of objection as soon as practicable.
- (4) If the Registrar is satisfied that an extension would not be granted, even in the absence of any objection to the application:
- (a) the Registrar must not give public notice under subsection (1); and
 - (b) the Registrar must refuse to grant an extension.

No objections

- (5) If public notice is given under subsection (1) and no notice of objection is given in accordance with subsection (2), the Registrar must:
- (a) grant, or refuse to grant, an extension; and
 - (b) if the Registrar grants an extension—specify the period of the extension (which may be less than the period sought by the applicant).
- (6) The Registrar must notify the applicant of the Registrar's decision on the application.

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Schedule 1 Amendments

Part 3 Extensions of time and protection of third parties

Objections

- (7) If public notice is given under subsection (1) and one or more notices of objection are given in accordance with subsection (2), the Registrar must:
- (a) give the applicant, and each person who gave a notice of objection, an opportunity to be heard; and
 - (b) grant, or refuse to grant, an extension; and
 - (c) if the Registrar grants an extension—specify the period of the extension (which may be less than the period sought by the applicant).
- (8) The Registrar must notify the applicant, and each person who gave a notice of objection, of the Registrar's decision on the application.

Grounds for extension

- (9) The Registrar must, under subsection (5) or (7), extend the time for doing the relevant act that is required to be done within a certain time if the Registrar is satisfied that the relevant act is not, or cannot be, done within that time because of:
- (a) an error or omission by the applicant or the applicant's agent; or
 - (b) circumstances beyond the applicant's control.
- (10) The Registrar must, under subsection (5) or (7), refuse to extend the time for doing the relevant act that is required to be done within a certain time if the Registrar is not satisfied as mentioned in subsection (9).

Beginning of extension

- (11) A period of extension granted under this section begins on the day after the original day.

76E Extensions before or after time for doing relevant act expired

The time for doing a relevant act may be extended under section 76B or 76D, whether before or after that time has ended.

Note: For **relevant act** see subsection 3(1).

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76F Giving notice of extension

If, under section 76B or 76D, the Registrar extends the time for doing a relevant act, the Registrar must give public notice of such details of the extension as the Registrar considers appropriate.

Note: For **relevant act** see subsection 3(1).

76G Consequences of extension

(1) If:

(a) an application for the grant of PBR in a plant variety is taken to have been withdrawn under subsection 34(2), or the PBR in a plant variety ceases, because of a failure to do a relevant act within the time allowed; and

(b) the time for doing the act is extended;
the application, or the PBR in the plant variety, is taken to have been restored on the day on which the extension is granted.

Note: For **relevant act** see subsection 3(1).

(2) The Registrar must:

(a) notify the applicant, or the grantee of PBR in the plant variety, that the application, or the PBR in the plant variety, has been restored; and

(b) give public notice of the fact that the application, or the PBR in the plant variety, has been restored.

Protection from infringement proceedings

(3) Infringement proceedings cannot be brought in respect of an infringement committed:

(a) between the day on which the application for the grant of PBR in the plant variety is taken to have been withdrawn under subsection 34(2) and the day on which the application is restored; or

(b) between the day on which PBR in the plant variety ceases and the day on which the PBR in the plant variety is restored.

76H Protection of third parties

(1) This section applies if:

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- 1 (a) an application for the grant of PBR in a plant variety is taken
2 to have been withdrawn under subsection 34(2), or the PBR
3 in a plant variety ceases, because of a failure to do a relevant
4 act; and
- 5 (b) the application, or the PBR in the plant variety, is restored
6 under section 76G because the Registrar extends the time for
7 doing the relevant act as a result of an application under
8 section 76C.
- 9 Note: For **relevant act** see subsection 3(1).
- 10 (2) A person (the **initial person**) who started to exploit, or who took
11 definite steps by way of contract or otherwise to exploit, the plant
12 variety:
- 13 (a) after the day on which the application for the grant of PBR in
14 the plant variety is taken to have been withdrawn under
15 subsection 34(2) or after the day on which the PBR in the
16 plant variety ceased; and
- 17 (b) before the day on which public notice under
18 subsection 76D(1) is given of details in relation to the
19 application for an extension of time;
- 20 may, at any time after so starting or after taking the definite steps,
21 do either or both of the following:
- 22 (c) exploit the plant variety;
- 23 (d) dispose of the right to exploit the plant variety to another
24 person.
- 25 (3) However, paragraph (2)(c) ceases to apply in relation to the initial
26 person if the initial person disposes of the right to exploit the plant
27 variety to another person.
- 28 (4) A person (the **later person**) who, under subsection (2) or this
29 subsection, acquires the right to exploit the plant variety, may, at
30 any time after the acquisition, do either or both of the following:
- 31 (a) exploit the plant variety;
- 32 (b) dispose of the right to exploit the plant variety to another
33 person.
- 34 (5) However, paragraph (4)(a) ceases to apply in relation to the later
35 person if the later person disposes of the right to exploit the plant
36 variety to another person.
-

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1 *No grant of licences*

2 (6) The initial person, or the later person, must not grant a licence to
3 another person to exploit the plant variety.

4 *No infringement of PBR in the plant variety*

5 (7) If, apart from this subsection, the doing of a thing in accordance
6 with subsection (2) or (4) would infringe the PBR in the plant
7 variety, then the doing of the thing does not infringe the PBR in the
8 plant variety.

9 **154 Subparagraphs 77(1)(b)(vii) and (xii)**

10 Repeal the subparagraphs.

11 **155 At the end of paragraph 77(1)(b)**

12 Add:

13 (xix) under section 76B or 76D to extend the time, or to
14 refuse to extend the time, for doing a relevant act; or

15 **156 After subparagraph 80(2)(a)(ii)**

16 Insert:

17 (iia) fees payable in respect of the making of applications
18 under section 76C (about extensions of time); and

19 ***Trade Marks Act 1995***

20 **157 Readers guide (list of terms defined in section 6)**

21 Insert “new day”.

22 **158 Readers guide (list of terms defined in section 6)**

23 Insert “original day”.

24 **159 Readers guide (list of terms defined in section 6)**

25 Insert “relevant act”.

26 **160 Subsection 6(1)**

27 Insert:

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1 **new day**, in relation to a relevant act, has the meaning given by
2 paragraph 224A(2)(b).

3 **original day**, in relation to a relevant act, means the day before the
4 end of which the relevant act was originally required to be done.

5 **relevant act** means:

- 6 (a) any act (other than a prescribed act) done in relation to a
7 trade mark; or
8 (b) the filing of any document (other than a prescribed
9 document); or
10 (c) any proceedings (other than court proceedings).

11 **161 Subsection 37(2)**

12 After “section 224”, insert “, 224B or 224C”.

13 **162 At the end of section 128**

14 Add:

15 (4) If:

- 16 (a) an application for the registration of a trade mark lapses as
17 mentioned in subsection 37(1); and
18 (b) the Registrar extends under section 224, 224B or 224C the
19 period within which the application may be accepted; and
20 (c) the application is accepted within the extended period; and
21 (d) the trade mark becomes a registered trade mark;

22 then an action may not be brought in respect of an act that:

- 23 (e) infringed the trade mark; and
24 (f) was done after the application lapsed and before the end of
25 the day on which the extension was granted.

26 (5) If:

- 27 (a) an application for the registration of a trade mark lapses as
28 mentioned in subsection 54A(1); and
29 (b) the Registrar extends, under the regulations, the period within
30 which the notice of intention to defend the application may
31 be filed; and
32 (c) the notice of intention to defend the application is filed
33 within the extended period; and
-

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- 1 (d) the trade mark becomes a registered trade mark;
2 then an action may not be brought in respect of an act that:
3 (e) infringed the trade mark; and
4 (f) was done after the application lapsed and before the end of
5 the day on which the extension was granted.

6 **163 Paragraph 222(a)**

7 Omit “224(6)”, substitute “224C(2)”.

8 **164 Section 224 (heading)**

9 Repeal the heading, substitute:

10 **224 Extensions of time—errors/omissions by Registrar etc.**

11 **165 Subsection 224(1)**

12 Omit “(1)”.

13 **166 Subsections 224(2) to (8)**

14 Repeal the subsections.

15 **167 After section 224**

16 Insert:

17 **224A Application for extensions of time**

- 18 (1) A person may apply to the Registrar for an extension of time for
19 doing a relevant act that is required to be done within a certain time
20 if the act is not, or cannot be, done within that time.

21 Note: For **relevant act** see subsection 6(1).

- 22 (2) An application must:

- 23 (a) be in the approved form; and
24 (b) specify the day (the **new day**) before the end of which the
25 applicant seeks to do the relevant act; and
26 (c) set out the ground on which the application is made, which
27 must be that the relevant act was not, or cannot be, done
28 within the certain time:

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- 1 (i) because of an error or omission by the applicant or the
2 applicant's agent; or
3 (ii) because of circumstances beyond the applicant's
4 control; or
5 (iii) because of special circumstances; and
6 (d) include a statement justifying the extension sought; and
7 (e) be accompanied by a declaration if the approved form
8 requires this; and
9 (f) be made within the prescribed period; and
10 (g) be accompanied by the prescribed fee.
- 11 (3) The Registrar may, by notifiable instrument, determine
12 circumstances that constitute special circumstances for the
13 purposes of subparagraph (2)(c)(iii).
- 14 (4) Subsection (3) does not limit subparagraph (2)(c)(iii).

224B Application for extension of time—extension sought is 3 months or less

- 17 (1) If a person applies under section 224A for an extension of time for
18 doing a relevant act and the period, beginning on the day after the
19 original day and ending at the end of the new day, is 3 months or
20 less, the Registrar must publish, in accordance with section 230A:
21 (a) details of the relevant act; and
22 (b) the fact that an application has been made to extend the time
23 for doing the relevant act; and
24 (c) the length of the extension sought; and
25 (d) such other details as the Registrar considers appropriate.

26 Note: For **original day**, **new day** and **relevant act** see subsection 6(1).

27 Example: A relevant act is originally required to be done before the end of
28 31 March (the **original day**). A person applies for an extension of time
29 for doing the relevant act and specifies 31 May as the day before the
30 end of which the person seeks to do the relevant act (the **new day**).

31 Since the period beginning on 1 April and ending at the end of 31 May
32 is less than 3 months, the application must be dealt with under this
33 section.

34 The person applies for a further extension of time for doing the
35 relevant act and specifies 31 July as the day before the end of which
36 the person seeks to do the relevant act (the **new day**).

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1 Since the period beginning on 1 April and ending at the end of 31 July
2 is more than 3 months, the application must be dealt with under
3 section 224C.

4 (2) A person may object to the grant of an extension by giving the
5 Registrar a notice of objection, in the approved form, within the
6 prescribed period.

7 (3) The Registrar must give the applicant a copy of any notice of
8 objection as soon as practicable.

9 *No objections*

10 (4) If no notice of objection is given in accordance with subsection (2),
11 the Registrar must:

12 (a) grant, or refuse to grant, an extension; and

13 (b) if the Registrar grants an extension—specify the period of the
14 extension (which may be less than the period sought by the
15 applicant).

16 (5) The Registrar must notify the applicant of the Registrar's decision
17 on the application.

18 *Objections*

19 (6) If one or more notices of objection are given in accordance with
20 subsection (2), the Registrar must:

21 (a) give the applicant, and each person who gave a notice of
22 objection, an opportunity to be heard; and

23 (b) grant, or refuse to grant, an extension; and

24 (c) if the Registrar grants an extension—specify the period of the
25 extension (which may be less than the period sought by the
26 applicant).

27 (7) The Registrar must notify the applicant, and each person who gave
28 a notice of objection, of the Registrar's decision on the application.

29 *Grounds for extension*

30 (8) The Registrar must, under subsection (4) or (6), extend the time for
31 doing the relevant act that is required to be done within a certain

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- 1 time if the Registrar is satisfied that the relevant act is not, or
2 cannot be, done within that time because of:
3 (a) an error or omission by the applicant or the applicant's agent;
4 or
5 (b) circumstances beyond the applicant's control; or
6 (c) special circumstances.
- 7 (9) The Registrar must, under subsection (4) or (6), refuse to extend
8 the time for doing the relevant act that is required to be done within
9 a certain time if the Registrar is not satisfied as mentioned in
10 subsection (8).

11 *Beginning of extension*

- 12 (10) A period of extension granted under this section begins on the day
13 after the original day.

14 *Review*

- 15 (11) Applications may be made to the Administrative Appeals Tribunal
16 for review of decisions of the Registrar to extend, or not to extend,
17 the time for the doing of a relevant act.

18 **224C Application for extension of time—extension sought is more** 19 **than 3 months**

- 20 (1) Subject to subsection (3), if a person applies under section 224A
21 for an extension of time for doing a relevant act and the period,
22 beginning on the day after the original day and ending at the end of
23 the new day, is more than 3 months, the Registrar must publish, in
24 accordance with section 230A:
25 (a) details of the relevant act; and
26 (b) the fact that an application has been made to extend the time
27 for doing the relevant act; and
28 (c) the length of the extension sought; and
29 (d) such other details as the Registrar considers appropriate.

30 Note: For **original day**, **new day** and **relevant act** see subsection 6(1).

31 Example: A relevant act is originally required to be done before the end of
32 31 March (the **original day**). A person applies for an extension of time

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1 for doing the relevant act and specifies 20 July as the day before the
2 end of which the person seeks to do the relevant act (the *new day*).
3 Since the period beginning on 1 April and ending at the end of 20 July
4 is more than 3 months, the application must be dealt with under this
5 section.
6 The person applies for a further extension of time for doing the
7 relevant act and specifies 15 September as the day before the end of
8 which the person seeks to do the relevant act (the *new day*).
9 Since the period beginning on 1 April and ending at the end of
10 15 September is more than 3 months, the application must be dealt
11 with under this section.

12 (2) A person may, as prescribed by the regulations, oppose the grant of
13 an extension.

14 (3) If the Registrar is satisfied that an extension would not be granted,
15 even in the absence of any opposition to the application:

16 (a) the Registrar must not make a publication under
17 subsection (1); and

18 (b) the Registrar must refuse to grant an extension.

19 *No opposition*

20 (4) If there is a publication under subsection (1) and no-one opposes
21 the grant of an extension in accordance with subsection (2), the
22 Registrar must:

23 (a) grant, or refuse to grant, an extension; and

24 (b) if the Registrar grants an extension—specify the period of the
25 extension (which may be less than the period sought by the
26 applicant).

27 (5) The Registrar must notify the applicant of the Registrar's decision
28 on the application.

29 *Opposition*

30 (6) If there is a publication under subsection (1) and one or more
31 persons oppose the grant of an extension in accordance with
32 subsection (2), the Registrar must:

33 (a) grant, or refuse to grant, an extension; and

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- 1 (b) if the Registrar grants an extension—specify the period of the
2 extension (which may be less than the period sought by the
3 applicant).

4 Note: The regulations deal with the opposition process.

- 5 (7) The Registrar must notify the applicant, and each person who
6 opposed the grant of an extension, of the Registrar's decision on
7 the application.

8 *Grounds for extension*

- 9 (8) The Registrar must, under subsection (4) or (6), extend the time for
10 doing the relevant act that is required to be done within a certain
11 time if the Registrar is satisfied that the relevant act is not, or
12 cannot be, done within that time because of:

13 (a) an error or omission by the applicant or the applicant's agent;
14 or

15 (b) circumstances beyond the applicant's control; or

16 (c) special circumstances.

- 17 (9) The Registrar must, under subsection (4) or (6), refuse to extend
18 the time for doing the relevant act that is required to be done within
19 a certain time if the Registrar is not satisfied as mentioned in
20 subsection (8).

21 *Beginning of extension*

- 22 (10) A period of extension granted under this section begins on the day
23 after the original day.

24 *Review*

- 25 (11) Applications may be made to the Administrative Appeals Tribunal
26 for review of decisions of the Registrar to extend, or not to extend,
27 the time for the doing of a relevant act.

28 **224D Extensions before or after time for doing relevant act expired**

29 The time for doing a relevant act may be extended under
30 section 224, 224B or 224C, whether before or after that time has
31 ended.

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Note: For **relevant act** see subsection 6(1).

224E Giving notice of extension

If, under section 224, 224B or 224C, the Registrar extends the time for doing a relevant act, the Registrar must publish, in accordance with section 230A, such details of the extension as the Registrar considers appropriate.

Note: For **relevant act** see subsection 6(1).

