



Australian Government

IP Australia

Consultation on proposed amendments to the *Trade Marks Regulations 1995*



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Introduction

IP Australia welcomes feedback from interested stakeholders on an exposure draft of proposed *Trade Marks Amendment (International Registrations, Hearings and Oppositions) Regulations 2025*.

This paper sets out a detailed description of what each provision of the proposed regulations would do, were the Federal Executive Council to choose to make them. This document is not intended to represent the Explanatory Statement which will support the final Regulations. It is intended only as a guide to assist with the interpretation of the draft legislation. IP Australia will undertake further editorial review and will finalise the text of our Explanatory Statement when a final version of the legislation is settled.

Subject to the Government's priorities, IP Australia would seek to submit the regulations to the Federal Executive Council for its consideration later this year. Please note that the scope and contents of the final Regulations will not necessarily reflect the exposure draft or this paper.

Making a Submission

To provide a written submission and/or complete the survey please visit our [Consultation Hub](#).

Submissions should be received no later than 29 September 2025.

We are seeking comments on the draft legislation. Your views will be considered but there is no guarantee that they will determine Government policy or the final legislation.

Contact us

The contact officer is Ava Atkinson-Barclay, who may be contacted on (02) 6283 2440 or via email at consultation@ipaustalia.gov.au.

You can reach IP Australia on 1300 651 010.

Important Privacy Information

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Contents

Introduction	3
Making a Submission	3
Contact us	3
Contents	4
Overview of the Proposed Regulations	5
The Regulations	5
Purpose of the Amending Regulations	5
Details of the Trade Marks Amendment (International Registrations, Hearings and Oppositions) Regulations 2025	6
Schedule 1 – Increased period for filing of notice of intention to defend	7
Schedule 2 – Relationship between registered trade marks and protected international trade marks	9
Schedule 3 – Rejecting IRDA on basis of sanctions regime	12
Schedule 4 – Registrar’s power to revoke acceptance of IRDA	14
Schedule 5 – Dealing with opposition to trade mark applications or removal of trade mark for non-use	15
Schedule 6 – Extending period for examining trade mark applications where a hearing is requested	18
Schedule 7 – Technical amendments	18
Schedule 8 – Application provisions	19

Overview of the Proposed Regulations

Trade Marks Amendment (International Registrations, Hearings and Oppositions) Regulations 2025

The Regulations

The proposed *Trade Marks Amendment (International Registrations, Hearings and Oppositions) Regulations 2025* ('the amending regulations'), as set out in the exposure draft, would make amendments to the *Trade Marks Regulations 1995* to make them more user-friendly and consistent with international requirements.

Purpose of the Amending Regulations

The Schedules to the amending regulations would amend the Trade Marks Regulations as follows:

Schedule 1 – Increased period for filing of notice of intention to defend

- Increases the period for filing a notice of intention to defend an opposition (NID) from one month to 2 months. This accords with changes to the international trade mark system under the *Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* (the 'Madrid Regulations').
- Updates the definition of the expression 'Madrid Regulations' to refer to the current version of the international instrument.

Schedule 2 – Relationship between registered trade marks and protected international trade marks

- Permits partial replacement of an Australian trade mark registration by a protected international trade mark. This accords with changes to the Madrid Regulations.

Schedule 3 – Rejecting IRDA on basis of sanctions regime

- Provides specific grounds to refuse protection of an international registration designating Australia – if protecting it would contravene Australia's sanctions laws.

Schedule 4 – Registrar's power to revoke acceptance of IRDA

- Clarifies the Registrar of Trade Mark's power to revoke the acceptance of international registrations designating Australia.

Schedule 5 – Dealing with opposition to trade mark applications or removal of trade mark for non-use

- Empowers the Registrar to finalise an opposition proceeding – if neither party seeks to be heard or have the matter decided.

Schedule 6 – Extending period for examining trade mark applications where a hearing is requested

- Allows deferment of the time limit for acceptance of a trade mark – if a hearing is requested.

Schedule 7 – Technical amendments

- Makes minor technical terminology changes.

Schedule 8 – Application provisions

- Sets out how the amendments in Schedules 1 to 6 will apply in certain circumstances.

Details of the Trade Marks Amendment (International Registrations, Hearings and Oppositions) Regulations 2025

Section 1 - Name of Regulations

This section identifies the proposed regulations as the *Trade Marks Amendment (International Registrations, Hearings and Oppositions) Regulations 2025*.

Section 2 - Commencement

This section provides for the commencement of the proposed regulations:

- Schedules 1 and 6 would commence a month after the proposed regulations are registered on the Federal Register of Legislation.
- The other provisions would commence on the day after the proposed regulations are registered.

Section 3 - Authority

This section provides that the proposed regulations are made under the *Trade Marks Act 1995*.

Section 4 - Schedules

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

Schedule 1 – Increased period for filing of notice of intention to defend

This schedule amends the *Trade Marks Regulations 1995* to increase the period for filing a notice of intention to defend an opposition (NID) from one month to 2 months. It also updates the definition of the expression 'Madrid Regulations' to refer to the current version of the international instrument.

The Madrid Regulations are the *Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*. They govern the procedures under the 'Madrid System' for the international registration of trade marks and the extension of protection to international registrations designating Contracting Parties. Australia is a Contracting Party.

The current version of the Madrid Regulations is that in force on 1 November 2024. Its text can be found on the website of the World Intellectual Property Organization at <<https://www.wipo.int/>>.

