



**Trade Marks Regulations 1995**

**Statutory Rules 1995 No. 341 as amended**

made under the

*Trade Marks Act 1995*

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Consolidated as in force on 1 November 1998

(includes amendments up to SR 1998 No. 265)

Prepared by the Office of Legislative Drafting,  
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### Statutory Rules 1995 No. 341 as amended

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## **Part 1 Preliminary**

### **1.1 Name of regulations** [*see* Note 1]

These regulations are the *Trade Marks Regulations 1995*.

### **1.2 Commencement**

These regulations commence on 1 January 1996.

## **Part 2 Interpretation**

### **2.1 Interpretation**

In these regulations, unless the contrary intention appears:

*Act* means the *Trade Marks Act 1995*.

*certificate of verification* means a statement:

- (a) that a document to which the statement relates:
  - (i) has been translated by a person who is proficient in both the language from which the document has been translated into English and English; and
  - (ii) is a true and complete translation of the accompanying document to the best of the knowledge of the person who signs the statement; and
- (b) that is dated and signed.

*earlier application*, in relation to an application for the registration of a trade mark for which a right of priority is claimed, means an application for the registration of that trade mark in a Convention country:

- (a) that was filed, at the trade marks office (or its equivalent) of that Convention country, before the application for which the right of priority is claimed; and
- (b) on which the claim for the right of priority is based.

*working day* means a day other than a Saturday, a Sunday or a public holiday for the purposes of the Australian Public Service.

## **Part 3 Trade marks and trade mark rights**

### **3.1 Classification of goods and services**

- (1) For the purposes of subsection 19 (3) of the Act (which deals with the classification of goods and services):
  - (a) goods are divided into the classes of goods described in column 2 of Part 1 of Schedule 1; and
  - (b) services are divided into the classes of services described in column 2 of Part 2 of Schedule 1.

- (2) Each class of goods or services described in Schedule 1 has:
  - (a) a class number corresponding to the item number of that class in column 1 of Part 1 or 2 of Schedule 1; and
  - (b) a class heading corresponding to the description of that class in column 2 of Part 1 or 2 of Schedule 1.

### **3.2 Period in which action for infringement may be brought**

For the purposes of paragraph 26 (1) (b) of the Act (which deals with powers of the authorised user of a trade mark), the prescribed period is 2 months from the day on which the authorised user of a trade mark asks the registered owner of the trade mark to bring an action for infringement of the trade mark.

## **Part 4 Application for registration**

### **4.1 Applications — approved form**

- (1) For the purposes of subsection 27 (2) of the Act (which deals with applications for registration), an application for the registration of a trade mark must be in an approved form.
- (2) Any material that is intended by the applicant to form part of the application for registration of a trade mark:
  - (a) must be attached to the application; and
  - (b) is taken to be part of the application.

### **4.2 Applications — requirements for filing**

- (1) In order for an application for registration of a trade mark to be taken to be filed, the application must:
  - (a) state that the application is for registration of the trade mark, or contain a clear indication to that effect; and
  - (b) include a representation of the trade mark that is sufficient to identify the trade mark; and
  - (c) specify the goods and/or services in relation to which the application is made; and
  - (d) specify the name of the applicant; and
  - (e) contain sufficient information to enable the Registrar to contact the applicant.
- (2) If an application does not meet a requirement set out in paragraph (1) (a), (b), (c) or (d), the Registrar must give to the applicant written notice of the requirement.
- (3) If the applicant meets the requirement within a period of 2 months from the date of the notice, the application is taken to be filed on the day on which the requirement is met.
- (4) If the applicant does not meet the requirement within that period, the application is taken not to have been filed.