168 Subsection 231(3)

Omit “and 92”, substitute “, 96 and 224C”.

Division 2—Application, saving and transitional provisions

169 Designs

- (1) Paragraph 136(1)(g) of the *Designs Act 2003*, as in force immediately before the commencement of this item, continues in force on and after that commencement in relation to a decision made before, on or after that commencement to refuse an application under section 137 of that Act made before, on or after that commencement.
- (2) The amendments of section 137 of the *Designs Act 2003* made by this Part, and sections 137A to 137E of that Act as inserted by this Part, apply in relation to a relevant act that is required to be done within a certain time if:
 - (a) the end of the time for originally doing the act is on or after the commencement of this item; and
 - (b) no application had been made under section 137 of that Act before that commencement to extend the time for doing that act.
- (3) Section 137 of the *Designs Act 2003*, as in force immediately before the commencement of this item, continues in force on and after that commencement in relation to a relevant act that is required to be done within a certain time if:
 - (a) the end of the time for originally doing the act is before the commencement of this item; or

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- 1 (b) the end of the time for originally doing the act is on or after
2 the commencement of this item and an application had been
3 made under that section before that commencement to extend
4 the time for doing that act.
- 5 (4) The amendments of section 137 of the *Designs Act 2003* made by this
6 Part do not affect the validity of an extension granted under that section
7 before the commencement of this item.
- 8 (5) If, on or after the commencement of this item, the Registrar is required
9 to advertise an application, for an extension, in the *Official Journal* in
10 accordance with subsection 137(4) of the *Designs Act 2003*, as
11 continued in force by this item, then that requirement is taken to have
12 been met if the Registrar publishes details in relation to the application
13 in accordance with section 148A of that Act.

170 Patents

- 15 (1) The amendments of section 41 of the *Patents Act 1990* made by this
16 Part apply in relation to requirements specified in paragraph 6(c) or (d)
17 of that Act that cease to be satisfied on or after the commencement of
18 this item.
- 19 (2) The amendments of section 150 of the *Patents Act 1990* made by this
20 Part apply in relation to an application that lapses under section 148 of
21 that Act on or after the commencement of this item.
- 22 (3) The amendments of section 223 of the *Patents Act 1990* made by this
23 Part, and sections 223A to 223H of that Act as inserted by this Part,
24 apply in relation to a relevant act that is required to be done within a
25 certain time if:
26 (a) the end of the time for originally doing the act is on or after
27 the commencement of this item; and
28 (b) no application had been made under section 223 of that Act
29 before that commencement to extend the time for doing that
30 act.
- 31 (4) Section 223 of the *Patents Act 1990*, as in force immediately before the
32 commencement of this item, continues in force on and after that
33 commencement in relation to a relevant act that is required to be done
34 within a certain time if:

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- 1 (a) the end of the time for originally doing the act is before the
2 commencement of this item; or
3 (b) the end of the time for originally doing the act is on or after
4 the commencement of this item and an application had been
5 made under that section before that commencement to extend
6 the time for doing that act.
- 7 (5) The amendments of section 223 of the *Patents Act 1990* made by this
8 Part do not affect the validity of an extension granted under that section
9 before the commencement of this item.

10 **171 Plant breeder's rights**

- 11 (1) Sections 76B to 76H of the *Plant Breeder's Rights Act 1994*, as inserted
12 by this Part, apply in relation to a relevant act that is required to be done
13 within a certain time, where the end of the time is on or after the
14 commencement of this item.
- 15 (2) However, if, before the commencement of this item, a person sought an
16 extension under subsection 34(1), paragraph 40(8)(b) or
17 subsection 44(6) of the *Plant Breeder's Rights Act 1994* for doing an
18 action:
19 (a) sections 76B to 76H of that Act do not apply in relation to
20 that action; and
21 (b) section 34, 40 or 44 of that Act, as in force immediately
22 before the commencement of this item, continues to apply on
23 and after that commencement in relation to the extension
24 sought.
- 25 (3) Subparagraphs 77(1)(b)(vii) and (xii) of the *Plant Breeder's Rights Act*
26 *1994*, as in force immediately before the commencement of this item,
27 continue to apply on or after that commencement in relation to refusal
28 decisions made before, on or after that commencement as a result of an
29 extension sought before that commencement.

30 **172 Trade marks**

- 31 (1) Subsection 128(4) of the *Trade Marks Act 1995*, as added by this Part,
32 applies in relation to an application for the registration of a trade mark
33 that lapses as mentioned in subsection 37(1) of that Act on or after the
34 commencement of this item.

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Part 3 Extensions of time and protection of third parties

- 1 (2) Subsection 128(5) of the *Trade Marks Act 1995*, as added by this Part,
2 applies in relation to an application for the registration of a trade mark
3 that lapses as mentioned in subsection 54A(1) of that Act on or after the
4 commencement of this item.
- 5 (3) Section 222 of the *Trade Marks Act 1995*, as in force immediately
6 before the commencement of this item, continues in force on and after
7 that commencement in relation to a notice of opposition given under
8 subsection 224(6) of that Act before, on or after that commencement.
- 9 (4) The amendments of section 224 of the *Trade Marks Act 1995* made by
10 this Part, and sections 224A to 224E of that Act as inserted by this Part,
11 apply in relation to a relevant act that is required to be done within a
12 certain time if:
13 (a) the end of the time for originally doing the act is on or after
14 the commencement of this item; and
15 (b) no application had been made under section 224 of that Act
16 before that commencement to extend the time for doing that
17 act.
- 18 (5) Section 224 of the *Trade Marks Act 1995*, as in force immediately
19 before the commencement of this item, continues in force on and after
20 that commencement in relation to a relevant act that is required to be
21 done within a certain time if:
22 (a) the end of the time for originally doing the act is before the
23 commencement of this item; or
24 (b) the end of the time for originally doing the act is on or after
25 the commencement of this item and an application had been
26 made under that section before that commencement to extend
27 the time for doing that act.
- 28 (6) The amendments of section 224 of the *Trade Marks Act 1995* made by
29 this Part do not affect the validity of an extension granted under that
30 section before the commencement of this item.
- 31 (7) If, on or after the commencement of this item, the Registrar is required
32 to advertise an application, for an extension, in the *Official Journal* in
33 accordance with subsection 224(5) of the *Trade Marks Act 1995*, as
34 continued in force by this item, then that requirement is taken to have
35 been met if the Registrar publishes details in relation to the application
36 in accordance with section 230A of that Act.
-

Part 4—Written requirements

Division 1—Amendments

Designs Act 2003

173 Subsection 24(1)

Omit “give a written notice to the applicant stating”, substitute “, by notification to the applicant, state”.

174 Subsections 24(2) and (3)

Repeal the subsections, substitute:

(2) If a purported design application does not meet the minimum filing requirements, the Registrar must notify the applicant to that effect. The notification must:

(a) identify each minimum filing requirement that has not been met; and

(b) require the applicant to file the additional information required within 2 months, or such other period as is prescribed, from the date of the notification.

(3) If the minimum filing requirements are not met within the period under paragraph (2)(b), the application is taken never to have been filed.

175 Section 41

Omit “give a written notice to the applicant stating”, substitute “notify the applicant”.

176 Paragraph 41(a)

Before “the matters”, insert “of”.

177 Subparagraph 41(c)(ii)

Omit “notice”, substitute “notification”.

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Schedule 1 Amendments

Part 4 Written requirements

1 **178 Section 42 (heading)**

2 Repeal the heading, substitute:

3 **42 What happens after Registrar gives notification under section 41**

4 **179 Subsection 42(1)**

5 Omit “written notice”, substitute “notification”.

6 **180 Subsection 42(3)**

7 Omit “notice”, substitute “notification”.

8 **181 Paragraph 42(5)(b)**

9 Omit “notice”, substitute “notification”.

10 **182 Subsection 43(2)**

11 Omit “a notice”, substitute “a notification”.

12 **183 Paragraph 43(2)(b)**

13 Omit “notice”, substitute “notification”.

14 **184 Subsection 43(3)**

15 Omit “in writing of a refusal under subsection (1) or (2). The notice
16 must set out”, substitute “of a refusal under subsection (1) or (2) and
17 of”.

18 **185 Paragraph 52(3)(a)**

19 Omit “give the relevant parties a notice stating”, substitute “notify the
20 relevant parties”.

21 **186 Subsection 66(2)**

22 Omit “give written notice to that effect to the registered owner of the
23 design”, substitute “notify the registered owner of the design to that
24 effect”.

25 **187 Subsection 67(2)**

26 Omit “give the relevant parties a notice stating”, substitute “notify the
27 relevant parties”.

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1 **188 Paragraph 67(2)(b)**

2 Before “the details”, insert “of”.

3 **189 Paragraph 68(2)(a)**

4 Omit “give the relevant parties a notice stating”, substitute “notify the
5 relevant parties”.

6 **190 Paragraph 69(3)(a)**

7 Omit “inform”, substitute “notify”.

8 **191 Paragraph 138(2)(a)**

9 Omit “advise”, substitute “notify”.

10 **192 Before section 145**

11 Insert:

12 **144D Notifications by Registrar under this Act or regulations**

13 If under this Act or the regulations the Registrar is required or
14 permitted:

15 (a) to notify a person of a matter; or

16 (b) to notify a person that the person is required to do a thing;

17 the Registrar may so notify the person by any means of
18 communication (including by electronic means).

19 Note: Section 145 deals with the service etc. of documents on a person.

20 ***Patents Act 1990***

21 **193 Subsection 27(2)**

22 Repeal the subsection, substitute:

23 (2) The Commissioner must:

24 (a) notify the applicant for the patent of any matter of which the
25 Commissioner is notified under subsection (1); and

26 (b) give the applicant for the patent a copy of any document
27 accompanying the notice under subsection (1).

EXPOSURE DRAFT

Schedule 1 Amendments

Part 4 Written requirements

1 (2A) Without limiting paragraph (2)(b), the Commissioner may give the
2 copy by:

3 (a) making the copy available to the person in an electronic
4 form; and

5 (b) notifying the person that the copy is available.

6 **194 Subsection 28(4)**

7 Repeal the subsection, substitute:

8 *Commissioner must notify patentee of notice given*

9 (4) The Commissioner must:

10 (a) notify the patentee of any matter of which the Commissioner
11 is notified under subsection (1); and

12 (b) give the patentee a copy of any document accompanying the
13 notice under subsection (1).

14 (4A) Without limiting paragraph (4)(b), the Commissioner may give the
15 copy by:

16 (a) making the copy available to the patentee in an electronic
17 form; and

18 (b) notifying the patentee that the copy is available.

19 **195 Paragraph 49(5)(a)**

20 Omit “in writing”.

21 **196 Subsection 49(7)**

22 Omit “in writing”.

23 **197 Paragraphs 74(2)(a) and (4)(a)**

24 Omit “in writing”.

25 **198 Subsection 76(2)**

26 Omit “in writing”.

27 **199 Paragraph 101E(1)(a)**

28 Omit “in writing”.

EXPOSURE DRAFT

Amendments **Schedule 1**
Written requirements **Part 4**

1 **200 Subsection 101E(3)**

2 Repeal the subsection.

3 **201 After section 220**

4 Insert:

5 **220A Notifications by Commissioner under this Act**

6 If under this Act the Commissioner is required or permitted:

7 (a) to notify a person of a matter; or

8 (b) to notify a person that the person is required to do a thing;
9 the Commissioner may so notify the person by any means of
10 communication (including by electronic means).

11 Note 1: A reference to this Act includes the regulations (see Schedule 1).

12 Note 2: Section 221 deals with the service etc. of documents on a person.

13 ***Plant Breeder's Rights Act 1994***

14 **202 Subsection 19(6)**

15 Omit “give the grantee”.

16 **203 Paragraph 19(6)(a)**

17 Before “a”, insert “give the grantee”.

18 **204 Paragraph 19(6)(b)**

19 Omit “a written invitation”, substitute “by notification to the grantee,
20 invite the grantee”.

21 **205 Paragraph 19(7)(b)**

22 Omit “give written notice of the decision to the grantee and to the
23 person making the request”, substitute “notify the grantee, and the
24 person making the request, of the decision”.

25 **206 Subparagraph 19(9)(b)(i)**

26 Omit “given written notice to”, substitute “notified”.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 4 Written requirements

1 **207 Subsection 21(3)**

2 Omit “give written notice to the claimant and to the person who was the
3 holder before the entry was made, stating that the entry has been made”,
4 substitute “notify the claimant, and the person who was the holder
5 before the entry was made, that the entry has been made”.

6 **208 Paragraph 21(4)(a)**

7 Omit “give written notice to”, substitute “notify”.

8 **209 Subparagraph 21(4)(a)(i)**

9 Omit “telling the claimant”.

10 **210 Subparagraph 21(4)(a)(ii)**

11 Omit “setting out”, substitute “of”.

12 **211 Paragraph 21(4)(b)**

13 Omit “give written notice to”, substitute “notify”.

14 **212 Subparagraph 21(4)(b)(i)**

15 Omit “setting out”, substitute “of the”.

16 **213 Subparagraph 21(4)(b)(ii)**

17 Omit “telling the claimant”.

18 **214 Subparagraph 21(4)(b)(iii)**

19 Omit “setting out”, substitute “of”.

20 **215 Paragraph 30(4)(a)**

21 Omit “give written notice to the applicant telling the applicant”,
22 substitute “notify the applicant”.

23 **216 Paragraph 30(5)(a)**

24 Omit “give written notice to the applicant telling the applicant”,
25 substitute “notify the applicant”.

26 **217 Paragraph 30(5)(a)**

27 Omit “setting out”, substitute “of”.

EXPOSURE DRAFT

Amendments **Schedule 1**
Written requirements **Part 4**

1 **218 Subsection 32(1)**
2 Omit “give written notice to”, substitute “notify”.

3 **219 Subsection 32(1)**
4 Omit “telling the person”.

5 **220 Subsection 32(2)**
6 Omit “give written notice to”, substitute “notify”.

7 **221 Paragraph 32(2)(a)**
8 Omit “telling the person”.

9 **222 Paragraph 32(2)(b)**
10 Omit “setting out”, substitute “of”.

11 **223 Subsection 32(3)**
12 Omit “give written notice to”, substitute “notify”.

13 **224 Paragraph 32(3)(a)**
14 Omit “setting out”, substitute “of the”.

15 **225 Paragraph 32(3)(b)**
16 Omit “telling the applicant”.

17 **226 Paragraph 32(3)(c)**
18 Omit “setting out”, substitute “of”.

19 **227 Subsection 32(4)**
20 Omit “give written notice of”, substitute “notify”.

21 **228 Paragraphs 37(1)(d) and (e)**
22 Omit “give written notice of”, substitute “notify”.

23 **229 Subsection 37(2)**
24 Omit “notice”, substitute “notification”.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 4 Written requirements

1 **230 Subsection 37(2A)**

2 Omit “a notice is sent”, substitute “a notification is given”.

3 **231 Subsection 37(2A)**

4 Omit “the requirements of the notice”, substitute “the requirements of
5 the notification”.

6 **232 Paragraph 37(2A)(a)**

7 Omit “of service of the notice”, substitute “the notification is given”.

8 **233 Subsection 37(2B)**

9 Omit “notice issued”, substitute “notification given”.

10 **234 Paragraph 37(2B)(a)**

11 Omit “notice”, substitute “notification”.

12 **235 Subsection 37(3)**

13 Omit “notice”, substitute “notification”.

14 **236 Paragraph 39(1)(b)**

15 Omit “notice” (wherever occurring), substitute “notification”.

16 **237 Subsection 39(2)**

17 Omit “, in writing,”.

18 **238 Subsection 39(2)**

19 Omit “notice”, substitute “notification”.

20 **239 Subsection 39(3)**

21 Omit “notice” (wherever occurring), substitute “notification”.

22 **240 Subsection 40(6)**

23 Omit “refuse to declare the second variety essentially derived from”.

24 **241 Paragraph 40(6)(a)**

25 Before “the”, insert “refuse to declare the second variety essentially
26 derived from”.

EXPOSURE DRAFT

Amendments **Schedule 1**
Written requirements **Part 4**

1 **242 Paragraph 40(6)(b)**

2 Omit “inform the applicant for the declaration in writing, to that effect,
3 and give the applicant”, substitute “notify the applicant for the
4 declaration of the decision and of the”.