International registrations designating Australia are called IRDAs. If the IRDA is accepted and no issues are raised during the oppositions period, the trade mark that is the subject of an IRDA becomes a protected international trade mark.

Part 17A of the Trade Marks Regulations governs the extension of protection to trade marks which are the subject of an IRDA (sometimes referred to simply as 'protection of an IRDA') as well as the amendment and cessation of protected international trade marks.

Items 1, 2, 5 and 6 – increasing the period for filing a NID

Filing an NID is an important step in trade mark oppositions. Failing to file the NID in time can mean the end of an opposition process. What this looks like will differ depending on the opposition process in question:

- For oppositions to the acceptance of a trade mark application or extension of protection to an IRDA, this can mean the end of the process for obtaining trade mark protection in Australia.
- For an opposition to an application to cease protection of a trade mark for non-use, failure by the applicant to file an NID can result in the failure of the non-use application – leaving the registered trade mark or protected international trade mark unaffected.

Under rule 17(2)(vii) of the Madrid Regulations, Australia is required to give the holder of an IRDA at least 2 months to respond to an opposition to extension of protection. Accordingly, item 5 amends subregulation 17A.34H(1) of the Trade Marks Regulations to allow the holder of an IRDA 2 months to file an NID in an opposition to extension of protection.

Item 1 amends subregulation 5.13(1) of the Trade Marks Regulations to allow the applicant for registration of a trade mark (the domestic equivalent of an IRDA) 2 months to file an NID in an opposition to registration. Although not required by the Madrid Regulations, this ensures that an applicant for registration of a trade mark receives the same treatment as the holder of an IRDA.

Items 2 and 6 amend subregulations 9.15(1) and 17A.48Q(1) of the Trade Marks Regulations respectively, to extend the time for filing an NID in an opposition to a non-use application. This too is not required by the Madrid Regulations. Nevertheless, non-use applications can substantially affect trade mark rights in Australia. As such, IP Australia considers it appropriate that the same period for filing an NID should apply in oppositions to non-use applications as applies to protecting trade marks in Australia. Amending both subregulations ensures the same treatment of the non-use applicant, whether the application is for removal of a registered trade mark or is for cessation of protection of a protected international trade mark.

Items 3 and 4 – updating the reference to the Madrid Regulations

The expression ‘Madrid Regulations’ is defined in regulation 17A.2 for the purposes of Part 17A of the Trade Marks Regulations. That definition is no longer up-to-date, as it refers to the Madrid Regulations as in force for Australia on 1 October 2020.

Item 3 updates that definition to refer to the Madrid Regulations as in force for Australia on 1 November 2024. Item 4 updates the Note 1 following the definition so that it advises the reader that the current version of the Madrid Regulations can be viewed on the website of the World Intellectual Property Organization this year. Previous versions of the Madrid Regulations have been viewable on that website and remain so.

Schedule 2 – Relationship between registered trade marks and protected international trade marks

This Schedule amends the Trade Marks Regulations to make provision for ‘partial’ replacement of national trade mark registrations (registered trade marks) by protected international trade marks.

The *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* (Madrid Protocol) article 4bis requires that Australian law permits national registrations to be ‘replaced’ by a protected international trade mark in certain circumstances. The Madrid Regulations rule 21 sets out these requirements in more detail.

Replacement is implemented in Trade Marks Regulations Part 17A Division 8. One of the prerequisites for replacement in existing paragraph 17A.54(1)(c) is that *all* the goods and services covered by the registered trade mark are covered by the protected international trade mark. In other words, the current provisions require *full* replacement.

Amendments to the Madrid Regulations rule 21, effective 1 November 2021, require that Contracting Parties permit a national trade mark registration to be *partially* replaced by a protected international trade mark.

The Schedule implements this requirement, makes consequential amendments, and also clarifies the provisions on replacement.

Item 1 – At the end of regulation 17A.4

This item adds a new sub-regulation (3) to regulation 17A.4 to clarify that the definition of ‘date of effect’ is subject to the replacement provisions in regulation 17A.54.

This amendment is intended to assist in the readability of the regulations, by indicating clearly in the main definition of ‘date of effect’ that it is subject to regulation 17A.54.

Item 2 – Paragraph 17A.54(1)(c)

This item amends paragraph 17A.54(1)(c) to allow for partial replacement. In particular, it is no longer a requirement that, to be replaced, *all* the goods and services of a registered trade mark must be covered by a protected international trade mark. Instead, it is sufficient that *some or all* of the goods or services of a registered trade mark are covered by the protected international trade mark.

When only some goods or services of the registered trade mark are covered by the protected international trade mark, the goods and services not covered by the protected international trade mark will not be replaced. If the national trade mark registration is not renewed, those goods and services will cease to be protected.

Item 3 – Subregulations 17A.54(2) and (3)

This item replaces existing subregulations 17A.54(2) and (3) with new subregulations 17A.54(2) and (3), to clarify the effect of replacement, particularly where some goods or services in the registered trade mark have different dates of registration, or if the protected international trade mark happens to have an earlier date of effect than the registered trade mark.

New subregulation 17A.54(2) provides that, for particular goods or services covered by both the registered trade mark and the protected international trade mark, the date of effect is taken to be the date of registration of the registered trade mark in respect of those goods or services.