### 4.3 Representation of trade marks

- (1) If practicable, the representation of a trade mark included in an application for registration of the trade mark must not exceed 8 centimetres by 8 centimetres.
- (2) In an application for the registration of 2 or more trade marks as a series, the representation of each trade mark in the series must, if practicable, not exceed 8 centimetres by 8 centimetres.
- (3) In an application for the registration of a trade mark that contains, or consists of, a 3 dimensional shape:
  - (a) if practicable, the representation of the trade mark in the application must be illustrated in a perspective that shows each feature of the trade mark; and
  - (b) otherwise, the representation of the trade mark in the application must include views of the trade mark that are necessary to show each feature of the trade mark.
- (4) If the Registrar reasonably believes that the views of a trade mark to which paragraph (3) (a) or (b) applies are not sufficient to allow all features of the trade mark to be properly examined, the Registrar may, by notice in writing, require the applicant to give to the Registrar up to 6 additional views of the trade mark that show the features sufficiently to permit proper examination of the trade mark.
- (5) If the representation of a trade mark in an application for registration of the trade mark includes words of a language other than English, the applicant must file in support of the application a translation of the words into English.
- (6) If the representation of a trade mark in an application for registration of the trade mark includes characters constituting words, being characters that are not roman letters, the applicant must file in support of the application:
  - (a) a transliteration of the characters into roman letters, using the recognised system of romanisation of the characters (if any); and
  - (b) a translation of the words into English.
- (7) If a trade mark for which registration is sought contains or consists of a sign that is a colour, scent, shape, sound or an aspect of packaging, or any combination of those features, the application for registration of the trade mark must include a concise and accurate description of the trade mark.
- (8) If the Registrar reasonably believes that the description or representation of a trade mark in an application for registration of the trade mark does not:
  - (a) demonstrate the nature of the trade mark sufficiently; or
  - (b) show each feature of the trade mark sufficiently;to permit proper examination of the trade mark, the Registrar may require the applicant to give to the Registrar:
  - (c) a description, or further description, of the trade mark; and
  - (d) a specimen of the trade mark.
- (9) If a representation of a single trade mark exceeds, or the representations of the trade marks in a series of trade marks together exceed, 8 centimetres by 8 centimetres, the representation or representations:

- (a) must be attached to the application for registration of the trade mark or trade marks; and
  - (b) must be taken to be part of the application.
- (10) The representation of a trade mark in an application for registration of the trade mark must be of a kind and quality that:
- (a) ensures that the features of the trade mark will be preserved in the course of time; and
  - (b) is suitable for reproduction.

#### **4.4 Specification of goods and/or services**

- (1) For the purposes of paragraph 27 (3) (b) of the Act, the following subregulations set out the manner of specifying, in an application for the registration of a trade mark, the goods and/or services in respect of which registration is sought.
- (2) The expression “all goods”, “all services”, “all other goods”, or “all other services” must not be used in an application for registration of a trade mark to specify the goods and/or services in respect of which registration is sought.
- (3) The goods and/or services must be grouped according to the appropriate classes described in Schedule 1.
- (4) The applicant must nominate the class number that is appropriate to the goods or services in each group.
- (5) The groups must be listed in the order of their class numbers.
- (6) The goods and/or services must, as far as practicable, be specified in terms appearing in any listing of goods and services that is:
  - (a) published by the Registrar; and
  - (b) made available for inspection by the public at the Trade Marks Office and its sub-offices.
- (7) If any of the goods and/or services cannot be specified using terms referred to in subregulation (6), the applicant must provide sufficient information to enable the Registrar to decide the classification of the goods and/or services.

#### **4.5 Period for claiming priority for an application**

For the purposes of subsection 29 (1) of the Act (which deals with claims for priority), the prescribed period in relation to a claim for a right of priority for an application is 2 working days after filing the application.

#### 4.6 How to claim priority

- (1) For the purposes of subsection 29 (1) of the Act (which deals with claims for priority), an applicant must claim a right of priority for an application by filing notice of the claim.
- (2) Any notice under subregulation (1) must specify, in respect of the earlier application or, if there is more than 1 earlier application, in respect of each earlier application:
  - (a) the Convention country in which the earlier application was filed at the trade marks office (or its equivalent) of that Convention country; and
  - (b) the date on which the earlier application was filed; and
  - (c) if a number is allocated to the earlier application in the trade marks office (or its equivalent) of that Convention country — that number.
- (3) If, as a result of a claim for a right of priority, more than 1 priority date applies in relation to an application, a person who claims a right of priority under subsection 29 (1) of the Act must specify the goods and/or services to which each priority date relates.