5 **243 Paragraphs 40(8)(a) and (b)**

6 Omit “inform”, substitute “notify”.

7 **244 Paragraph 40(8)(b)**

8 Omit “informed”, substitute “notified”.

9 **245 Subsection 40(9)**

10 Omit “inform the applicant, in writing, to that effect, and give the
11 applicant”, substitute “notify the applicant of the decision and of the”.

12 **246 Paragraph 40(10)(e)**

13 Omit “by notice in writing given to”, substitute “notify”.

14 **247 Paragraph 40(10)(e)**

15 Omit “, tell that grantee”.

16 **248 Paragraph 40(10)(f)**

17 Omit “by notice in writing given to”, substitute “notify”.

18 **249 Paragraph 40(10)(f)**

19 Omit “, tell that grantee of the declaration and set out”, substitute “of
20 the declaration and of”.

21 **250 Paragraph 40(11)(a)**

22 Omit “by notice in writing given to”, substitute “notify”.

23 **251 Paragraph 40(11)(a)**

24 Omit “, tell that grantee that he or she is so satisfied and set out”,
25 substitute “that he or she is so satisfied and of”.

26 **252 Paragraph 40(11)(b)**

27 Omit “by notice in writing given to”, substitute “notify”.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 4 Written requirements

1 **253 Paragraph 40(11)(b)**

2 Omit “, tell that grantee”.

3 **254 Subsection 41(1)**

4 Omit “give notice of”, substitute “notify”.

5 **255 Subsection 41(2)**

6 Omit “notice”, substitute “notification”.

7 **256 Subsection 41(5)**

8 Omit “subsection 40(8) has effect as if the reference in that subsection
9 to 30 days after being so informed were a reference to 30 days after
10 being informed”, substitute “paragraph 40(8)(b) has effect as if the
11 reference in that paragraph to 30 days after being so notified were a
12 reference to 30 days after being notified”.

13 **257 Subsection 44(12)**

14 Omit “give written notice to”, substitute “notify”.

15 **258 Paragraph 44(12)(a)**

16 Omit “telling the applicant”.

17 **259 Paragraph 44(12)(b)**

18 Omit “setting out”, substitute “of”.

19 **260 Paragraph 50(2)(aa)**

20 Omit “notice”, substitute “notification”.

21 **261 Subsection 50(3)**

22 Omit “by notice given to the grantee of the right that has been revoked
23 or of the right that is affected by the giving of the declaration of
24 essential derivation, tell that grantee of the decision and set out the
25 reasons for the revocation”, substitute “notify the decision, and the
26 reasons for the decision, to the grantee of the right that has been
27 revoked or to the grantee of the right that was affected by the giving of
28 the declaration of essential derivation”.

EXPOSURE DRAFT

Amendments **Schedule 1**
Written requirements **Part 4**

1 **262 Subsection 50(10)**

2 Omit “by notice in writing to”, substitute “notify”.

3 **263 Subsection 50(10)**

4 Omit “, tell the person of the decision and set out”, substitute “of the
5 decision and of”.

6 **264 After section 72**

7 Insert:

8 **72A Notifications by Registrar under this Act or regulations**

9 If under this Act or the regulations the Registrar is required or
10 permitted:

11 (a) to notify a person of a matter; or

12 (b) to notify a person that the person is required to do a thing;

13 the Registrar may so notify the person by any means of
14 communication (including by electronic means).

15 Note: Section 73 deals with the service etc. of documents on a person.

16 **265 Subparagraph 77(1)(b)(xi)**

17 Omit “issue a notice”, substitute “give a notification”.

18 ***Trade Marks Act 1995***

19 **266 Section 34 (heading)**

20 Repeal the heading, substitute:

21 **34 Notification of decision**

22 **267 Paragraph 34(a)**

23 Omit “in writing”.

24 **268 Subsection 77(2)**

25 Omit “notice”, substitute “notification”.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 4 Written requirements

1 **269 Section 80C (heading)**

2 Repeal the heading, substitute:

3 **80C Notification about renewal**

4 **270 Subsection 80E(2)**

5 Omit “notice”, substitute “notification”.

6 **271 Subsection 84A(4)**

7 Omit “notice”, substitute “notification”.

8 **272 Subsection 84A(4)**

9 Omit “in accordance with the regulations”.

10 **273 Subsection 95(1)**

11 Omit “notice”, substitute “a copy”.

12 **274 Section 111 (heading)**

13 Repeal the heading, substitute:

14 **111 Notification of application to be given to person recorded as**
15 **claiming interest in trade mark etc.**

16 **275 Paragraph 176(3)(a)**

17 Repeal the paragraph, substitute:

18 (a) notify the applicant of the Registrar’s decision under this
19 section; and

20 **276 After section 214**

21 Insert:

22 **214A Notifications by Registrar under this Act**

23 If under this Act the Registrar is required or permitted:

24 (a) to notify a person of a matter; or

25 (b) to notify a person that the person is required to do a thing;

the Registrar may so notify the person by any means of communication (including by electronic means).

Note 1: A reference to this Act includes the regulations (see section 6).

Note 2: Section 215 deals with the service etc. of documents on a person.

Division 2—Application and saving provisions

277 Designs

(1) The amendments of sections 24, 41, 42, 43, 52, 66, 67, 68, 69 and 138 of the *Designs Act 2003* made by this Part apply in relation to notifications occurring on or after the commencement of this item.

(2) The *Designs Act 2003*, as in force immediately before the commencement of this item, continues to apply on and after that commencement in relation to a notice given under subsection 24(1) or (2), section 41, paragraph 52(3)(a), subsection 66(2) or 67(2) or paragraph 68(2)(a) of that Act before that commencement.

278 Patents

The amendments of sections 27, 28, 49, 74 and 76 of the *Patents Act 1990* made by this Part apply in relation to notifications occurring on or after the commencement of this item.

279 Plant breeder's rights

(1) The amendment of paragraph 19(6)(b) of the *Plant Breeder's Rights Act 1994* made by this Part applies in relation to invitations made on or after the commencement of this item.

(2) The amendments of paragraph 19(7)(b), subparagraph 19(9)(b)(i) and sections 21, 30, 32, 37, 39, 40, 41, 44 and 50 of the *Plant Breeder's Rights Act 1994* made by this Part apply in relation to notifications occurring on or after the commencement of this item.

(3) The *Plant Breeder's Rights Act 1994*, as in force immediately before the commencement of this item, continues to apply on and after that commencement in relation to a notice given under paragraph 19(7)(b), subparagraph 19(9)(b)(i), subsection 21(3), paragraph 21(4)(a) or (b) or 30(4)(a) or (5)(a), subsection 32(1), (2), (3) or (4), section 37, subsection 39(2), paragraph 40(10)(e) or (f) or (11)(a) or (b) or

EXPOSURE DRAFT

Schedule 1 Amendments

Part 4 Written requirements

1 subsection 41(1), 44(12) or 50(3) or (10) of that Act before that
2 commencement.

3 **280 Trade marks**

- 4 (1) The amendments of sections 34, 77, 80E, 84A and 176 of the *Trade*
5 *Marks Act 1995* made by this Part apply in relation to notifications
6 occurring on or after the commencement of this item.
- 7 (2) The *Trade Marks Act 1995*, as in force immediately before the
8 commencement of this item, continues to apply on and after that
9 commencement in relation to a notice given under subsection 77(2),
10 80E(2) or 84A(4) or paragraph 176(3)(a) of that Act before that
11 commencement.

1 **Part 5—Filing requirements**

2 **Division 1—Amendments**

3 ***Designs Act 2003***

4 **281 Section 5**

5 Insert:

6 ***preferred means:***

- 7 (a) in relation to filing a document with the Designs Office—
8 means the means specified under subsection 144A(4); or
9 (b) in relation to paying a fee—means the means specified under
10 subsection 130A(4).

11 **282 After subsection 69(2)**

12 Insert:

13 (2A) A person must not provide to the Registrar material in the form of
14 a physical article, other than a document, unless the Registrar has
15 given the person an approval to do so.

16 (2B) If a person provides material to the Registrar under subsection (1),
17 the material may be accompanied by evidence, in the form of a
18 declaration, of the publication of the material.

19 Note: The regulations deal with the making of declarations.

20 **283 After subsection 130(2)**

21 Insert:

22 (2A) Without limiting subsection (1), different fees may be prescribed
23 for filing a document with the Designs Office according to the
24 means by which the document is filed.

25 (2B) Without limiting subsection (1), different amounts of a fee may be
26 prescribed according to the means by which the fee is paid.

EXPOSURE DRAFT

Schedule 1 Amendments Part 5 Filing requirements

1 *Means of paying fee*

2 (2C) A fee must be paid by a means determined in an instrument under
3 section 130A.

4 *Fees payable in accordance with the regulations*

5 **284 Before subsection 130(4)**

6 Insert:

7 *Consequences of failure to pay fee*

8 **285 At the end of Part 2 of Chapter 11**

9 Add:

10 **130A Approved means of paying a fee**

11 (1) For the purposes of subsection 130(2C), the Registrar may, by
12 writing, determine one or more means for paying a fee.

13 (2) The means may be an electronic means or any other means.

14 (3) The Registrar must publish a notice, in accordance with
15 section 148A, setting out the determination.

16 (4) The Registrar may, in a determination under subsection (1), specify
17 that one or more means for paying a fee are preferred means.

18 Note: Under the regulations, the amount of a fee may be reduced for paying
19 the fee by preferred means.

20 (5) A determination under subsection (1) is not a legislative
21 instrument.

22 **286 Section 144**

23 Repeal the section, substitute:

24 **144 Filing of documents**

25 For the purposes of this Act and the regulations, a document may
26 be filed with the Designs Office by a means determined in an
27 instrument under subsection 144A(1).

144A Approved means of filing documents

(1) For the purposes of section 144, the Registrar may, by writing, determine one or more means for filing a document with the Designs Office.

(2) The means may be an electronic means or any other means.

(3) The Registrar must publish a notice, in accordance with section 148A, setting out the determination.

(4) The Registrar may, in a determination under subsection (1), specify that one or more means for filing a document with the Designs Office are preferred means.

Note: Under the regulations, reduced fees may be payable for filing a document by preferred means.

(5) A determination under subsection (1) is not a legislative instrument.

144B Directions by Registrar for filing of documents

(1) The Registrar may, by writing, give a direction specifying the form in which a document is to be filed under this Act or the regulations.

Note: See also paragraph 149(2)(aa) (about regulations).

(2) Subsection (1) does not apply in relation to a document that is required, under the regulations, to be in an approved form.

(3) The Registrar must publish a notice, in accordance with section 148A, setting out the direction.

(4) A direction under subsection (1) is not a legislative instrument.

144C Directions by Registrar for filing of evidence

(1) The Registrar may, by writing, give a direction in relation to the filing of evidence in connection with a matter arising under this Act or the regulations.

Note: See also paragraph 149(2)(ab) (about regulations).

EXPOSURE DRAFT

Schedule 1 Amendments Part 5 Filing requirements

- 1 (2) Without limiting subsection (1), a direction under that subsection
2 may relate to the following:
3 (a) the number of copies of evidence to be filed;
4 (b) the form in which evidence is to be filed (including the
5 circumstances in which physical articles, other than
6 documents, are or are not permitted to be filed);
7 (c) the means by which evidence is to be filed.
- 8 (3) Without limiting paragraph (2)(b), a direction under subsection (1)
9 may require that evidence in writing be in the form of a
10 declaration.
- 11 (4) This section does not apply in relation to the provision of material
12 under section 69 (about material relating to whether a registered
13 design is new or distinctive).
- 14 (5) The Registrar must publish a notice, in accordance with
15 section 148A, setting out a direction under subsection (1) of this
16 section.
- 17 (6) A direction under subsection (1) is not a legislative instrument.

287 Before paragraph 149(2)(a)

- 18 Insert:
19
20 (aa) making provision for and in relation to the following:
21 (i) the requirements for filing a document under this Act or
22 the regulations (including the requirement that the
23 document must be in the form (if any) specified in a
24 direction under section 144B);
25 (ii) the consequences of a document not being in
26 accordance with an approved form or not complying
27 with the requirements referred to in subparagraph (i);
28 and
29 (ab) making provision for and in relation to the consequences of
30 not complying with a direction under section 144C; and

31 *Patents Act 1990*

32 288 Section 3 (list of definitions)

- 33 Insert “preferred means”.
-

1 **289 Subsection 214(1)**

2 Omit all the words after “A document”, substitute “under this Act may
3 be filed with the Patent Office by a means determined in an instrument
4 under subsection 214A(1)”.

5 **290 After section 214**

6 Insert:

7 **214A Approved means of filing documents**

8 (1) For the purposes of subsection 214(1), the Commissioner may, by
9 writing, determine one or more means for filing a document with
10 the Patent Office.

11 (2) The means may be an electronic means or any other means.

12 (3) The Commissioner must publish a notice in the *Official Journal*
13 setting out the determination.

14 (4) The Commissioner may, in a determination under subsection (1),
15 specify that one or more means for filing a document with the
16 Patent Office are preferred means.

17 Note: Under the regulations, reduced fees may be payable for filing a
18 document by preferred means.

19 (5) A determination under subsection (1) is not a legislative
20 instrument.

21 **291 Before section 215**

22 Insert:

23 **214B Directions by Commissioner for filing of documents**

24 (1) The Commissioner may, by writing, give a direction specifying the
25 form in which a document is to be filed under this Act.

26 Note 1: A reference to this Act includes the regulations (see Schedule 1).

27 Note 2: See also paragraph 228(2)(ba) (about regulations).

28 (2) Subsection (1) does not apply in relation to a document that is
29 required to be in an approved form.

EXPOSURE DRAFT

Schedule 1 Amendments Part 5 Filing requirements

1 (3) The Commissioner must publish a notice in the *Official Journal*
2 setting out the direction.

3 (4) A direction under subsection (1) is not a legislative instrument.

4 **214C Directions by Commissioner for filing of evidence**

5 (1) The Commissioner may, by writing, give a direction in relation to
6 the filing of evidence in connection with a matter arising under this
7 Act.

8 Note 1: A reference to this Act includes the regulations (see Schedule 1).

9 Note 2: See also paragraph 228(2)(bb) (about regulations).

10 (2) Without limiting subsection (1), a direction under that subsection
11 may relate to the following:

12 (a) the number of copies of evidence to be filed;

13 (b) the form in which evidence is to be filed (including the
14 circumstances in which physical articles, other than
15 documents, are or are not permitted to be filed);

16 (c) the means by which evidence is to be filed.

17 (3) Without limiting paragraph (2)(b), a direction under subsection (1)
18 may require that evidence in writing be in the form of a
19 declaration.

20 (4) The Commissioner must publish a notice in the *Official Journal*
21 setting out a direction under subsection (1).

22 (5) A direction under subsection (1) is not a legislative instrument.

23 **292 After subsection 227(2)**

24 Insert:

25 (2A) Without limiting subsection (1), different fees may be prescribed
26 for filing a document with the Patent Office according to the means
27 by which the document is filed.

28 (2B) Without limiting subsection (1), different amounts of a fee may be
29 prescribed according to the means by which the fee is paid.

30 (2C) A fee must be paid by a means determined in an instrument under
31 section 227AAA.

EXPOSURE DRAFT

Amendments **Schedule 1**
Filing requirements **Part 5**

1 **293 After section 227**

2 Insert:

3 **227AAA Approved means of paying a fee**

4 (1) For the purposes of subsection 227(2C), the Commissioner may,
5 by writing, determine one or more means for paying a fee.

6 (2) The means may be an electronic means or any other means.

7 (3) The Commissioner must publish a notice in the *Official Journal*
8 setting out the determination.

9 (4) The Commissioner may, in a determination under subsection (1),
10 specify that one or more means for paying a fee are preferred
11 means.

12 Note: Under the regulations, the amount of a fee may be reduced for paying
13 the fee by preferred means.

14 (5) A determination under subsection (1) is not a legislative
15 instrument.

16 **294 After paragraph 228(2)(b)**

17 Insert:

18 (ba) making provision for and in relation to the following:

19 (i) the requirements for filing a document under this Act
20 (including the requirement that the document must be in
21 the form (if any) specified in a direction under
22 section 214B);

23 (ii) the consequences of a document not being in
24 accordance with an approved form or not complying
25 with the requirements referred to in subparagraph (i);
26 and

27 (bb) making provision for and in relation to the consequences of
28 not complying with a direction under section 214C; and

29 **295 Schedule 1**

30 Insert:

31 ***preferred means:***

EXPOSURE DRAFT

Schedule 1 Amendments Part 5 Filing requirements

- 1 (a) in relation to filing a document with the Patent Office—
2 means the means specified under subsection 214A(4); or
3 (b) in relation to paying a fee—means the means specified under
4 subsection 227AAA(4).