Unlike the replaced subregulation 17A.54(3), new regulation 17A.54 does not refer to the priority date of the protected international trade mark. This is because, under existing subregulation 17A.3(2), the priority date for a protected international trade mark in respect of particular goods and services is simply its date of effect in respect of those goods and services. Adjusting the date of effect is therefore sufficient to adjust the priority date.

New subregulation 17A.54(3) provides that the date of effect will not be adjusted if, for particular goods and services, the new date of effect under subregulation 17A.54(2) would be *later* than the relevant date of effect before replacement, that is the date given by existing subregulations 17A.4(1) or (2).

The requirement of paragraph 17A.54(1)(a) is met when a registered trade mark becomes a protected international trade mark. While improbable, it is possible for a national trade mark application to be registered before an IRDA is protected, in circumstances where the protected international trade mark has an earlier date of effect than the national trade mark's registration date. This is because the timeframes from notification to protection of an IRDA, and from filing to registration of a national trade mark, are variable. In those circumstances, the protected international trade mark would be entitled to an earlier date of effect under subregulations 17A.4(1) or (2), than it would be under regulation 17A.54(2).

New subregulation 17A.54(3) clarifies that replacement should never result in a later date of effect for the protected international trade mark.

Item 4 – Regulation 17A.55

This item replaces regulation 17A.55 to indicate the effect of cancellation, removal or expiry of the national trade mark registration, given the possibility of partial replacement.

New subregulations 17A.55(1), (3) and (5) set out circumstances where replacement will be ceased and the original date of effect will be restored. New subregulations 17A.55(2), (4) and (6) set out exceptions, that is cases where replacement will not be ceased despite the usual operation of (1), (3) and (5).

The effect is that a voluntary choice by the owner will not lead to the ceasing of the effect of replacement, while a mandatory action by a Court or the Registrar will lead to the ceasing of this effect. The overall impact is the same as the replaced regulation 17A.55, with more explicit provisions given the complex circumstances that can arise due to partial replacement.

In the event of cancellation

New subregulation 17A.55(1) means that subregulation 17A.54(2) will cease to apply if the registered trade mark is cancelled (for example, by a Court under paragraph 88(1)(a) of the Trade Marks Act).

However, new subregulation 17A.55(2) means subregulation 17A.54(2) will continue to apply if the cancellation is at the request of the registered owner (for example, under section 84 of the Act).

This ensures that the holder is able to cancel the replaced registered trade mark, and keep only the protected international trade mark. The holder would only need to pay renewal fees for the protected international trade mark.

In the event of removal

New subregulation 17A.55(3) means that subregulation 17A.54(2) will cease to apply in respect of particular goods or services if the registered trade mark is removed from the Register for those goods or services (for example, after a removal for non-use under Part 9 of the Act).

However, new subregulation 17A.55(4) means subregulation 17A.54(2) will continue to apply if the removal is under paragraph 78(b) or 80F(b) of the Act, that is as a result of the expiry of the trade mark if it is not renewed by the owner.

This ensures that the holder is able to let the replaced registered trade mark expire and then be removed from the Register, and keep only the protected international trade mark. The holder would only need to pay renewal fees for the protected international trade mark.

In the event of amendment or correction

New subregulation 17A.55(5) means that subregulation 17A.54(2) will cease to apply in respect of particular goods or services if an entry in the Register is amended or corrected, such that the trade mark is no longer

registered in respect of those goods or services. (For example, this might happen as the result of a Court order under paragraph 88(1)(b) of the Act.)

New subregulation 17A.55(6) means subregulation 17A.54(2) will continue to apply if the amendment is at the request of the owner. (For example, under section 83 of the Act.)

This ensures that, where a registered trade mark has been partially replaced by a protected international trade mark, the owner can amend the trade mark registration so that it no longer covers the replaced goods or services. In some cases, this may provide cost efficiencies when renewing the registered trade mark.

Schedule 3 – Rejecting IRDA on basis of sanctions regime

This Schedule amends the Trade Marks Regulations to introduce a new ground for rejecting an IRDA if its protection would result in an asset being made directly or indirectly available to, or for the benefit of, a person or entity to whom assets must not be made available under the *Autonomous Sanctions Act 2011*, the *Charter of the United Nations Act 1945*, or their regulations (the ‘sanctions laws’).

This provides an express power to refuse protection of an IRDA in circumstances where protection would be inconsistent with the intent of the sanctions laws. A specific ground for rejection is required because, unless the Registrar has notified the International Bureau of a provisional refusal or that late oppositions may be possible, IRDAs are automatically protected by operation of law 18 months after their notification to Australia.¹ By providing a ground for rejecting an IRDA in these circumstances, a provisional refusal can be issued,² which in turn ensures that the IRDA is not protected automatically.

A similar power is not needed for directly filed national trade mark applications, which do not automatically proceed to registration by operation of law. Instead, the Registrar must ordinarily register these directly filed trade mark applications only when they have been positively accepted for registration and have not been opposed (or if an opposition was unsuccessful).³ In these cases, the effect of the sanctions laws⁴ is that the Registrar has no power to register a trade mark where such registration would contravene those sanctions laws. The sanctions laws therefore prevent registration of a national trade mark whose registration would contravene sanctions. Because IRDAs are protected automatically by operation of law (rather than by action of the Registrar), the sanctions laws do not prevent protection of an IRDA in the same way.

The addition of this ground for rejecting an IRDA has the effect of bringing the outcomes for IRDAs in line with those for national trade mark applications in similar circumstances.

Item 1 – At the end of subregulations 17A.24(1) and (3)

This item adds a note clarifying that the grounds for rejecting an IRDA are set out in regulation 17A.28, which includes the new ground for rejection.

Item 2 – Subregulation 17A.28(1)

This item replaces subregulation 17A.28(1) to clarify that the grounds for rejecting an IRDA include sections 39-44 of the Trade Marks Act, as affected by subregulation 17A.28(2).

Item 3 – After subregulation 17A.28(2)

This item adds new subregulation 17A.28(2A), which introduces a new ground for rejecting an IRDA.

Paragraph 17A.28(2A)(a) provides that there is a ground for rejecting an IRDA if protection would result in an asset (within the meaning of the *Autonomous Sanctions Act*) being made directly or indirectly available to, or for the benefit of, a designated person or entity (within the meaning of the *Autonomous Sanctions Regulations 2011*), other than in accordance with a permit granted under those regulations. Otherwise, the conferral of the protection could engage the prohibition in regulation 14 of the *Autonomous Sanctions Regulations*.

Paragraph 17A.28(2A)(b) provides that there is a ground for rejecting an IRDA if protection would result in an asset (within the meaning of the *Charter of the United Nations Act*) being made directly or indirectly available to, or for the benefit of, a person or entity prescribed by regulations made for the purposes of Part 3 of that Act, other than in accordance with a permit issued under those regulations.

¹ Trade Marks Regulations, subregulation 17A.36(5).

² Since a provisional refusal is to be issued if the Registrar reasonably believes there are grounds for rejecting an IRDA: subregulation 17A.16(1).

³ Trade Marks Act 1995, section 68.

⁴ *Autonomous Sanctions Act* sections 12 and 13, *Charter of the United Nations Act* sections 9 and 10.

Part 3 of the Charter of the United Nations Act gives effect to decisions of the United Nations Security Council made under Chapter VII of the Charter of the United Nations, that Australia is required to carry out, relating to sanctions. This is achieved through regulations made for the purposes of that Part.

These sanction frameworks generally prohibit a person from directly or indirectly making an asset available to, or for the benefit of a designated person or entity, which usually includes persons or entities designated by the Security Council or a Committee established under a resolution of the Security Council. However, some frameworks extend the prohibition to other persons and entities, including persons or entities acting on behalf of or at the direction of a designated person or entity, and an entity that is owned or controlled, by a person or entity acting on behalf of or at the direction of a designated person or entity (see for example, paragraph 12(2)(a) of the *Charter of the United Nations (Sanctions – Democratic People's Republic of Korea Regulations 2008)*).

Use of the expression 'a person or entity prescribed by regulations' in paragraph 17A.28(2A)(b) is intended to capture the extended range of persons or entities to whom an asset may not be made available under regulations made for the purposes of Part 3 of the Charter of the United Nations Act, beyond solely designated persons and entities. All such persons or entities are intended to be covered by the expression 'a person or entity prescribed by regulations'.

The new paragraph 17A.28A(2A)(b) is intended to apply when protection would result in making an asset available to persons or entities prescribed under regulations implementing Part 3 of the Charter of the United Nations, including for example:

- a designated person or entity
- a person or entity acting on behalf of or at the direction of a designated person or entity
- an entity owned or controlled by a designated person or entity.

Paragraph 17A.28(2A)(c) provides that there is a ground for rejecting an IRDA if protection would result in an asset (within the meaning of the Charter of the United Nations Act) being made directly or indirectly available to, or for the benefit of, a proscribed person or entity (within the meaning of Part 4 of that Act), other than in accordance with a notice under section 22 of that Act. Otherwise, the conferral of the protection could engage the prohibition in section 21 of the Charter of the United Nations Act.

Exemptions in the form of a permit or notice may permit assets to be made available to persons or entities when this would otherwise be prohibited by the Autonomous Sanctions Act, Charter of the United Nations Act, or their regulations. For each of paragraphs 17A.28(2A)(a)-(c), the ground for rejection does not apply if the applicable permit or notice has been obtained.

Item 4 – Before subregulation 17A.28(3)

This item adds a subheading for clarity.

Schedule 4 – Registrar’s power to revoke acceptance of IRDA

This Schedule amends the Trade Marks Regulations so that an IRDA will not become a protected international trade mark if the Registrar has issued a notice of intention to revoke its acceptance.

Regulation 17A.27 provides that the Registrar may revoke the acceptance of an IRDA before the IRDA becomes a protected international trade mark. This can occur if the Registrar becomes satisfied that the IRDA should not have been accepted and it is reasonable to revoke, taking into account all the circumstances. When acceptance is revoked, an IRDA is taken never to have been accepted.

Where the Registrar considers that an IRDA’s acceptance should possibly be revoked, the Registrar will notify a holder of an IRDA of their intention to revoke the acceptance of the IRDA. Ideally, the Registrar will allow time for the holder to make representations in response to this notification, to allow the Registrar to be properly informed before making the final decision on whether or not to revoke.

The changes in this Schedule mean that once the Registrar notifies that they may revoke acceptance, the IRDA will not automatically become protected while the Registrar considers their decision. This will allow appropriate time for the holder to make representations, and for the Registrar to consider those representations, before making any revocation decision.

The changes are all still subject to the 18-month backstop which operates due to the existing subregulation 17A.36(5), and gives effect to Australia’s obligation to notify certain objections to the International Bureau which administers the Madrid System, within 18 months of the notification of an IRDA. If the conditions in 17A.36(5) are met, the IRDA will be protected, irrespective of any other events.