5 *Plant Breeder's Rights Act 1994*

6 **296 Subsection 3(1)**

7 Insert:

8 *preferred means:*

- 9 (a) in relation to lodging a document with, or giving a document
10 to, the Registrar—means the means specified under
11 subsection 72C(4); or
12 (b) in relation to paying a fee—means the means specified under
13 subsection 80A(4).

14 **297 Subsection 26(1)**

15 Repeal the subsection, substitute:

- 16 (1) An application for PBR in a plant variety must be in the approved
17 form.

18 **298 Subsection 34(3)**

19 Repeal the subsection, substitute:

- 20 (3) The detailed description must be in the approved form.

21 **299 Subsection 40(4)**

22 Repeal the subsection, substitute:

- 23 (4) An application for a declaration of essential derivation must:
24 (a) be in the approved form; and
25 (b) be accompanied by the prescribed fee in respect of the
26 application.

27 **300 Before section 73**

28 Insert:

EXPOSURE DRAFT

Amendments **Schedule 1**
Filing requirements **Part 5**

1 **72B Manner in which documents may be lodged with or given to**
2 **Registrar**

3 For the purposes of this Act and the regulations, a document may
4 be lodged with, or given to, the Registrar by a means determined in
5 an instrument under subsection 72C(1).

6 **72C Approved means of lodging or giving documents**

7 (1) For the purposes of section 72B, the Registrar may, by writing,
8 determine one or more means for lodging a document with, or
9 giving a document to, the Registrar.

10 (2) The means may be an electronic means or any other means.

11 (3) The Registrar must give public notice setting out the determination.

12 (4) The Registrar may, in a determination under subsection (1), specify
13 that one or more means for lodging a document with, or giving a
14 document to, the Registrar are preferred means.

15 Note: Under the regulations, reduced fees may be payable for lodging or
16 giving a document by preferred means.

17 (5) A determination under subsection (1) is not a legislative
18 instrument.

19 **301 At the end of subparagraph 80(2)(a)(iv)**

20 Add “and”.

21 **302 After subparagraph 80(2)(a)(iv)**

22 Insert:

23 (v) different fees for lodging a document with, or giving a
24 document to, the Registrar according to the means by
25 which the document is lodged or given; and

26 (vi) different amounts of a fee according to the means by
27 which the fee is paid;

28 **303 Paragraph 80(2)(a)**

29 Omit “and the manner of payment of such fees”.

EXPOSURE DRAFT

Schedule 1 Amendments Part 5 Filing requirements

304 At the end of section 80

Add:

- (3) A fee must be paid by a means determined in an instrument under section 80A.

305 At the end of Part 8

Add:

80A Approved means of paying a fee

- (1) For the purposes of subsection 80(3), the Registrar may, by writing, determine one or more means for paying a fee.
- (2) The means may be an electronic means or any other means.
- (3) The Registrar must give public notice setting out the determination.
- (4) The Registrar may, in a determination under subsection (1), specify that one or more means for paying a fee are preferred means.
- Note: Under the regulations, the amount of a fee may be reduced for paying the fee by preferred means.
- (5) A determination under subsection (1) is not a legislative instrument.

Trade Marks Act 1995

306 Readers guide (list of terms defined in section 6)

Insert “preferred means”.

307 Subsection 6(1)

Insert:

preferred means:

- (a) in relation to filing a document with the Trade Marks Office—means the means specified under subsection 213A(4); or
- (b) in relation to paying a fee—means the means specified under subsection 223AA(4).

1 **308 Paragraph 52(2)(a)**

2 Omit “manner and”.

3 **309 Subsection 52A(2)**

4 Omit “in the prescribed manner and”.

5 **310 Paragraph 54A(1)(b)**

6 Omit “in the prescribed manner or”.

7 **311 Paragraph 96(2)(a)**

8 Omit “manner and”.

9 **312 Section 213**

10 Repeal the section, substitute:

11 **213 Filing of documents**

12 For the purposes of this Act, a document may be filed with the
13 Trade Marks Office by a means determined in an instrument under
14 subsection 213A(1).

15 **213A Approved means of filing documents**

16 (1) For the purposes of section 213, the Registrar may, by writing,
17 determine one or more means for filing a document with the Trade
18 Marks Office.

19 (2) The means may be an electronic means or any other means.

20 (3) The Registrar must publish a notice, in accordance with
21 section 230A, setting out the determination.

22 (4) The Registrar may, in a determination under subsection (1), specify
23 that one or more means for filing a document with the Trade Marks
24 Office are preferred means.

25 Note: Under the regulations, reduced fees may be payable for filing a
26 document by preferred means.

27 (5) A determination under subsection (1) is not a legislative
28 instrument.

EXPOSURE DRAFT

Schedule 1 Amendments Part 5 Filing requirements

313 Before section 214

Insert:

213B Directions by Registrar for filing of documents

- (1) The Registrar may, by writing, give a direction specifying the form in which a document is to be filed under this Act.

Note 1: A reference to this Act includes the regulations (see section 6).

Note 2: See also paragraph 231(2)(ba) (about regulations).

- (2) Subsection (1) does not apply in relation to a document that is required to be in an approved form.

- (3) The Registrar must publish a notice, in accordance with section 230A, setting out the direction.

- (4) A direction under subsection (1) is not a legislative instrument.

213C Directions by Registrar for filing of evidence

- (1) The Registrar may, by writing, give a direction in relation to the filing of evidence in connection with a matter arising under this Act.

Note 1: A reference to this Act includes the regulations (see section 6).

Note 2: See also paragraph 231(2)(bb) (about regulations).

- (2) Without limiting subsection (1), a direction under that subsection may relate to the following:

- (a) the number of copies of evidence to be filed;
- (b) the form in which evidence is to be filed (including the circumstances in which physical articles, other than documents, are or are not permitted to be filed);
- (c) the means by which evidence is to be filed.

- (3) Without limiting paragraph (2)(b), a direction under subsection (1) may require that evidence in writing be in the form of a declaration.

1 (4) The Registrar must publish a notice, in accordance with
2 section 230A, setting out a direction under subsection (1) of this
3 section.

4 (5) A direction under subsection (1) is not a legislative instrument.

5 **314 After subsection 223(2)**

6 Insert:

7 (2A) Without limiting subsection (1), different fees may be prescribed
8 for filing a document with the Trade Marks Office according to the
9 means by which the document is filed.

10 (2B) Without limiting subsection (1), different amounts of a fee may be
11 prescribed according to the means by which the fee is paid.

12 *Means of paying fee*

13 (2C) A fee that must be paid to the Registrar must be paid by a means
14 determined in an instrument under section 223AA.

15 *Consequences of failure to pay fee*

16 **315 After section 223**

17 Insert:

18 **223AA Approved means of paying a fee**

19 (1) For the purposes of subsection 223(2C), the Registrar may, by
20 writing, determine one or more means for paying a fee.

21 (2) The means may be an electronic means or any other means.

22 (3) The Registrar must publish a notice, in accordance with
23 section 230A, setting out the determination.

24 (4) The Registrar may, in a determination under subsection (1), specify
25 that one or more means for paying a fee are preferred means.

26 Note: Under the regulations, the amount of a fee may be reduced for paying
27 the fee by preferred means.

EXPOSURE DRAFT

Schedule 1 Amendments Part 5 Filing requirements

- 1 (5) A determination under subsection (1) is not a legislative
2 instrument.

3 **316 Before paragraph 231(2)(c)**

4 Insert:

- 5 (ba) provide for and in relation to the following:
6 (i) the requirements for filing a document under this Act
7 (including the requirement that the document must be in
8 the form (if any) specified in a direction under
9 section 213B);
10 (ii) the consequences of a document not being in
11 accordance with an approved form or not complying
12 with the requirements referred to in subparagraph (i);
13 and
14 (bb) provide for and in relation to the consequences of not
15 complying with a direction under section 213C; and

16 **Division 2—Application, saving and transitional** 17 **provisions**

18 **317 Designs**

- 19 (1) The amendment of section 69 of the *Designs Act 2003* made by this Part
20 applies in relation to the provision of material to the Registrar on or
21 after the commencement of this item.
- 22 (2) Subsection 130(2C) of the *Designs Act 2003*, as inserted by this Part,
23 applies in relation to fees paid on or after the commencement of this
24 item.
- 25 (3) Section 144 of the *Designs Act 2003*, as substituted by this Part, applies
26 in relation to documents filed on or after the commencement of this
27 item.
- 28 (4) Section 144B of the *Designs Act 2003*, as inserted by this Part, applies
29 in relation to documents filed on or after the commencement of this
30 item.
- 31 (5) Section 144C of the *Designs Act 2003*, as inserted by this Part, applies
32 in relation to evidence filed on or after the commencement of this item.

EXPOSURE DRAFT

Amendments **Schedule 1**
Filing requirements **Part 5**

318 Patents

- (1) The amendment of section 214 of the *Patents Act 1990* made by this Part applies in relation to documents filed on or after the commencement of this item.
- (2) Section 214B of the *Patents Act 1990*, as inserted by this Part, applies in relation to documents filed on or after the commencement of this item.
- (3) Section 214C of the *Patents Act 1990*, as inserted by this Part, applies in relation to evidence filed on or after the commencement of this item.
- (4) Subsection 227(2C) of the *Patents Act 1990*, as inserted by this Part, applies in relation to fees paid on or after the commencement of this item.

319 Plant breeder's rights

- (1) The repeal and substitution of subsection 26(1) of the *Plant Breeder's Rights Act 1994* made by this Part applies in relation to applications made on or after the commencement of this item.
- (2) An approved form that was in effect immediately before the commencement of this item for the purposes of paragraph 26(1)(b) of the *Plant Breeder's Rights Act 1994* continues in force on and after that commencement as if it were an approved form in effect for the purposes of subsection 26(1) of that Act.
- (3) The repeal and substitution of subsection 34(3) of the *Plant Breeder's Rights Act 1994* made by this Part applies in relation to detailed descriptions given on or after the commencement of this item.
- (4) An approved form that was in effect immediately before the commencement of this item for the purposes of paragraph 34(3)(b) of the *Plant Breeder's Rights Act 1994* continues in force on and after that commencement as if it were an approved form in effect for the purposes of subsection 34(3) of that Act.
- (5) The repeal and substitution of subsection 40(4) of the *Plant Breeder's Rights Act 1994* made by this Part applies in relation to applications made on or after the commencement of this item.

EXPOSURE DRAFT

Schedule 1 Amendments Part 5 Filing requirements

- 1 (6) An approved form that was in effect immediately before the
2 commencement of this item for the purposes of paragraph 40(4)(b) of
3 the *Plant Breeder's Rights Act 1994* continues in force on and after that
4 commencement as if it were an approved form in effect for the purposes
5 of paragraph 40(4)(a) of that Act.
- 6 (7) The repeal and substitution of subsection 40(4) of the *Plant Breeder's*
7 *Rights Act 1994* made by this Part does not affect the validity of any
8 regulations prescribing a fee for an application under subsection 40(1)
9 of that Act that were in force immediately before the commencement of
10 this item.
- 11 (8) Section 72B of the *Plant Breeder's Rights Act 1994*, as inserted by this
12 Part, applies in relation to documents lodged with, or given to, the
13 Registrar on or after the commencement of this item.
- 14 (9) Subsection 80(3) of the *Plant Breeder's Rights Act 1994*, as added by
15 this Part, applies in relation to fees paid on or after the commencement
16 of this item.

17 **320 Trade marks**

- 18 (1) Section 213 of the *Trade Marks Act 1995*, as substituted by this Part,
19 applies in relation to documents filed on or after the commencement of
20 this item.
- 21 (2) Section 213B of the *Trade Marks Act 1995*, as inserted by this Part,
22 applies in relation to documents filed on or after the commencement of
23 this item.
- 24 (3) Section 213C of the *Trade Marks Act 1995*, as inserted by this Part,
25 applies in relation to evidence filed on or after the commencement of
26 this item.
- 27 (4) Subsection 223(2C) of the *Trade Marks Act 1995*, as inserted by this
28 Part, applies in relation to fees paid on or after the commencement of
29 this item.

1 **Part 6—Official Journal**

2 **Division 1—Amendments**

3 *Designs Act 2003*

4 **321 Section 25**

5 Omit “in the manner prescribed by the regulations”, substitute “in
6 accordance with section 148A”.

7 **322 Section 31**

8 After “publish”, insert “, in accordance with section 148A,”.

9 **323 At the end of section 32**

10 Add:

11 (5) If a design is withdrawn, including a design disclosed in a design
12 application that is withdrawn, the Registrar must publish, in
13 accordance with section 148A, the fact of the withdrawal,
14 including the design number.

15 **324 Subsection 33(4)**

16 Omit “a notice stating”, substitute “the fact”.

17 **325 Subsection 33(4)**

18 Omit “notice must be in the form prescribed by”, substitute “publication
19 must be in accordance with”.

20 **326 Subsection 45(4)**

21 Omit “a notice stating”, substitute “, in accordance with section 148A,
22 the fact”.

23 **327 Subsection 45(4)**

24 Omit “The notice must be in the form”, substitute “The publication
25 must include the details”.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 6 Official Journal

1 **328 After paragraph 50(2)(a)**

2 Insert:

3 (aa) publish, in accordance with section 148A, the fact the offer
4 has been made; and

5 **329 Subsection 52(4)**

6 Omit “in the form prescribed by the regulations”, substitute “in
7 accordance with section 148A”.

8 **330 At the end of subsection 52(4)**

9 Add “The notice must include the details prescribed by the
10 regulations.”.

11 **331 Paragraph 67(3)(c)**

12 Omit “a notice, in the form prescribed by the regulations, stating”,
13 substitute “, in accordance with section 148A, the following
14 information”.

15 **332 Subparagraph 67(3)(c)(i)**

16 Omit “and”.

17 **333 At the end of paragraph 67(3)(c)**

18 Add:

19 ; (iii) the details prescribed by the regulations.

20 **334 Subsection 68(3)**

21 Omit “in the form prescribed by the regulations”, substitute “in
22 accordance with section 148A”.

23 **335 At the end of subsection 68(3)**

24 Add “The notice must include the details prescribed by the
25 regulations.”.

26 **336 Paragraph 116(b)**

27 Omit “a notice in the manner prescribed by the regulations, specifying”,
28 substitute “, in accordance with section 148A, details of”.

1 **337 Paragraph 136A(2)(b)**

2 Omit “in writing published in the prescribed way”, substitute “by notice
3 published in accordance with section 148A”.

4 **338 Paragraph 138(2)(b)**

5 Omit “a notice in the manner prescribed by the regulations”, substitute
6 “, in accordance with section 148A, the fact”.

7 **339 After section 148**

8 Insert:

9 **148A Electronic publication**

10 If a provision of this Act or the regulations requires or permits the
11 publishing or giving of information, or of a notice, in accordance
12 with this section, the information or notice must be published or
13 given:

- 14 (a) on IP Australia’s website; or
15 (b) by any other electronic means.

16 ***Olympic Insignia Protection Act 1987***

17 **340 Subsections 10(3) and (10)**

18 Omit “in the *Official Journal*”, substitute “in accordance with
19 section 14B”.

20 **341 Subsections 11(3), (8) and (9)**

21 Omit “in the *Official Journal*”, substitute “in accordance with
22 section 14B”.

23 **342 Subsection 11A(2)**

24 Omit “in the *Official Journal*”, substitute “in accordance with
25 section 14B”.

26 **343 Paragraph 14A(2)(b)**

27 Omit “in writing published in the prescribed way”, substitute “by notice
28 published in accordance with section 14B”.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 6 Official Journal

1 **344 At the end of Part 2.3**

2 Add:

3 **14B Electronic publication**

4 If a provision of this Act or the regulations requires or permits the
5 publishing or giving of information, or of a notice, in accordance
6 with this section, the information or notice must be published or
7 given:

- 8 (a) on IP Australia’s website; or
9 (b) by any other electronic means.