Item 1 – At the end of subregulation 17A.36(2)

This item amends subregulation 17A.36(2) to indicate it has effect subject to new subregulation 17A.36(2AA).

The existing subregulation provides that if the Registrar accepts an IRDA, the IRDA becomes a protected international trade mark at the end of the opposition period if no notice of intention to oppose the IRDA is filed, or if a notice of intention to oppose is filed but a statement of grounds and particulars is not filed (subparagraphs 17A.36(2)(b)(i) and (ii)).

This item clarifies that this provision is now subject to the new subregulation 17A.36(2AA).

Item 2 – After subregulation 17A.36(2)

This item inserts a new subregulation 17A.36(2AA), to provide for the circumstances when an IRDA becomes a protected international trade mark after the Registrar has notified the holder of the IRDA of the intention to revoke acceptance.

The new subregulation applies when either subparagraphs (2)(b)(i) or (ii) apply (so either no notice of intention to oppose has been filed, or a notice of intention was filed but no statement of grounds and particulars has been filed) and the Registrar has notified the holder of the IRDA of the intention to revoke acceptance, but the final decision regarding the revocation has not been made.

The new subregulation provides that, in those scenarios, the IRDA does not become a protected international trade mark at the end of the opposition period. This is to allow the process of revocation to take its course.

The IRDA will, however, become a protected international trade mark as soon as the Registrar makes a decision not to revoke acceptance. If the Registrar instead decides to revoke acceptance, the IRDA is taken never to have been accepted, due to subregulation 17A.27(2).

The new subregulation does not override the default provisions in subregulation 17A.36(5), which may still result in an IRDA being automatically protected 18 months after notification in some circumstances, even if a notice of intention to revoke acceptance has been issued.

Schedule 5 – Dealing with opposition to trade mark applications or removal of trade mark for non-use

This Schedule amends the Trade Marks Regulations to provide the Registrar powers to end an opposition when it is not being progressed to a hearing or final decision.

This Schedule deals with certain types of oppositions, referred to generally as ‘oppositions’ below. Other opposition types have different procedures and are not covered by this Schedule.

This Schedule applies to:

- oppositions to registration of a trade mark (‘oppositions to registration’)
- oppositions to extension of protection to the trade mark that is the subject of an IRDA (‘oppositions to protection’)
- opposition to removal of a trade mark from the Register for non-use
- oppositions to cessation of protection of a protected international trade mark for non-use.

After the end of the period for providing evidence in oppositions, a hearing may be requested by either party. There is currently no time limit or obligation to do so.

Even if neither party requests a hearing, the Registrar may choose to hold a hearing on their own initiative.⁷ The Registrar may also decide a matter without a hearing in certain circumstances, including that no party has requested an oral hearing.⁸ Critically, whichever approach is taken, there is a fee payable,⁹ and without payment of the fee, the Registrar cannot make a decision.¹⁰

Under the existing Trade Marks Regulations, when neither party to an opposition requests a hearing or pays the fee to have the matter decided, the Registrar lacks the power to end the opposition and the opposition remains in ‘limbo’. A number of these matters have accumulated and sit unresolved on the Register, creating uncertainty for other trade mark applicants.

New discretionary power to end oppositions

The amendments in this Schedule resolve this issue by providing a new discretionary power to end oppositions, triggered by a failure of a party to progress the matter to a hearing or pay the necessary fees. Once it is time to request a hearing, the new regulations place obligations on one party: the opponent in an opposition to registration or to protection, and the non-use applicant in oppositions to non-use removal or cessation. The obligation sits with the party which initiated the action.

The party subject to these obligations (the ‘relevant party’) can either:

- i. Request a hearing, and then pay the applicable fees to be heard. As a practical matter, a party is expected to pay the applicable fees at the time of requesting a hearing.
- ii. Not request a hearing, but pay the applicable fees for a decision (likely to be the fee for a decision without a hearing).

Where the relevant party has failed to request a hearing, the Registrar must wait 3 months before acting, to allow the party time to request a hearing and/or pay the applicable fees.

If the relevant party has not met either requirement and 3 months have elapsed, the Registrar may end the opposition unfavourably to the party on whom the obligation sits. For oppositions to registration or to protection, this means the opposition would be dismissed. For oppositions to non-use removal or cessation, this means the opposition would be ended favourably to the non-use opponent.

This is a discretionary power and is only intended to be used as a last resort where the matter is not progressing. For that reason there is no need for a formal extension of time provision. Should parties be engaged in the process, the Registrar would not need to use this power.

It is important to note that, while the Schedule places new obligations on one party, they are modest. The party is at no risk of having the opposition ended unfavourably under these provisions if they simply continue to participate in the opposition process, whether by requesting a hearing, paying the fee to have a decision made without a hearing, or paying the fee to be heard in a hearing requested by the other party. Should they not do so, the default will be the state of the Register of Trade Marks (the Register) had the party not commenced an opposition to registration or to protection, or had they not taken a non-use action.

Item 1 – At the end of paragraph 5.4(1)(b)

This item amends paragraph 5.4(1)(b) to exclude decisions under new regulation 5.17A from the rules in regulation 5.4.

Regulation 5.4 provides for a detailed process of notification of proposed decisions, opportunities for representation, and then notification of outcome. The decision in new regulation 5.17A is a relatively simple one, and does not require the formal procedure set out in regulation 5.4. However, despite the inapplicability of regulation 5.4, the Registrar will still need to act fairly before making a decision under regulation 5.17A.