10 ***Patents Act 1990***

11 **345 Subsection 222(2)**

12 Omit “, and of complete specifications which are open to public
13 inspection”.

14 ***Trade Marks Act 1995***

15 **346 Readers guide (Appendix)**

16 Omit “advertised in the *Official Journal*”, substitute “published in
17 accordance with section 230A”.

18 **347 Readers guide (Appendix)**

19 Omit “advertise the registration in the *Official Journal*”, substitute
20 “publish details of the registration in accordance with section 230A”.

21 **348 Readers guide (list of terms defined in section 6)**

22 Omit “Official Journal”.

23 **349 Subsection 6(1) (definition of *Official Journal*)**

24 Repeal the definition.

25 **350 Paragraph 34(b)**

26 Repeal the paragraph, substitute:

- 1 (b) if the decision is to accept the application—publish, in
2 accordance with section 230A, the fact that the Registrar has
3 accepted the application (including the date of the
4 acceptance); and
5 (c) if the decision is to refuse the application—publish, in
6 accordance with section 230A, the fact that the Registrar has
7 refused the application.

8 **351 Section 65 (heading)**

9 Repeal the heading, substitute:

10 **65 Amendment after particulars of application have been**
11 **published—request for amendment not published**

12 **352 Section 65A (heading)**

13 Repeal the heading, substitute:

14 **65A Amendment after particulars of application have been**
15 **published—request for amendment published**

16 **353 Subsection 65A(3)**

17 Omit “advertise the request for the amendment in the *Official Journal*”,
18 substitute “publish, in accordance with section 230A, details of the
19 request for the amendment”.

20 **354 Paragraph 65A(5)(a)**

21 Omit “advertise”, substitute “publish details of”.

22 **355 Paragraph 71(a)**

23 Repeal the paragraph, substitute:

- 24 (a) publish, in accordance with section 230A, details of the
25 registration; and

26 **356 Subsection 83A(3)**

27 Omit “advertise the request for the amendment in the *Official Journal*”,
28 substitute “publish, in accordance with section 230A, details of the
29 request for the amendment”.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 6 Official Journal

1 **357 Subsection 83A(3) (note)**

2 Omit “advertise”, substitute “publish details of”.

3 **358 Paragraph 83A(7)(a)**

4 Omit “advertise”, substitute “publish details of”.

5 **359 Subsections 95(2) and (3)**

6 Omit “advertise the application in the *Official Journal*”, substitute
7 “publish, in accordance with section 230A, details of the application”.

8 **360 Subsection 110(3)**

9 Omit “advertise in the *Official Journal*”, substitute “publish, in
10 accordance with section 230A, the fact of”.

11 **361 Paragraph 175(4)(b)**

12 Omit “advertise the matter in the *Official Journal* in accordance with
13 the regulations”, substitute “publish, in accordance with section 230A
14 and the regulations, such details in relation to the decision not to give a
15 certificate as the Registrar considers appropriate”.

16 **362 Paragraph 176(3)(b)**

17 Repeal the paragraph, substitute:

18 (b) publish, in accordance with section 230A, such details in
19 relation to the decision as the Registrar considers appropriate.

20 **363 Paragraph 223A(2)(b)**

21 Omit “in writing published in the prescribed way”, substitute “by notice
22 published in accordance with section 230A”.

23 **364 Section 226 (heading)**

24 Repeal the heading, substitute:

25 **226 Publication and sale of documents**

26 **365 Subsection 226(1)**

27 Repeal the subsection.

1 **366 Subsection 226(3)**

2 Omit “(3)”.

3 **367 After section 230**

4 Insert:

5 **230A Electronic publication**

6 If a provision of this Act requires or permits the publishing or
7 giving of information, or of a notice, in accordance with this
8 section, the information or notice must be published or given:

- 9 (a) on IP Australia’s website; or
10 (b) by any other electronic means.

11 Note: A reference to this Act includes the regulations (see section 6).

12 **Division 2—Application provisions**

13 **368 Designs**

- 14 (1) The amendments of sections 25, 31, 33, 45, 52, 67, 68, 116, 136A and
15 138 of the *Designs Act 2003* made by this Part apply in relation to
16 publications occurring on or after the commencement of this item.
- 17 (2) The amendment of section 32 of the *Designs Act 2003* made by this Part
18 applies in relation to:
- 19 (a) a withdrawal made on or after the commencement of this
20 item; and
- 21 (b) a withdrawal made before the commencement of this item,
22 where the design number had not been published in the
23 *Official Journal* before that commencement.
- 24 (3) The amendment of section 50 of the *Designs Act 2003* made by this Part
25 applies in relation to:
- 26 (a) an offer received on or after the commencement of this item;
27 and
- 28 (b) an offer received before the commencement of this item,
29 where notice of the offer had not been published in the
30 *Official Journal* before that commencement.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 6 Official Journal

1 **369 Olympic designs**

2 The amendments of sections 10, 11, 11A and 14A of the *Olympic*
3 *Insignia Protection Act 1987* made by this Part apply in relation to
4 publications occurring on or after the commencement of this item.

5 **370 Trade marks**

6 The amendments of section 34, subsection 65A(3), section 71,
7 subsection 83A(3) and sections 95, 110, 175, 176 and 223A of the
8 *Trade Marks Act 1995* made by this Part apply in relation to
9 publications occurring on or after the commencement of this item.

1 **Part 7—Amendments of applications or other**
2 **documents**

3 **Division 1—Amendments**

4 ***Designs Act 2003***

5 **371 Before section 28**

6 Insert:

7 **27A Amendments by applicant or Registrar on own initiative**

8 *Amendments by applicant*

- 9 (1) For a design application, the applicant may amend the prescribed
10 particulars that are in the application or in any other document
11 accompanying the application (except in a way that changes the
12 identity of the applicant).

13 Note: Section 30 allows a person to ask the Registrar to direct that a design
14 application specify the person as an applicant or as an entitled person
15 in relation to a design disclosed in the application.

- 16 (2) The amendment must be:
17 (a) made by an electronic means approved in an instrument
18 under subsection (3); or
19 (b) made in accordance with the regulations.
- 20 (3) The Registrar may, by writing, approve one or more electronic
21 means for making an amendment under subsection (1).
- 22 (4) The Registrar must publish a notice, in accordance with
23 section 148A, setting out the approval.
- 24 (5) An approval under subsection (3) is not a legislative instrument.
- 25 (6) The Registrar may undo an amendment made under subsection (1)
26 if:

EXPOSURE DRAFT

Schedule 1 Amendments

Part 7 Amendments of applications or other documents

- 1 (a) the Registrar is satisfied that the effect of the amendment is
2 that the design application does not comply with the
3 minimum filing requirements; or
4 (b) the Registrar is satisfied, in all the circumstances, that the
5 amendment is inappropriate.

6 *Amendments by Registrar*

- 7 (7) For a design application, the Registrar may, on his or her own
8 initiative and for the purpose of correcting an obvious mistake,
9 amend the prescribed particulars that are in the application or in
10 any other document accompanying the application.
11 (8) If the Registrar does so, the Registrar must notify the applicant of
12 the amendment.

13 *Exceptions*

- 14 (9) Subsections (1) and (7) do not apply in relation to a design
15 application after the day a design disclosed in the application is
16 registered. This subsection does not limit subsection (10).
17 (10) The regulations may make provision for when subsection (1) or (7)
18 does not apply in relation to some or all of the particulars
19 prescribed for the purposes of that subsection.

20 **372 Section 28 (heading)**

21 Repeal the heading, substitute:

22 **28 Amendments by Registrar upon request of applicant**

23 **373 Subsection 28(1)**

24 After “design application”, insert “, or any other document
25 accompanying the application,”.

26 **374 After subsection 28(2)**

27 Insert:

- 28 (2A) Subsection (1) does not apply in relation to amendments to a
29 design application, or any other document accompanying the

EXPOSURE DRAFT

Amendments **Schedule 1**
Amendments of applications or other documents **Part 7**

1 application, if the amendments could be made under
2 subsection 27A(1).

3 **375 At the end of section 31**

4 Add “(other than under section 27A)”.

5 ***Trade Marks Act 1995***

6 **376 Before section 63**

7 Insert:

8 **62B Amendments of prescribed particulars in application for**
9 **registration of trade mark**

10 *Amendments by applicant*

11 (1) For an application for the registration of a trade mark, the
12 applicant, or the applicant’s agent, may amend the prescribed
13 particulars that are in the application (except in a way that changes
14 the identity of the applicant).

15 Note: Part 10 deals with the circumstances in which another person may
16 become the applicant for the registration of the trade mark.

17 (2) The amendment must be:

- 18 (a) made by an electronic means approved in an instrument
19 under subsection (3); or
20 (b) made by notice in the approved form given to the Registrar.

21 (3) The Registrar may, by writing, approve one or more electronic
22 means for making an amendment under subsection (1).

23 (4) The Registrar must publish a notice, in accordance with
24 section 230A, setting out the approval.

25 (5) An approval under subsection (3) is not a legislative instrument.

26 (6) The Registrar may undo an amendment made under subsection (1)
27 if:

- 28 (a) the Registrar is satisfied that the effect of the amendment is
29 that the application does not comply with section 27; or

EXPOSURE DRAFT

Schedule 1 Amendments

Part 7 Amendments of applications or other documents

- 1 (b) the Registrar is satisfied, in all the circumstances, that the
2 amendment is inappropriate.

3 *Amendments by Registrar*

- 4 (7) For an application for the registration of a trade mark, the Registrar
5 may, on his or her own initiative and for the purpose of correcting
6 an obvious mistake, amend the prescribed particulars that are in the
7 application.
- 8 (8) If the Registrar does so, the Registrar must notify the applicant, or
9 the applicant's agent, of the amendment.

10 *Exceptions*

- 11 (9) Subsections (1) and (7) do not apply in relation to an application
12 for the registration of a trade mark after the day the application is
13 accepted. This subsection does not limit subsection (11).
- 14 (10) However, subsection (9) ceases to apply in relation to the
15 application if the acceptance is revoked under section 38.
- 16 (11) The regulations may make provision for when subsection (1) or (7)
17 does not apply in relation to some or all of the particulars
18 prescribed for the purposes of that subsection.

19 **377 Section 63 (heading)**

20 Repeal the heading, substitute:

21 **63 Other amendments of application for registration of trade mark**

22 **378 After subsection 63(1)**

23 Insert:

- 24 (1A) Subsection (1) does not apply in relation to amendments to an
25 application for the registration of a trade mark if the amendments
26 could be made under subsection 62B(1).

27 **379 After subsection 66(1)**

28 Insert:

EXPOSURE DRAFT

Amendments **Schedule 1**
Amendments of applications or other documents **Part 7**

1 (1A) If a person has filed an application (other than an application for
2 the registration of a trade mark), a notice or other document for the
3 purposes of this Act, the Registrar may, on his or her own
4 initiative, amend the application, notice or document to correct a
5 clerical error or an obvious mistake.

6 Note: For *file* see section 6.

7 **380 Subsection 66(2)**

8 After “Subsection (1)”, insert “or (1A)”.

9 **Division 2—Application provisions**

10 **381 Designs**

11 (1) Section 27A of the *Designs Act 2003*, as inserted by this Part, applies on
12 and after the commencement of this item in relation to design
13 applications filed before, on or after that commencement.

14 (2) The amendments of section 28 of the *Designs Act 2003* made by this
15 Part apply in relation to requests made under subsection 28(1) of that
16 Act on or after the commencement of this item (whether the design
17 applications were filed before, on or after that commencement).

18 **382 Trade marks**

19 (1) Section 62B of the *Trade Marks Act 1995*, as inserted by this Part,
20 applies on and after the commencement of this item in relation to
21 applications for the registration of a trade mark made before, on or after
22 that commencement.

23 (2) The amendments of section 63 of the *Trade Marks Act 1995* made by
24 this Part apply in relation to requests made under subsection 63(1) of
25 that Act on or after the commencement of this item (whether the
26 applications for the registration of a trade mark were made before, on or
27 after that commencement).

28 (3) Subsection 66(1A) of the *Trade Marks Act 1995*, as inserted by this
29 Part, applies on and after the commencement of this item in relation to
30 an application, notice or other document filed before, on or after that
31 commencement.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 8 Signatures

1 **Part 8—Signatures**

2 *Patents Act 1990*

3 **383 Paragraph 151(4)(c)**

4 Omit “signed by the applicant”.

5 **384 Paragraph 176(c)**

6 Omit “signed by the applicant”.

7 **385 Application provision**

8 The amendments made by this Part apply in relation to a request
9 referred to in paragraph 151(4)(c) or 176(c) of the *Patents Act 1990*
10 filed on or after the commencement of this item.

Part 9—Computerised decision-making

Designs Act 2003

386 Section 129

After:

Part 3 contains offence provisions.

insert:

Part 3A deals with computerised decision-making.

387 After Part 3 of Chapter 11

Insert:

Part 3A—Computerised decision-making

135A Computerised decision-making

- (1) The Registrar may arrange for the use, under the Registrar's control, of computer programs for any purposes for which the Registrar may, or must, under this Act or the regulations:
 - (a) make a decision; or
 - (b) exercise any power or comply with any obligation; or
 - (c) do anything else related to making a decision to which paragraph (a) applies or related to exercising a power, or complying with an obligation, to which paragraph (b) applies.
- (2) Paragraphs (1)(a) and (b) apply only in relation to decisions, powers and obligations determined in a legislative instrument made by the Registrar for the purposes of this subsection.
- (3) For the purposes of this Act and the regulations, the Registrar is taken to have:

EXPOSURE DRAFT

Schedule 1 Amendments

Part 9 Computerised decision-making

- 1 (a) made a decision; or
2 (b) exercised a power or complied with an obligation; or
3 (c) done something else related to the making of a decision or
4 the exercise of a power or the compliance with an obligation;
5 that was made, exercised, complied with or done by the operation
6 of a computer program under an arrangement made under
7 subsection (1).

8 *Substituted decisions*

- 9 (4) The Registrar may substitute a decision for a decision the Registrar
10 is taken to have made under paragraph (3)(a) if the Registrar is
11 satisfied that the decision made by the operation of the computer
12 program is incorrect.

13 **388 After subsection 136(1)**

14 Insert:

15 (1A) If:

- 16 (a) the Registrar is taken to have made a decision (the ***initial***
17 ***decision***) under paragraph 135A(3)(a); and
18 (b) under subsection (1), a person may apply to the
19 Administrative Appeals Tribunal for review of the initial
20 decision; and
21 (c) the Registrar, under subsection 135A(4), substitutes a
22 decision for the initial decision;
23 a person may apply to the Administrative Appeals Tribunal for
24 review of the substituted decision.

25 **389 Subsection 136(2)**

26 Omit “If a decision mentioned in subsection (1) is made”, substitute “If,
27 under subsection (1) or (1A), a person may apply to the Administrative
28 Appeals Tribunal for review of a decision”.

29 ***Patents Act 1990***

30 **390 Before section 224**

31 Insert:

223J Computerised decision-making

(1) The Commissioner may arrange for the use, under the Commissioner's control, of computer programs for any purposes for which the Commissioner may, or must, under this Act:

- (a) make a decision; or
- (b) exercise any power or comply with any obligation; or
- (c) do anything else related to making a decision to which paragraph (a) applies or related to exercising a power, or complying with an obligation, to which paragraph (b) applies.

Note: A reference to this Act includes the regulations (see Schedule 1).

(2) Paragraphs (1)(a) and (b) apply only in relation to decisions, powers and obligations determined in a legislative instrument made by the Commissioner for the purposes of this subsection.

(3) For the purposes of this Act, the Commissioner is taken to have:

- (a) made a decision; or
- (b) exercised a power or complied with an obligation; or
- (c) done something else related to the making of a decision or the exercise of a power or the compliance with an obligation; that was made, exercised, complied with or done by the operation of a computer program under an arrangement made under subsection (1).

Substituted decisions

(4) The Commissioner may substitute a decision for a decision the Commissioner is taken to have made under paragraph (3)(a) if the Commissioner is satisfied that the decision made by the operation of the computer program is incorrect.

391 After subsection 224(1)

Insert:

(1A) If:

- (a) the Commissioner is taken to have made a decision (the **initial decision**) under paragraph 223J(3)(a); and

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Schedule 1 Amendments

Part 9 Computerised decision-making

- 1 (b) under subsection (1), application may be made to the
2 Administrative Appeals Tribunal for review of the initial
3 decision; and
4 (c) the Commissioner, under subsection 223J(4), substitutes a
5 decision for the initial decision;
6 application may be made to the Administrative Appeals Tribunal
7 for review of the substituted decision.