Item 2 – At the end of Division 4 of Part 5

This item adds a new regulation 5.17A, to provide for the dismissal of an opposition to registration for the opponent's failure to do things in relation to a hearing.

Subregulation 5.17A(1) covers the case where the opponent fails to request a hearing before the end of three months beginning on the day the opponent may request a hearing. (An opponent may request a hearing if the conditions in subregulation 5.17(3) are satisfied.)

If the opponent has not requested a hearing, they may still pay the applicable fee under item 15 or 16 of the table in subclause 1(1) of Schedule 9 of the Trade Marks Regulations. The applicable fee is usually in item 16, which applies when the Registrar is to make a decision but no party has requested a hearing or been heard by the Registrar. However, the fee in item 15 may be applicable, for example, because the other party (the applicant) has requested a hearing, or the Registrar has decided to hold a hearing on their own initiative.

If no hearing is requested, and no fee is paid, then the Registrar may dismiss the opposition.

Subregulation 5.17A(2) covers the case where the opponent requests a hearing. In this case, the opponent may pay the applicable fee in item 15 of the table in subclause 1(1) of Schedule 9 (the applicable fee will vary depending on whether the hearing will be oral or by means of written submissions).

If a hearing is requested, but no fee is paid, then the Registrar may dismiss the opposition.

Subregulation 5.17A(3) provides for review by the Administrative Review Tribunal (ART) of a decision to dismiss the opposition. While a decision to dismiss will normally be a straightforward result of the opponent's failure to engage with the opposition process, given the serious consequences of such a decision, administrative review is appropriate.

Item 3 – Regulation 5.20

This item amends regulation 5.20 to require notice to the parties of dismissal under the new regulation 5.17A.

Item 4 – At the end of paragraph 9.4(1)(b)

This item amends paragraph 9.4(1)(b) to exclude decisions under new regulation 9.20A from the rules in regulation 9.4.

This is the equivalent of item 1, but in respect of oppositions to non-use removals.

Item 5 – At the end of Division 5 of Part 9

This item adds a new regulation 9.20A, to provide for an opposition to non-use removal to be taken to have succeeded after the non-use applicant's failure to do things in relation to a hearing.

Regulation 9.20A largely follows the pattern of new regulation 5.17A. However, there are differences reflecting the rules applicable to non-use removals, and that the outcome of a failure to request a hearing for an opposition to a non-use removal will be that the trade mark will remain on the Register.

It is appropriate for the obligation to continue the hearing process to fall on the applicant for removal for non-use, even though the opposition in question is an opposition to removal for non-use. As noted previously by the Federal Court, the removal applicant is the substantive moving party responsible for initiating and prosecuting the removal.⁵

Subregulation 9.20A(1) covers the case where the applicant for removal for non-use fails to request a hearing before the end of three months beginning on the day the applicant may request a hearing. (An applicant may request a hearing if the conditions in subregulation 9.20(2) are satisfied.)

If the applicant has not requested a hearing, they may still pay a fee under item 15 or 16 of the table in subclause 1(1) of Schedule 9 of the Trade Marks Regulations. Usually, the applicable fee will be that in item 16, which applies when the Registrar is to make a decision but no party has requested a hearing or been heard by the Registrar. However, the fee in item 15 may be applicable, for example, because the other party (the opponent) has requested a hearing, or the Registrar has decided to hold a hearing on their own initiative.

If no hearing is requested, and no fee is paid, then the Registrar may take the opposition to removal for non-use to have succeeded, resulting in the trade mark not being removed from the Register

Subregulation 9.20A(2) covers the case where the applicant requests a hearing. In this case, the applicant may pay the applicable fee in item 15 of the table in subclause 1(1) of Schedule 9 (the applicable fee will vary depending on whether the hearing will be oral or by means of written submissions).

If a hearing is requested, but no fee is paid, then the Registrar may take the opposition to removal to have succeeded.

Subregulation 9.20A(3) requires notice to the parties of a decision under subregulations 9.20A(1) or (2).

Subregulation 9.20A(4) provides for review by the ART of a decision under subregulations 9.20A(1) or (2). While a decision under these subregulations will normally be a straightforward result of the applicant's failure to engage with the opposition process, given the serious consequences of such a decision, administrative review is appropriate.

Items 6, 7, and 8 – At the end of paragraph 17A.31(1)(b), after regulation 17A.34M, and regulation 17A.35

These items amend paragraph 17A.31(1)(b), add a new regulation 17A.34MA, and amend regulation 17A.35.

They are the equivalents of items 1, 2 and 3, but in respect of oppositions to protection rather than oppositions to registration.

Items 9 and 10 – At the end of paragraph 17A.48B(1)(b) and after regulation 17A.48V

These items amend paragraph 17A.48B(1)(b) and add a new regulation 17A.48VA.

They are the equivalents of items 4 and 5, but in respect of oppositions to cessation of protection for non-use, rather than oppositions to removal for non-use.

⁵ *Hungry Spirit Pty Limited ATF The Hungry Spirit Trust v Fit n Fast Australia Pty Ltd* [2020] FCA 883 [16].

Schedule 6 – Extending period for examining trade mark applications where a hearing is requested

This Schedule amends the Trade Marks Regulations so that an applicant or holder does not need to request an extension of time to cover the period for examining trade mark applications or IRDAs, after a hearing is requested. These amendments aim to simplify processes and minimise costs and administrative burdens.