8 **392 Subsection 224(2)**

- 9 Omit “Where a person who makes a decision mentioned in
10 subsection (1) gives the person or persons affected by the decision
11 written notice of the making of the decision”, substitute “If, under
12 subsection (1) or (1A), application may be made to the Administrative
13 Appeals Tribunal for review of a decision and a written notice of the
14 decision is given to a person whose interests are affected by the
15 decision”.

16 ***Plant Breeder’s Rights Act 1994***

17 **393 Before section 77**

18 Insert:

19 **76J Computerised decision-making**

- 20 (1) The Registrar may arrange for the use, under the Registrar’s
21 control, of computer programs for any purposes for which the
22 Registrar may, or must, under this Act or the regulations:
23 (a) make a decision; or
24 (b) exercise any power or comply with any obligation; or
25 (c) do anything else related to making a decision to which
26 paragraph (a) applies or related to exercising a power, or
27 complying with an obligation, to which paragraph (b)
28 applies.
- 29 (2) Paragraphs (1)(a) and (b) apply only in relation to decisions,
30 powers and obligations determined in a legislative instrument made
31 by the Registrar for the purposes of this subsection.

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Amendments **Schedule 1**
Computerised decision-making **Part 9**

- 1 (3) For the purposes of this Act and the regulations, the Registrar is
2 taken to have:
3 (a) made a decision; or
4 (b) exercised a power or complied with an obligation; or
5 (c) done something else related to the making of a decision or
6 the exercise of a power or the compliance with an obligation;
7 that was made, exercised, complied with or done by the operation
8 of a computer program under an arrangement made under
9 subsection (1).

Substituted decisions

- 11 (4) The Registrar may substitute a decision for a decision the Registrar
12 is taken to have made under paragraph (3)(a) if the Registrar is
13 satisfied that the decision made by the operation of the computer
14 program is incorrect.

15 Note: A substituted decision under subsection (4) may be reviewable by the
16 AAT under section 77.

394 After subsection 77(1)

18 Insert:

19 (1A) If:

- 20 (a) the Registrar is taken to have made a decision (the ***initial***
21 ***decision***) under paragraph 76J(3)(a); and
22 (b) under subsection (1), applications may be made to the AAT
23 for review of the initial decision; and
24 (c) the Registrar, under subsection 76J(4), substitutes a decision
25 for the initial decision;
26 applications may be made to the AAT for review of the substituted
27 decision.

395 Subsection 77(2)

29 Omit “for a review of a decision referred to in subsection (1)”,
30 substitute “under subsection (1) or (1A) of this section for a review of a
31 decision”.

396 Paragraph 77(3)(a)

33 After “subsection (1)”, insert “or (1A)”.

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Schedule 1 Amendments

Part 9 Computerised decision-making

1 ***Trade Marks Act 1995***

2 **397 After Division 2 of Part 21**

3 Insert:

4 **Division 2A—Computerised decision-making**

5 **222A Computerised decision-making**

6 (1) The Registrar may arrange for the use, under the Registrar's
7 control, of computer programs for any purposes for which the
8 Registrar may, or must, under this Act:

9 (a) make a decision; or

10 (b) exercise any power or comply with any obligation; or

11 (c) do anything else related to making a decision to which
12 paragraph (a) applies or related to exercising a power, or
13 complying with an obligation, to which paragraph (b)
14 applies.

15 Note: A reference to this Act includes the regulations (see section 6).

16 (2) Paragraphs (1)(a) and (b) apply only in relation to decisions,
17 powers and obligations determined in a legislative instrument made
18 by the Registrar for the purposes of this subsection.

19 (3) For the purposes of this Act, the Registrar is taken to have:

20 (a) made a decision; or

21 (b) exercised a power or complied with an obligation; or

22 (c) done something else related to the making of a decision or
23 the exercise of a power or the compliance with an obligation;
24 that was made, exercised, complied with or done by the operation
25 of a computer program under an arrangement made under
26 subsection (1).

27 ***Substituted decisions***

28 (4) The Registrar may substitute a decision for a decision the Registrar
29 is taken to have made under paragraph (3)(a) if the Registrar is
30 satisfied that the decision made by the operation of the computer
31 program is incorrect.

EXPOSURE DRAFT

Amendments **Schedule 1**
Computerised decision-making **Part 9**

Review

(5) If:

- (a) the Registrar is taken to have made a decision (the ***initial decision***) under paragraph (3)(a); and
- (b) under another provision of this Act, an application may be made to the Administrative Appeals Tribunal for review of the initial decision; and
- (c) the Registrar, under subsection (4), substitutes a decision for the initial decision;

an application may be made to the Administrative Appeals Tribunal for review of the substituted decision.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 10 Addresses and service of documents

Part 10—Addresses and service of documents

Plant Breeder's Rights Act 1994

398 Subsection 3(4)

Repeal the subsection, substitute:

(4) Subsection (2) of this section does not apply to a reference to an *address* in subsection 26(2).

399 At the end of subsection 19(5A)

Add:

Note: After the time specified in regulations made for the purposes of subsection 3(2), the address may be an electronic address: see subsections 3(2), (5) and (6).

400 Subsection 21(5) (before the note)

Insert:

Note 1: After the time specified in regulations made for the purposes of subsection 3(2), the address may be an electronic address: see subsections 3(2), (5) and (6).

401 Subsection 21(5) (note)

Omit “Note”, substitute “Note 2”.

402 After subsection 26(1)

Insert:

(1A) Without limiting subsection (1), the approved form must require the inclusion of an address in Australia or New Zealand for service, being an address that is in accordance with the requirements of the approved form.

Note: After the time specified in regulations made for the purposes of subsection 3(2), the address may be an electronic address: see subsections 3(2), (5) and (6).

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Amendments **Schedule 1**
Addresses and service of documents **Part 10**

1 **403 Subsection 26(3)**

2 Repeal the subsection.

3 **404 Subsection 31(3)**

4 Omit “notices”, substitute “documents”.

5 **405 At the end of subsection 31(3)**

6 Add:

7 Note: After the time specified in regulations made for the purposes of
8 subsection 3(2), the address may be an electronic address: see
9 subsections 3(2), (5) and (6).

10 **406 Subsection 31(4)**

11 Omit “notices”, substitute “documents”.

12 **407 At the end of section 73**

13 Add:

14 Note: After the time specified in regulations made for the purposes of
15 subsection 3(2), the address may be an electronic address: see
16 subsections 3(2), (5) and (6).

17 **408 Application provision**

18 The amendments of section 26 of the *Plant Breeder’s Rights Act 1994*
19 made by this Part apply in relation to applications for PBR in a plant
20 variety made on or after the commencement of this item.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 11 Examination of standard patent requests and specifications

Part 11—Examination of standard patent requests and specifications

Patents Act 1990

409 Subsection 44(1)

After “patent request and”, insert “complete”.

410 Subsection 44(2)

Omit “, within the prescribed period,”.

411 After subsection 44(2)

Insert:

(2A) If the Commissioner gives a direction under subsection (2), the applicant must, within the prescribed period and in accordance with the regulations, ask for an examination of the patent request and complete specification relating to the application.

412 Subsection 44(3)

After “patent request and”, insert “complete”.

413 Subsection 44(3)

After “a person”, insert “(other than the applicant)”.

414 Subsection 44(3)

Omit “in accordance with the regulations, require the Commissioner to direct the applicant to ask, within the prescribed period,”, substitute “within the prescribed period and in accordance with the regulations, ask”.

415 Subsection 44(4)

Repeal the subsection, substitute:

(4) A request cannot be made under subsection (3) if a request under subsection (1) has been made or a direction under subsection (2) has been given.

EXPOSURE DRAFT

Amendments **Schedule 1**
Examination of standard patent requests and specifications **Part 11**

- 1 (5) If a request is made under subsection (3), the Commissioner must
2 notify the applicant about the request.

3 **416 Subsection 45(1)**

- 4 Omit “if an applicant”, substitute “if, under subsection 44(1), (2A) or
5 (3), an applicant, or a person other than an applicant,”.

6 **417 Paragraph 142(2)(a)**

- 7 Omit “, (2) or (3)”, substitute “or (2A)”.

8 **418 At the end of subsection 142(3)**

9 Add:

- 10 Note: A complete application for a standard patent may also lapse in the
11 circumstances prescribed by the regulations: see section 227.

12 **419 Application and saving provisions**

- 13 (1) Subject to subitem (2), the amendments made by this Part apply in
14 relation to requests under section 44 of the *Patents Act 1990* made on or
15 after the commencement of this item, whether the complete application
16 for a standard patent was made before, on or after that commencement.
- 17 (2) Despite the amendments made by this Part, sections 44, 45 and 142 of
18 the *Patents Act 1990*, as in force immediately before the
19 commencement of this item, continue to apply on and after that
20 commencement for the purposes of a request being made under
21 section 44 of that Act on or after that commencement as a result of:
- 22 (a) a direction given before that commencement under
23 subsection 44(2) of that Act; or
24 (b) a requirement made of the Commissioner before that
25 commencement under subsection 44(3) of that Act.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 12 Requirements for patent documents

Part 12—Requirements for patent documents

Patents Act 1990

420 Subsections 29(3) and (4)

Repeal the subsections, substitute:

(3) A patent request in relation to a provisional application must:

(a) be in the approved form; and

(b) be in English; and

(c) be accompanied by a provisional specification.

(4) The provisional specification referred to in paragraph (3)(c) must:

(a) be in the approved form; and

(b) be in English.

(4A) A patent request in relation to a complete application must:

(a) be in the approved form; and

(b) be in English; and

(c) be accompanied by a complete specification; and

(d) comply with the formalities requirements determined in an instrument under section 229.

(4B) The complete specification referred to in paragraph (4A)(c) must:

(a) be in the approved form; and

(b) be in English; and

(c) comply with the formalities requirements determined in an instrument under section 229.

421 Subsection 29A(2)

After “drawings”, insert “, graphics, photographs”.

422 Subsection 40(3A)

Omit “or drawings”, substitute “, drawings, graphics or photographs”.

EXPOSURE DRAFT

Amendments **Schedule 1**
Requirements for patent documents **Part 12**

1 **423 Paragraph 151(4)(f)**

2 Omit “and drawings”, substitute “, drawings, graphics and
3 photographs”.

4 **424 Paragraph 176(f)**

5 Omit “and drawings”, substitute “, drawings, graphics and
6 photographs”.

7 **425 Subparagraph 228(2)(ha)(i)**

8 After “subsections 18(2) and (3)”, insert “and 29(4A) and (4B)”.

9 **426 Subparagraph 228(2)(ha)(ii)**

10 Omit “the application is in accordance with the requirements of the
11 regulations relating to the preparation of documents for filing”,
12 substitute “those formalities requirements are met”.

13 **427 Subparagraph 228(2)(i)(i)**

14 Omit “the requirements of subsection 29A(5) have been met”, substitute
15 “the applicant has complied with subsection 29A(5)”.

16 **428 Subparagraph 228(2)(i)(ii)**

17 Omit “the PCT application is in accordance with those requirements”,
18 substitute “those requirements are met”.

19 **429 After paragraph 228(2)(i)**

20 Insert:

21 (ia) making provision for and in relation to:

22 (i) empowering the Commissioner, in relation to a
23 provisional patent application, to direct the applicant to
24 do such things as are necessary to ensure that the
25 provisional specification complies with the
26 requirements of subsection 29(4); and

27 (ii) the provisional specification being taken not to have
28 been filed if such a direction is not complied with within
29 a time specified in the regulations; and

30 **430 Paragraph 228(2)(j)**

31 After “ensure that the”, insert “patent request or”.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 12 Requirements for patent documents

431 Paragraph 228(2)(j)

Omit “the requirements of the regulations relating to the preparation of documents for filing”, substitute “the requirements of subsection 29(4A) or (4B)”.

432 At the end of Chapter 22

Add:

229 Instrument determining formalities requirements for patent documents

- (1) The Commissioner may, by written instrument, determine formalities requirements for the purposes of the following:
 - (a) paragraphs 29(4A)(d) and (4B)(c);
 - (b) a provision of the regulations, if that provision refers to this section.
- (2) The Commissioner must publish a notice in the *Official Journal* setting out the determination.
- (3) A determination under subsection (1) is not a legislative instrument.

433 Schedule 1 (definition of *specification*)

Omit “and drawings”, substitute “, drawings, graphics and photographs”.

434 Application and transitional provisions

- (1) The amendments of section 29 of the *Patents Act 1990* made by this Part apply in relation to patent requests filed under subsection 29(1) of that Act on or after the commencement of this item.
- (2) An instrument approving a form and in force for the purposes of subsection 29(3) of the *Patents Act 1990* immediately before the commencement of this item has effect on and after that commencement as if it were an instrument approving that form and in force for the purposes of paragraph 29(3)(a) of that Act.
- (3) An instrument approving a form and in force for the purposes of subsection 29(4) of the *Patents Act 1990* immediately before the

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Amendments **Schedule 1**
Requirements for patent documents **Part 12**

1 commencement of this item has effect on and after that commencement
2 as if it were an instrument approving that form and in force for the
3 purposes of paragraph 29(4A)(a) of that Act.

4 (4) An instrument approving a form and in force for the purposes of
5 paragraph 3.2(1)(a) of the *Patents Regulations 1991* immediately before
6 the commencement of this item has effect on and after that
7 commencement as if it were an instrument approving that form and in
8 force for the purposes of paragraph 29(4)(a) of the *Patents Act 1990*.

9 (5) An instrument approving a form and in force for the purposes of
10 paragraph 3.2A(2)(a) of the *Patents Regulations 1991* immediately
11 before the commencement of this item has effect on and after that
12 commencement as if it were an instrument approving that form and in
13 force for the purposes of paragraph 29(4B)(a) of the *Patents Act 1990*.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 13 Acceptance of trade mark applications

1 **Part 13—Acceptance of trade mark applications**

2 ***Trade Marks Act 1995***

3 **435 Subsection 37(1)**

4 Omit “or within that period as extended in accordance with the
5 regulations”.

6 **436 Subsection 37(2)**

7 Omit “or the prescribed period as extended (as the case may be)”.

8 **437 Application provision**

9 The amendments made by this Part apply in relation to the following:

- 10 (a) an application filed or made on or after the commencement
11 of this item;
- 12 (b) an application filed or made before that commencement,
13 where acceptance of the application is revoked on or after
14 that commencement under subsection 38(1) of the *Trade*
15 *Marks Act 1995*;
- 16 (c) an application filed or made before that commencement,
17 where acceptance of the application is revoked on or after
18 that commencement as mentioned in subsection 84C(5) of
19 that Act.

1 **Part 14—Registration of designs**

2 *Designs Act 2003*

3 **438 Section 20**

4 Omit “or publication”.

5 **439 Paragraph 23(1)(d)**

6 Omit “, or published under section 57”.

7 **440 Subsection 23(3)**

8 Omit “or publication”.

9 **441 Paragraph 24(1)(c)**

10 Omit “or publication”.

11 **442 At the end of paragraph 24(1)(c)**

12 Add “and state the effect of subsections 35(4) and (5)”.

13 **443 Subsection 32(4)**

14 Omit “or publication”.

15 **444 Subsection 33(1)**

16 Repeal the subsection, substitute:

17 (1) A design application lapses if the Registrar has given the applicant
18 a notification under section 41 in respect of the application, and the
19 applicant has not, within the period prescribed by the regulations:

20 (a) requested that the application be amended; or

21 (b) responded in writing to the notification as mentioned in
22 subparagraph 41(c)(ii);

23 in such a way that the Registrar is satisfied that the application
24 meets the applicable requirements of Chapter 4.