The provisions provide a new ground for deferment of acceptance due to the applicant or holder requesting a hearing. Deferment of acceptance effectively pauses the deadline after which, if examination is not completed, an application will lapse (or the examination period for an IRDA will end).⁶ Even during a deferment, the trade mark examination must still be completed as soon as practicable.⁷

Item 1 – After paragraph 4.13(2)(c)

This item inserts a new paragraph (ca) to subregulation 4.13(2), to allow the Registrar to defer acceptance at their own initiative where the applicant has made a request to be heard in relation to the application.

Item 2 – At the end of subparagraph 4.14(3)(g)(ii)

This item adds the word ‘and’ at the end of subparagraph 4.14(3)(g)(ii) to ensure proper conjunction with the new paragraph being added.

Item 3 – After paragraph 4.14(3)(g)

This item inserts a new paragraph (ga) to subregulation 4.14(3), specifying that if acceptance is deferred because of a hearing request (under paragraph 4.13(2)(ca)), the deferral period ends on the earlier of the day the applicant withdraws the request to be heard or the day the Registrar decides to accept or reject the application. This ensures that the examination period is paused during the hearing process.

Items 4 and 5 – After paragraph 17A.21(2)(c) and after paragraph 17A.22(3)(h)

These items insert a new paragraph (ca) to subregulation 17A.21(2), and a new paragraph (ha) to regulation 17A.22(3). These are the equivalents of items 1 and 3, but with respect to IRDAs, rather than applications for registration.

Schedule 7 – Technical amendments

This schedule makes two technical amendments to the Trade Marks Regulations. These both substitute the word ‘or’ in place of the previous ‘and’ in subparagraphs 4.14(3)(j)(i) and 17A.22(3)(j)(i).

These subparagraphs relate to when the deferment period ends if acceptance is deferred for a certification trade mark application (or IRDA) when a copy of the rules governing the use of the certification trade mark is sent to the Australian Competition and Consumer Commission.

⁶ Trade Marks Regulations, subregulations 4.12(2); 17A.20(2).

⁷ Trade Marks Act, section 204.

Schedule 8 – Application provisions

This Schedule amends the Trade Marks Regulations to set out how the amendments in Schedules 1 to 6 apply in certain circumstances and to save the operation of any repealed provisions, as necessary.

Item 1 – In the appropriate position in Part 22

This item inserts application provisions in Part 22 of the Trade Marks Regulations, which deals with applications, savings and transitional provisions.

22.31 - Application provisions—increased period for filing of notice of intention to defend

New regulation 22.31 sets out how the amendments in Schedule 1 apply to existing trade mark applications and IRDAs.

Subregulations 22.31(1) and (3) provide for the application of the new time limits in Schedule 1 to oppositions to registration and oppositions to IRDAs respectively. In either case, the new time limits apply where acceptance has been published on or after commencement.

Subregulations 22.31(2) and (4) provide for the application of the new time limits in Schedule 1 to oppositions to non-use removal and oppositions to cessation for non-use, respectively. In either case, the new time limits apply where the non-use application has been published on or after commencement.

Where publication occurred before the new provisions commence, the existing time limits continue to apply, even if they would have ended after commencement. This ensures certainty about these time limits.

22.32 - Application provisions – relationship between registered trade marks and international trade marks

New regulation 22.32 provides that the changes in Schedule 2 apply to a registered trade mark becoming a protected international trade mark, whether that occurred before or after commencement.

The changes in Schedule 2 apply to trade marks that became protected international trade marks before commencement. In some cases, these changes alter existing rights, and in this sense may be said to effectively operate retrospectively. In particular, where a registered trade mark became a protected international trade mark before commencement and both trade marks met the criteria for partial replacement in the provisions as amended by Schedule 2, the effect of regulation 22.32 in combination with Schedule 2 is that, on commencement, the ‘date of effect’ of the protected international trade mark’s goods and services will become the earlier date of those goods and services in the national registration.⁸ The exclusive right of the holder to use the mark accrues from its date of effect.⁹ It follows that this alteration to an existing right could be characterised as ‘substantively retrospective’.¹⁰

While the provisions are retrospective in this sense, this is appropriate and necessary. The amendments do not affect any rights so as to disadvantage any person, nor do they impose liabilities for things done before registration. As such they do not raise any issues with subsection 12(2) of the *Legislation Act 2003*.

The amendments do not disadvantage any person because the amendments would only provide an earlier date of effect in respect of particular goods and services in cases where there is already a national registered trade mark that covers those goods and services owned by the same entity. The substantive rights given by the protected international trade mark are no broader than the substantive rights given by the national registered trade mark,¹¹ so the change has no overall effect on third parties. The only effect is a positive one for owners –

⁸ This is a consequence of new regulation 17A.54.

⁹ Trade Marks Act, subsection 20(3), as applied to a protected international trade mark by Trade Marks Regulations, regulation 17A.39

¹⁰ *ADCO Constructions Pty Ltd v Goudappel* (2014) 254 CLR 1 at [48].

¹¹ See Trade Marks Regulations, regulation 17A.39.

permitting the owner of the protected international trade mark to abandon the national trade mark registration and maintain only one international portfolio of marks, thereby avoiding unnecessary fees.

The changes are also necessary to implement Australia's obligations under the Madrid Protocol. The Madrid Protocol and Regulations make clear that replacement occurs from the date of effect of the protected international trade mark.¹² It is in Australia's interests to implement partial replacement in a way which is consistent with other jurisdictions.

22.33 - Application provisions – rejecting IRDA on basis of sanctions regime

New regulation 22.33 provides that the amendments in Schedule 3 apply to an IRDA of which the Registrar has been notified on or after commencement. As described in existing regulation 17A.12, notification of an IRDA is the process by which the International Bureau makes the Registrar aware of an IRDA. This is effectively equivalent to an application for registration of a trade mark which has been made under section 27 of the Trade Marks Act. The difference is that for an IRDA, the International Bureau acts as the notifying intermediary.

It follows that the amendments do not apply to IRDAs notified before commencement, including where the Registrar has not yet examined or accepted the IRDA.

22.34 - Application provisions – Registrar's power to revoke acceptance of IRDA

New regulation 22.34 provides that the amendments in Schedule 4 apply to IRDAs accepted on or after commencement.

It follows that the amendments do not apply to IRDAs accepted before commencement, even if the Registrar issues a notice of intention to revoke acceptance after commencement.

22.35 - Application provisions – Dealing with opposition to trade mark applications or removal of trade mark for non-use

New regulation 22.35 sets out how the amendments in Schedule 5 apply to existing oppositions to trade mark registrations or to IRDAs, and oppositions to removal or to ceasing of protection for non-use.

The new power to end oppositions to registration or IRDAs provided for in Schedule 5 is triggered 3 months after the opponent can request a hearing (should they fail to take the relevant actions). In turn, the power to request a hearing is triggered by the end of an evidentiary period (as provided in subregulations 5.17(3) and 17A.34M(3)). Subregulations 22.35(1) and (3) provide that the new provisions apply to oppositions to registration and to IRDAs, respectively, where that evidentiary period ends on or after commencement.

Similarly, the powers to end oppositions to non-use removal or cessation for non-use are triggered 3 months after the removal applicant can request a hearing (should they fail to take the relevant actions). The power to request a hearing is triggered by the end of an evidentiary period (as provided in subregulations 9.20(2) and 17A.48V(2)). Subregulations 22.35(2) and (4) provide that the new provisions apply to oppositions to non-use removal and to cessation for non-use, respectively, where that evidentiary period ends on or after commencement.

As such, if the relevant evidentiary period has finished before commencement, the new provisions do not apply. However, pending oppositions may nevertheless be affected by the transitional provisions in new regulation 22.36.

22.36 - Transitional provisions – Dealing with opposition to trade mark applications or removal of trade mark for non-use

New regulation 22.36 provides for transitional provisions for oppositions where the new provisions in Schedule 5 do not apply. As mentioned under Schedule 5, there is a number of existing pending oppositions in 'limbo', where neither side will request a hearing nor pay the fee for a decision to be made. The transitional provisions in

¹² Madrid Protocol article 4*bis*(1) and Madrid Regulations rule 21(3)(e).

regulation 22.36 are intended to allow these oppositions to be resolved in an analogous way to the process for ending oppositions in Schedule 5.

The transitional provisions provide a fresh three months to request a hearing. This is because the Trade Mark Regulations presently do not require either side to request a hearing, and so it would be unfair to attach consequences to a past failure to request a hearing.

Subregulation 22.36(1) provides that the Registrar may dismiss an opposition to registration, where the following conditions are met:

- the opposition is pending on commencement
- the opponent has been able to request a hearing, but has not done so at commencement
- at the end of 3 months beginning on the day of commencement, the opponent does not request a hearing
- the opponent has not paid the applicable fee (typically the fee for a decision without requesting a hearing).

As with the analogous provisions in Schedule 5, the Registrar must provide notice of the decision to dismiss an opposition (subregulation 22.36(2)). The decision may be reviewed by the ART (subregulation 22.36(3)).

New subregulation 22.36(4) largely follows the pattern of new subregulation 22.36(1). However, there are differences reflecting the rules applicable to non-use removals, and that the outcome of a failure to request a hearing for an opposition to a non-use removal will be that the trade mark will remain on the Register.

The provision provides the Registrar may take the opposition to have succeeded, and refuse to remove the mark from the Register, where the following conditions are met:

- the application for removal is pending on commencement
- the opposition to the application was filed before commencement
- the applicant was able to request a hearing, but had not done so at commencement
- at the end of three months beginning on the day of commencement, the applicant has not requested a hearing
- the applicant has not paid the applicable fee (typically the fee for a decision without requesting a hearing).

The provisions in new subregulations 22.36(5) and (6) are the equivalents of subregulations 22.36(2) and (3), providing for notification of the decision and ART review.

The provisions in new subregulations 22.36(7) – (9) are the equivalents of subregulations 22.36(1) – (3), but in respect of oppositions to IRDAs rather than oppositions to registration.

The provisions in new subregulations 22.36(10) – (12) are the equivalents of subregulations 22.36(4) – (6), but in respect of oppositions to cessation of protection for non-use rather than oppositions to removal for non-use.

23.37 - Application provisions - Extending period for examining trade mark applications where a hearing is requested

New regulation 23.37 sets out how the amendments in Schedule 6 apply to existing trade mark applications and IRDAs. The changes apply to requests to be heard that are made on or after commencement. It follows that the changes do not apply to hearings requested before commencement, even if the hearing has not yet occurred at commencement.