25 **445 Subsection 33(3)**

26 Repeal the subsection.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 14 Registration of designs

1 **446 Chapter 4 (heading)**

2 Repeal the heading, substitute:

3 **Chapter 4—Registration of designs**

4 **447 Section 34**

5 Omit “or publication”.

6 **448 Section 34**

7 Omit “or publish”.

8 **449 Section 34**

9 Omit “or 4”.

10 **450 Part 2 of Chapter 4 (heading)**

11 Repeal the heading, substitute:

12 **Part 2—Requests for registration**

13 **451 Section 35 (heading)**

14 Repeal the heading, substitute:

15 **35 Request for registration**

16 **452 Before subsection 35(1)**

17 Insert:

18 *Actual requests for registration*

19 **453 Subsection 35(1)**

20 Omit “or publication”.

21 **454 Paragraph 35(2)(b)**

22 Omit “(but see sections 37 and 38)”.

23 **455 At the end of section 35**

24 Add:

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Amendments **Schedule 1**
Registration of designs **Part 14**

Deemed requests for registration

(4) If:

- (a) one design is disclosed in a design application; and
- (b) at the end of the period mentioned in paragraph (2)(b):
 - (i) the applicant has not made a request in relation to the design in accordance with subsections (1) to (3); and
 - (ii) the applicant has not withdrawn the application in accordance with section 32;

then the applicant is taken to have requested that the design be registered.

(5) If:

- (a) more than one design is disclosed in a design application; and
- (b) at the end of the period mentioned in paragraph (2)(b):
 - (i) the applicant has not made a request in relation to any of the designs in accordance with subsections (1) to (3); and
 - (ii) the applicant has not withdrawn the application in accordance with section 32;

then the applicant is taken to have requested that all of the designs be registered.

Relationship with section 37

- (6) This section is subject to section 37.

456 Sections 36 to 38

Repeal the sections, substitute:

36 Request for registration of some, but not all, designs

If:

- (a) an applicant requests registration of one or more designs disclosed in a design application; but
- (b) the applicant does not request registration of one or more other designs (each of which is a ***relevant design***) disclosed in the application;

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Schedule 1 Amendments

Part 14 Registration of designs

1 the applicant cannot later make a request for registration of a
2 relevant design unless the Registrar determines, in accordance with
3 the regulations, that the applicant may do so.

4 **37 Request in respect of designs excluded from an application in** 5 **respect of more than one design**

6 A person who files a design application (the *later application*) in
7 respect of designs excluded from an initial application is taken, at
8 the time the later application is filed, to have requested registration
9 of all the designs disclosed in the later application.

10 **457 At the end of paragraph 39(1)(b)**

11 Add “(including a request taken to have been made under
12 subsection 35(4))”.

13 **458 At the end of paragraph 40(1)(b)**

14 Add “(including a request taken to have been made under
15 subsection 35(5))”.

16 **459 Paragraph 41(c)**

17 Omit “paragraph 33(1)(b)”, substitute “subsection 33(1)”.

18 **460 Part 4 of Chapter 4**

19 Repeal the Part.

20 **461 Subsection 60(1)**

21 Omit “or published”.

22 **462 Paragraphs 60(1)(d) and (e)**

23 Omit “or publication”.

24 **463 Subparagraph 60(4)(b)(iii)**

25 Omit “neither registered nor published”, substitute “not registered”.

26 **464 Subsection 60(4)**

27 Omit “or published”.

465 Subsection 61(3)

Omit “or publication”.

466 Subsection 108(3)

Omit “or published”.

467 Paragraph 108(4)(b)

Omit “or published”.

468 Subsection 108(4)

Omit “or published” (last occurring).

469 Paragraph 136(1)(e)

Repeal the paragraph.

**470 Subsection 137(7) (paragraph (b) of the definition of
relevant act)**

Omit “or publication”.

471 Section 146

Omit “or publication”.

472 Paragraph 149(2)(i)

Omit “or publication”.

473 Application and saving provisions

- (1) The amendments of section 23, and the repeal and substitution of section 37, of the *Designs Act 2003* made by this Part apply in relation to initial applications filed under section 21 of that Act on or after the commencement of this item.
- (2) The amendments of sections 24, 32, 33, 35, 39, 40, 41, 60, 61, 108 and 136 of the *Designs Act 2003*, the repeal and substitution of section 36 of that Act and the repeal of section 38 and Part 4 of Chapter 4 of that Act made by this Part apply in relation to design applications filed under section 21 of that Act on or after the commencement of this item.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 14 Registration of designs

- 1 (3) Sections 136, 137, 146 and 149 of the *Designs Act 2003*, as in force
2 immediately before the commencement of this item, continue to apply
3 on and after that commencement in relation to an application for
4 publication of a design that was made before that commencement.

1 **Part 15—Unjustified threats of infringement**

2 **Division 1—Amendments**

3 ***Designs Act 2003***

4 **474 After subsection 77(1)**

5 Insert:

6 (1A) The court may include an additional amount in an assessment of
7 damages sustained by the applicant as a result of the unjustified
8 threats, if the court considers it appropriate to do so having regard
9 to:

- 10 (a) the flagrancy of the threats; and
11 (b) the need to deter similar threats; and
12 (c) the conduct of the respondent that occurred after the
13 respondent made the threats; and
14 (d) any benefit shown to have accrued to the respondent because
15 of the threats; and
16 (e) all other relevant matters.

17 ***Olympic Insignia Protection Act 1987***

18 **475 Division 3 of Part 3.4 (heading)**

19 Repeal the heading, substitute:

20 **Division 3—Unjustified threats**

21 **476 Section 64 (heading)**

22 Repeal the heading, substitute:

23 **64 Unjustified threats of legal proceedings**

24 **477 Paragraph 64(2)(a)**

25 Omit “AOC or the licensed user had no grounds for making the threat”,
26 substitute “threat is unjustified”.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 15 Unjustified threats of infringement

1 **478 Section 65 (heading)**

2 Repeal the heading, substitute:

3 **65 Counterclaim**

4 ***Patents Act 1990***

5 **479 After subsection 128(1)**

6 Insert:

7 (1A) The court may include an additional amount in an assessment of
8 damages sustained by the applicant as a result of the unjustifiable
9 threats, if the court considers it appropriate to do so having regard
10 to:

11 (a) the flagrancy of the threats; and

12 (b) the need to deter similar threats; and

13 (c) the conduct of the person who made the threats, being
14 conduct that occurred after the person made the threats; and

15 (d) any benefit shown to have accrued to the person who made
16 the threats because of the threats; and

17 (e) all other relevant matters.

18 ***Plant Breeder's Rights Act 1994***

19 **480 Subsection 3(1)**

20 Insert:

21 ***legal practitioner*** means a barrister or solicitor of the High Court
22 or of the Supreme Court of a State or Territory.

23 **481 At the end of Part 5**

24 Add:

25 **57A Application for relief from unjustified threats**

26 (1) If a person is threatened by another person (the ***respondent***) with
27 proceedings for infringement of PBR in a plant variety, or other

1 similar proceedings, an aggrieved person (the **applicant**) may
2 apply to the Federal Court or Federal Circuit Court for:

- 3 (a) a declaration that the threats are unjustified; and
- 4 (b) an injunction against the continuance of the threats; and
- 5 (c) the recovery of any damages sustained by the applicant as a
6 result of the threats.

7 (2) A threat mentioned in subsection (1) may be by means of circulars,
8 advertisements or otherwise.

9 (3) Subsection (1) applies whether or not the respondent is the grantee
10 of the PBR in the plant variety.

11 **57B Court's power to grant relief**

12 The Federal Court or Federal Circuit Court may grant the relief
13 sought by an applicant under section 57A, unless the respondent
14 satisfies the Court that:

- 15 (a) the respondent is the grantee of the PBR in the plant variety;
16 and
- 17 (b) the acts about which the threats were made infringe, or would
18 infringe, the PBR in the plant variety.

19 **57C Counterclaim for infringement**

20 (1) The respondent in proceedings under section 57A may apply, by
21 way of counter-claim, for relief to which the respondent would be
22 entitled in separate proceedings against the applicant for
23 infringement of the PBR in the plant variety.

24 (2) The provisions of this Act relating to proceedings for infringement
25 of PBR in a plant variety apply, with the necessary changes, to a
26 counter-claim under subsection (1).

27 **57D Notification of PBR in a plant variety not a threat**

28 The mere notification of the existence of PBR in a plant variety
29 does not constitute a threat of proceedings for the purposes of
30 section 57A.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 15 Unjustified threats of infringement

1 **57E Liability of legal practitioner**

2 A legal practitioner is not liable to proceedings under section 57A
3 in respect of an act done in a professional capacity on behalf of a
4 client.

5 ***Trade Marks Act 1995***

6 **482 Section 129 (heading)**

7 Repeal the heading, substitute:

8 **129 Application for relief from unjustified threats**

9 **483 Paragraph 129(2)(a)**

10 Omit “defendant has no grounds for making the threat”, substitute
11 “threat is unjustified”.

12 **484 After subsection 129(2)**

13 Insert:

14 (2A) The court may include an additional amount in an assessment of
15 damages the plaintiff has sustained because of the defendant’s
16 conduct, if the court considers it appropriate to do so having regard
17 to:

- 18 (a) the flagrancy of the threat; and
19 (b) the need to deter similar threats; and
20 (c) the conduct of the defendant that occurred after the defendant
21 made the threat; and
22 (d) any benefit shown to have accrued to the defendant because
23 of the threat; and
24 (e) all other relevant matters.

25 **485 Subsection 129(5)**

26 Repeal the subsection.

27 **486 Section 130 (heading)**

28 Repeal the heading, substitute:

1 **130 Counterclaim for infringement**

2 **Division 2—Application and saving provisions**

3 **487 Application and saving provisions**

4 *Designs*

- 5 (1) The amendment of section 77 of the *Designs Act 2003* made by this Part
6 applies in relation to threats of the kind referred to in subsection 77(1)
7 of that Act that are made on or after the commencement of this item.

8 *Olympic expressions*

- 9 (2) The amendments of section 64 of the *Olympic Insignia Protection Act*
10 *1987* made by this Part apply in relation to threats of the kind referred to
11 in subsection 64(1) of that Act that are made on or after the
12 commencement of this item.

13 *Patents*

- 14 (3) The amendment of section 128 of the *Patents Act 1990* made by this
15 Part applies in relation to threats of the kind referred to in
16 subsection 128(1) of that Act that are made on or after the
17 commencement of this item.

18 *Plant breeder's rights*

- 19 (4) Section 57A of the *Plant Breeder's Rights Act 1994*, as added by this
20 Schedule, applies in relation to threats of the kind referred to in
21 subsection 57A(1) of that Act that are made on or after the
22 commencement of this item.

23 *Trade marks*

- 24 (5) The amendments of section 129 of the *Trade Marks Act 1995* made by
25 this Part (except the repeal of subsection 129(5) of that Act) apply in
26 relation to threats of the kind referred to in subsection 129(1) of that Act
27 that are made on or after the commencement of this item.
- 28 (6) Despite the repeal of subsection 129(5) of the *Trade Marks Act 1995*
29 made by this Part, that subsection, as in force immediately before the
30 commencement of this item, continues to apply on and after that
-

EXPOSURE DRAFT

Schedule 1 Amendments

Part 15 Unjustified threats of infringement

- 1 commencement in relation to an action for infringement of a trade mark
2 begun before that commencement.

EXPOSURE DRAFT

Amendments **Schedule 1**
Ownership of PBR and entries in the Register **Part 16**

Part 16—Ownership of PBR and entries in the Register

Plant Breeder’s Rights Act 1994

488 Subsection 45(1)

Omit “subsections (2) and (3)”, substitute “subsection (3)”.

489 At the end of subsection 45(1)

Add:

Note: If PBR is granted to persons who make a joint application, the PBR is granted to those persons jointly: see subsection 44(11).

490 Subsection 45(2)

Repeal the subsection.

491 At the end of Part 6

Add:

62A Registrar’s power to rectify Register

- (1) The Registrar may rectify the Register if the Registrar is satisfied, whether on application or otherwise, of any of the following:
- (a) the omission of an entry from the Register;
 - (b) an entry made in the Register without sufficient cause;
 - (c) an entry wrongly existing in the Register;
 - (d) an error or defect in an entry in the Register.

Form of application

- (2) An application under subsection (1) must be in the approved form.

Further information

- (3) The Registrar:

EXPOSURE DRAFT

Schedule 1 Amendments

Part 16 Ownership of PBR and entries in the Register

- 1 (a) may seek further information from any person for the
2 purpose of considering an application under subsection (1);
3 and
4 (b) is not required to consider the application while seeking the
5 further information.

6 *Persons to be heard*

- 7 (4) The Registrar must not rectify the Register under this section in
8 relation to PBR in a plant variety without first giving the following
9 persons a reasonable opportunity to be heard:
10 (a) in the case of an application to rectify the Register—the
11 applicant;
12 (b) the grantee of the PBR as recorded in the Register;
13 (c) any other person the Registrar considers appropriate.

14 *Relevant proceedings pending*

- 15 (5) The Registrar must not rectify the Register under this section in
16 relation to PBR in a plant variety while:
17 (a) relevant proceedings in relation to the PBR are pending; or
18 (b) proceedings in a court or in the AAT, relating to a decision
19 under section 21 to amend, or refuse to amend, the Register
20 in relation to the PBR, are pending.

21 Note: A decision under this section to rectify, or refuse to rectify, the
22 Register is reviewable by the AAT under section 77.

23 **492 After subparagraph 77(1)(b)(xvii)**

24 Insert:

- 25 (xviii) under section 62A to rectify, or refuse to rectify, the
26 Register; or

27 **493 Paragraph 80(2)(d)**

28 After “mistake”, insert “, or for any other purpose”.

29 **494 Application provision**

30 Section 62A of the *Plant Breeder’s Rights Act 1994*, as added by this
31 Part, applies in relation to:

EXPOSURE DRAFT

Amendments **Schedule 1**
Ownership of PBR and entries in the Register **Part 16**

- 1 (a) PBR in a plant variety granted before, on or after the
- 2 commencement of this item; and
- 3 (b) entries made in the Register before, on or after that
- 4 commencement.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 17 Trade mark oppositions

1 **Part 17—Trade mark oppositions**

2 ***Trade Marks Act 1995***

3 **495 Paragraph 222(a)**

4 After “subsection”, insert “65A(4), 83A(4) or”.

5 **496 Subsection 231(3)**

6 After “52,”, insert “65A, 83A,”.

7 **497 Application provision**

8 The amendment of paragraph 222(a) of the *Trade Marks Act 1995* made
9 by this Part applies in relation to requests made on or after the
10 commencement of this item.

Part 18—Seizure notices

Division 1—Amendments

Copyright Act 1968

498 Subsection 135AC(1)

Omit “either personally or by post, a written notice”, substitute “by any means of communication (including by electronic means), a notice”.

499 Paragraphs 135AC(3)(c) and (d)

Repeal the paragraphs, substitute:

- (c) if the notice is given to the objector—state the name and the address of the place of business or residence of the importer (if known), unless the Comptroller-General of Customs is satisfied, for reasons of confidentiality, that it is not desirable to do so; and
- (d) if the notice is given to the importer—state the name and the address of the place of business or residence of:
 - (i) the objector; or
 - (ii) if the objector has nominated a person to be the objector’s agent or representative for the purposes of this Division—that person;unless the Comptroller-General of Customs is satisfied, for reasons of confidentiality, that it is not desirable to do so.

Olympic Insignia Protection Act 1987

500 Subsection 55(1)

Omit “either personally or by post, a written notice”, substitute “by any means of communication (including by electronic means), a notice”.

501 Paragraph 55(2)(a)

Repeal the paragraph, substitute:

- (a) state the name and the address of the place of business or residence of the designated owner (if known), unless the

EXPOSURE DRAFT

Schedule 1 Amendments

Part 18 Seizure notices

1 Comptroller-General of Customs is satisfied, for reasons of
2 confidentiality, that it is not desirable to do so; and

3 ***Trade Marks Act 1995***

4 **502 Subsection 134(1)**

5 Omit “either personally or by post, a written notice”, substitute “by any
6 means of communication (including by electronic means), a notice”.

7 **503 Paragraphs 134(3)(c) and (d)**

8 Repeal the paragraphs, substitute:

- 9 (c) if the notice is given to the objector—state the name and the
10 address of the place of business or residence of the
11 designated owner (if known), unless the Comptroller-General
12 of Customs is satisfied, for reasons of confidentiality, that it
13 is not desirable to do so; and
14 (d) if the notice is given to the designated owner—state the name
15 and the address of the place of business or residence of:
16 (i) the objector; or
17 (ii) if the objector has nominated a person to be the
18 objector’s agent or representative for the purposes of
19 this Division—that person;
20 unless the Comptroller-General of Customs is satisfied, for
21 reasons of confidentiality, that it is not desirable to do so.

22 **Division 2—Application provisions**

23 **504 Application provisions**

24 *Copyright*

- 25 (1) The amendments of section 135AC of the *Copyright Act 1968* made by
26 this Part apply in relation to notices given under subsection 135AC(1)
27 of that Act on or after the commencement of this item.

28 *Olympic expressions*

- 29 (2) The amendments of section 55 of the *Olympic Insignia Protection Act*
30 *1987* made by this Part apply in relation to notices given under
31 subsection 55(1) of that Act on or after the commencement of this item.
-

EXPOSURE DRAFT

Amendments **Schedule 1**
Seizure notices **Part 18**

1 *Trade marks*

2 (3) The amendments of section 134 of the *Trade Marks Act 1995* made by
3 this Part apply in relation to notices given under subsection 134(1) of
4 that Act on or after the commencement of this item.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 19 Publishing personal information of registered patent or trade marks attorneys

Part 19—Publishing personal information of registered patent or trade marks attorneys

Division 1—Amendments

Patents Act 1990

505 After subsection 183(1)

Insert:

- (1A) The Designated Manager may disclose to the Board personal information (within the meaning of the *Privacy Act 1988*):
- (a) that is about a registered patent attorney; and
 - (b) that the Designated Manager considers to be relevant to the Board's functions.

506 After section 227A

Insert:

227B Publishing personal information of registered patent attorneys

- (1) The Board may publish on its website any or all of the following personal information (within the meaning of the *Privacy Act 1988*) that is about a registered patent attorney:
- (a) the name of the attorney;
 - (b) the State or Territory in which the attorney's work address is located;
 - (c) the attorney's work email address.
- (2) Subsection (1) does not prevent the Board from publishing on its website other personal information (within the meaning of the *Privacy Act 1988*) that is about a registered patent attorney with the attorney's written consent.

EXPOSURE DRAFT

Amendments **Schedule 1**

Publishing personal information of registered patent or trade marks attorneys **Part 19**

1 ***Trade Marks Act 1995***

2 **507 After section 229**

3 Insert:

4 **229AA Designated Manager may disclose information to Board**

5 The Designated Manager may disclose to the Board personal
6 information:

- 7 (a) that is about a registered trade marks attorney; and
8 (b) that the Designated Manager considers to be relevant to the
9 Board's functions.

10 **508 After section 229A**

11 Insert:

12 **229B Publishing personal information of registered trade marks**
13 **attorneys**

- 14 (1) The Board may publish on its website any or all of the following
15 personal information that is about a registered trade marks
16 attorney:
17 (a) the name of the attorney;
18 (b) the State or Territory in which the attorney's work address is
19 located;
20 (c) the attorney's work email address.
21 (2) Subsection (1) does not prevent the Board from publishing on its
22 website other personal information that is about a registered trade
23 marks attorney with the attorney's written consent.

24 **Division 2—Application provisions**

25 **509 Application provisions**

26 ***Patents***

- 27 (1) The amendments of the *Patents Act 1990* made by this Part apply in
28 relation to information about a registered patent attorney obtained
-

EXPOSURE DRAFT

Schedule 1 Amendments

Part 19 Publishing personal information of registered patent or trade marks attorneys

1 before, on or after the commencement of this item (whether the attorney
2 was registered under that Act before, on or after that commencement).

3 *Trade marks*

4 (2) The amendments of the *Trade Marks Act 1995* made by this Part apply
5 in relation to information about a registered trade marks attorney
6 obtained before, on or after the commencement of this item (whether
7 the attorney was registered under that Act before, on or after that
8 commencement).

Part 20—Prosecutions

Division 1—Amendments

Patents Act 1990

510 Section 204

Omit “or (5)”, substitute “, (5) or (6) or 201B(1) or (2)”.

511 Section 204

After “202A”, insert “, 202B”.

Trade Marks Act 1995

512 Before subsection 156(4)

Insert:

Common rules

513 At the end of section 157A

Add:

Time for starting prosecutions

(9) Despite section 15B of the *Crimes Act 1914*, a prosecution for an offence against this section may be started at any time within 5 years after the offence was committed.

Division 2—Application provision

514 Application provision

The amendments of section 204 of the *Patents Act 1990* and of section 157A of the *Trade Marks Act 1995* made by this Part apply in relation to offences committed on or after the commencement of this item.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 21 Secretary's role in the Plant Breeder's Rights Act

Part 21—Secretary's role in the Plant Breeder's Rights Act

Plant Breeder's Rights Act 1994

515 Subsection 3(1) (definition of *approved form*)

Repeal the definition, substitute:

approved form, in relation to a provision of this Act, means a form approved in an instrument under subsection (1A) for the purposes of that provision.

516 Subsection 3(1) (definition of *genetic resource centre*)

Omit "Secretary", substitute "Registrar".

517 Subsection 3(1) (definition of *herbarium*)

Omit "Secretary", substitute "Registrar".

518 Subsection 3(1) (definition of *Secretary*)

Repeal the definition.

519 After subsection 3(1)

Insert:

(1A) The Registrar may, by writing, approve a form for the purposes of a provision of this Act.

520 Subsection 8(1)

Omit "Secretary", substitute "Registrar".

521 Paragraph 12(c)

Omit "Secretary", substitute "Registrar".

522 Subsections 19(3) and (4) and (6) to (11)

Omit "Secretary" (wherever occurring), substitute "Registrar".

EXPOSURE DRAFT

Amendments **Schedule 1**
Secretary's role in the Plant Breeder's Rights Act **Part 21**

1 **523 Subsection 24(1)**

2 Omit "Secretary", substitute "Registrar".

3 **524 Subparagraph 26(2)(i)(iii)**

4 Omit "Secretary", substitute "Registrar".

5 **525 Subsections 28(1), (2) and (3)**

6 Omit "Secretary", substitute "Registrar".

7 **526 Subsections 29(3) and (4)**

8 Omit "Secretary", substitute "Registrar".

9 **527 Subsections 30(1) to (5)**

10 Omit "Secretary" (wherever occurring), substitute "Registrar".

11 **528 Subsections 31(1), (2), (4), (5) and (6)**

12 Omit "Secretary" (wherever occurring), substitute "Registrar".

13 **529 Subsections 32(1) to (5)**

14 Omit "Secretary" (wherever occurring), substitute "Registrar".

15 **530 Subsection 33(2)**

16 Omit "Secretary", substitute "Registrar".

17 **531 Section 34 (heading)**

18 Repeal the heading, substitute:

19 **34 Detailed description in support of application to be given to**
20 **Registrar**

21 **532 Subsections 34(1), (2), (5) and (6)**

22 Omit "Secretary", substitute "Registrar".

23 **533 Subsections 35(1) and (2)**

24 Omit "Secretary" (wherever occurring), substitute "Registrar".

EXPOSURE DRAFT

Schedule 1 Amendments

Part 21 Secretary's role in the Plant Breeder's Rights Act

1 **534 Paragraph 36(3)(d)**

2 Omit "Secretary", substitute "Registrar".

3 **535 Subsection 37(1)**

4 Omit "Secretary" (wherever occurring), substitute "Registrar".

5 **536 Subsection 37(2)**

6 Omit "Secretary's", substitute "Registrar's".

7 **537 Paragraph 37(2)(b)**

8 Omit "Secretary" (wherever occurring), substitute "Registrar".

9 **538 Subsections 37(2B), (3), (4), (6) and (7)**

10 Omit "Secretary" (wherever occurring), substitute "Registrar".

11 **539 Subsections 38(4) and (5)**

12 Omit "Secretary", substitute "Registrar".

13 **540 Subsection 38(5) (note)**

14 Omit "Secretary", substitute "Registrar".

15 **541 Subsections 39(1), (2) and (4)**

16 Omit "Secretary" (wherever occurring), substitute "Registrar".

17 **542 Subsections 40(1), (3), (6), (7), (8), (9), (10) and (11)**

18 Omit "Secretary" (wherever occurring), substitute "Registrar".

19 **543 Subsections 41(1), (2) and (5)**

20 Omit "Secretary" (wherever occurring), substitute "Registrar".

21 **544 Subsections 44(1), (2), (3), (4), (5), (6) and (9)**

22 Omit "Secretary" (wherever occurring), substitute "Registrar".

23 **545 Subsection 44(10)**

24 Omit "issue to that person by the Secretary", substitute "issue to that
25 person by the Registrar".

EXPOSURE DRAFT

Amendments **Schedule 1**
Secretary's role in the Plant Breeder's Rights Act **Part 21**

1 **546 Subsection 44(10)**

2 Omit "the Secretary or".

3 **547 Subsection 44(10)**

4 Omit "as the Secretary", substitute "as the Registrar".

5 **548 Subsection 44(12)**

6 Omit "Secretary" (wherever occurring), substitute "Registrar".

7 **549 Paragraph 45(3)(c)**

8 Omit "Secretary", substitute "Registrar".

9 **550 Subsections 46(1) and (2)**

10 Omit "Secretary", substitute "Registrar".

11 **551 Subsections 47(1) and (2)**

12 Omit "Secretary", substitute "Registrar".

13 **552 Paragraph 48(2)(c)**

14 Omit "Secretary", substitute "Registrar".

15 **553 Paragraph 49(3)(a)**

16 Omit "Secretary", substitute "Registrar".

17 **554 Subsections 50(2), (3), (4), (5), (9) and (10)**

18 Omit "Secretary" (wherever occurring), substitute "Registrar".

19 **555 Subsections 51(1) and (3)**

20 Omit "Secretary" (wherever occurring), substitute "Registrar".

21 **556 Paragraph 54(2)(b)**

22 Omit "Secretary", substitute "Registrar".

23 **557 Subsection 58(3)**

24 Repeal the subsection, substitute:

EXPOSURE DRAFT

Schedule 1 Amendments

Part 21 Secretary's role in the Plant Breeder's Rights Act

1 (3) The Registrar has the functions and powers that are conferred on
2 the Registrar by this Act or by the regulations.

3 **558 Subsection 59(2)**

4 Repeal the subsection.

5 **559 Subsection 59(4)**

6 Omit "the Minister or the Secretary under subsection (1) or (2)",
7 substitute "the Minister under subsection (1)".

8 **560 Subsection 59(5)**

9 Omit "person who originally delegated the corresponding power or
10 function under subsection (1) or (2)", substitute "Minister".

11 **561 Paragraph 60(1)(a)**

12 Repeal the paragraph.

13 **562 Subsection 61(1)**

14 Omit "Secretary", substitute "Registrar".

15 **563 Subsections 68(1), (2), (3) and (4)**

16 Omit "Secretary" (wherever occurring), substitute "Registrar".

17 **564 Subsection 70(1)**

18 Omit "Secretary" (wherever occurring), substitute "Registrar".

19 **565 Section 71**

20 Omit "Secretary" (wherever occurring), substitute "Registrar".

21 **566 Paragraph 73(b)**

22 Omit "the Secretary or".

23 **567 Subsection 75(1)**

24 Omit "the Secretary or".

25 **568 Paragraph 77(1)(b)**

26 Omit "by the Secretary", substitute "by the Registrar".

EXPOSURE DRAFT

Amendments **Schedule 1**
Secretary's role in the Plant Breeder's Rights Act **Part 21**

1 **569 After subparagraph 77(1)(b)(iv)**

2 Insert:

3 (iva) under section 21 to amend, or refuse to amend, the
4 Register; or

5 **570 Subparagraphs 77(1)(b)(ix) and (x)**

6 Omit "Secretary", substitute "Registrar".

7 **571 Subparagraph 77(1)(b)(xix)**

8 Omit "act; or", substitute "act.".

9 **572 Paragraph 77(1)(c)**

10 Repeal the paragraph.

11 **573 Subsection 77(3)**

12 Omit "Secretary", substitute "Registrar".

13 **574 Subparagraph 80(2)(a)(iv)**

14 Omit "Secretary", substitute "Registrar".

15 **575 Saving and transitional provisions**

- 16 (1) A thing done by, or in relation to, the Secretary under the *Plant*
17 *Breeder's Rights Act 1994* before the commencement of this item has
18 effect on and after that commencement as if it had been done by, or in
19 relation to, the Registrar.
- 20 (2) A form approved by the Secretary and in force immediately before the
21 commencement of this item for the purposes of a provision of the *Plant*
22 *Breeder's Rights Act 1994* has effect on and after that commencement
23 as if it were a form approved by the Registrar in an instrument under
24 subsection 3(1A) of that Act for the purposes of that provision.
- 25 (3) Despite the repeal of paragraph 60(1)(a) of the *Plant Breeder's Rights*
26 *Act 1994* made by this Part, that paragraph, as in force immediately
27 before the commencement of this item, continues in force on and after
28 that commencement for the period of 12 months beginning on the day
29 this item commences.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 21 Secretary's role in the Plant Breeder's Rights Act

- 1 (4) Paragraph 77(1)(c) of the *Plant Breeder's Rights Act 1994*, as in force
2 immediately before the commencement of this item, continues to apply
3 on and after that commencement in relation to a decision of the
4 Registrar, before that commencement, under section 21 of that Act to
5 amend, or refuse to amend, the Register.

EXPOSURE DRAFT

Amendments **Schedule 1**
Updating references to Designs Act **Part 22**

Part 22—Updating references to Designs Act

Olympic Insignia Protection Act 1987

576 Subsection 2(1) (definition of Registrar)

Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

577 Subsection 2(2)

Repeal the subsection.

578 Subsection 2(3)

Omit “*Designs Act 1906*” (wherever occurring), substitute “*Designs Act 2003*”.

579 Paragraph 10(7)(e)

Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

580 Subsection 10(12) (paragraph (a) of the definition of *published design*)

Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

581 Subsection 12(5)

Omit “Section 36 of the *Designs Act 1906*”, substitute “Section 131 of the *Designs Act 2003*”.

582 Section 13

Omit “Section 8A of the *Designs Act 1906*”, substitute “Section 124 of the *Designs Act 2003*”.

583 Section 18 (heading)

Repeal the heading, substitute:

EXPOSURE DRAFT

Schedule 1 Amendments

Part 22 Updating references to Designs Act

1 **18 Protected designs not to be registered under the *Designs Act 2003***

2 **584 Section 18**

3 Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

4 **585 Paragraphs 20(1)(b) and (3)(d)**

5 Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

1 **Part 23—Other amendments**
2

3 ***Plant Breeder’s Rights Act 1994***

4 **586 Subsection 3(1)**

5 Repeal the following definitions:

6 (a) definition of ***Advisory Committee***;

7 (b) definition of ***indigenous***;

8 (c) definition of ***member***.

9 **587 Section 42**

10 Repeal the section.

11 **588 Subsection 49(1)**

12 Repeal the subsection.

13 **589 Subsection 49(2)**

14 Omit “, having regard to the views of the Plant Breeder’s Rights
15 Advisory Committee on a matter referred under subsection (1),”.

16 **590 Subsection 49(2)**

17 Omit “appropriate”, substitute “to be necessary in the public interest”.

18 **591 Part 7**

19 Repeal the Part.

20 **592 Subsection 69(1)**

21 Omit “, 22(3) or 42(1)”, substitute “or 22(3)”.

22 **593 Subsection 69(1)**

23 Omit “and before the Minister seeks any advice from the Advisory
24 Committee concerning those regulations”.

25 **594 Subsection 69(3)**

26 Repeal the subsection.

EXPOSURE DRAFT

Schedule 1 Amendments
Part 23 Other amendments

1 **595 Section 85**

2 Repeal the section.

3 **596 Transitional provisions**

4 (1) If:

5 (a) before the commencement of this item, the Advisory
6 Committee had given views to the Minister on a matter
7 referred to the Committee under subsection 49(1) of the *Plant*
8 *Breeder's Rights Act 1994*; and

9 (b) before that commencement, the Minister had not had regard
10 to those views;

11 then the Minister must have regard to those views on or after that
12 commencement.

13 (2) Any records or documents that were in the possession of the Advisory
14 Committee immediately before the commencement of this item are to
15 be transferred to the Registrar after that commencement.

16 Note: The records and documents are Commonwealth records for the purposes of the *Archives*
17 *Act 1983*.

18 (3) If:

19 (a) before the commencement of this item, the Advisory
20 Committee had given advice to the Minister on an intended
21 regulation as mentioned in section 69 of the *Plant Breeder's*
22 *Rights Act 1994*; and

23 (b) before that commencement, the Minister had not had regard
24 to that advice;

25 then the Minister must have regard to that advice on or after that
26 commencement.
27