#### 4.7 Publication of particulars of application

- (1) For the purposes of section 30 of the Act (which deals with publishing particulars of applications), the Registrar must publish the following particulars of the application:
  - (a) if a number has been allocated to the application in the Trade Marks Office — the number;
  - (b) the applicant's name;
  - (c) the date of filing the application;
  - (d) if the application is a divisional application — particulars of the initial application;
  - (e) particulars of any claim for a right of priority for the application;
  - (f) the class number or numbers for the goods and/or services in respect of which registration of the trade mark is sought.
- (2) The particulars must be published in 1, or more than 1, of the following ways:
  - (a) publication in the *Official Journal*;
  - (b) listing in a computer database maintained by the Trade Marks Office;
  - (c) making a record of the application available, in electronic or other form, in each of the sub-offices of the Trade Marks Office.
- (3) If, before 1 January 2001, an application by:
  - (a) the Sydney Organising Committee for the Olympic Games constituted by the Sydney Organising Committee for the Olympic Games Act 1993 of New South Wales; or
  - (b) Sydney Paralympic Organising Committee Limited incorporated under the law of New South Wales;
 is accompanied by a written request by the applicant to postpone publication of the particulars of the application, the Registrar must publish the particulars of the application as soon as practicable after the expiration of 3 months after the date on which the application was filed.

#### **4.8 Examination of application — report to applicant**

- (1) For the purposes of section 31 of the Act (which deals with examination and reporting), if in the course of an examination of an application the Registrar reasonably believes that:
  - (a) the application has not been made in accordance with the Act or these regulations; or
  - (b) there are grounds under Division 2 of Part 4 of the Act for rejecting it; the Registrar must report that belief in writing to the applicant.
- (2) A report under subregulation (1) must include notice of the date on which the application will lapse if it is not accepted earlier.
- (3) If the Registrar reasonably suspects that the provisions of paragraph 27 (1) (b) of the Act do not apply in relation to all of the goods and/or services specified in an application for registration of a trade mark, the Registrar may require the applicant to make a declaration to the Registrar that those provisions apply to all of those goods and/or services.

*Note* Section 37 of the Act and regulation 4.12 deal with the lapsing of an application before acceptance.

#### **4.9 Examination — applicant's response to report**

- (1) An applicant may respond in writing to the Registrar's report under regulation 4.8.
- (2) The response may:
  - (a) contest a belief of the Registrar that is expressed in the report; and
  - (b) contest another matter that is mentioned in the report; and
  - (c) provide further documents or evidence in support of the application; and
  - (d) request that the application be amended in accordance with the Act.

*Note* Section 65 of the Act relates to the amendment of an application after particulars of the application have been published.

#### **4.10 Examination — further report to applicant**

- (1) On receipt of a response under regulation 4.9, the Registrar must consider the response.
- (2) If the Registrar continues to believe that:
  - (a) the application has not been made in accordance with the Act or these regulations; or
  - (b) there are grounds under Division 2 of Part 4 of the Act for rejecting it; the Registrar must report that belief in writing to the applicant.
- (3) Unless acceptance of an application is deferred, a report under subregulation (2) in relation to that application must include notice of the date on which the application will lapse if it is not accepted earlier.
- (4) Regulation 4.9 and this regulation apply to a report under subregulation (2) as if it were a report under regulation 4.8.

#### 4.11 Examination — additional requirements

- (1) In the course of an examination of an application for which a right of priority is claimed, the Registrar may require in writing the applicant to file:
  - (a) a copy of any earlier application certified in the trade marks office (or its equivalent) of the Convention country in which it was filed; and
  - (b) if the earlier application is not in English:
    - (i) a translation of the earlier application into English; and
    - (ii) a certificate of verification relating to the translation.
- (2) If the applicant is the successor in title to the person who made the earlier application, the Registrar may require in writing the applicant to file documentary evidence that is sufficient to establish the passing of title to the applicant.

#### 4.12 Periods after which applications lapse

- (1) For the purposes of subsection 37 (1) of the Act (which deals with lapsing), the prescribed period, for an application in respect of which a report is made under regulation 4.8, is:
  - (a) except as provided by paragraph (b) — 15 months from the date of that report (whether or not a further report is made under regulation 4.10); or
  - (b) if a further report raises grounds under Division 2 of Part 4 of the Act for rejecting the application that were not raised in the report made under regulation 4.8 — 15 months from the date of the further report.
- (2) In determining the period of 15 months for the purposes of paragraph (1) (a) or (b) in relation to an application, no account is to be taken of a period in which acceptance of the application is deferred under regulation 4.13.
- (3) An applicant may, before the end of a period prescribed in subregulation (1), or that period as extended under section 224 of the Act or as a result of a previous application of subregulation (4), request the Registrar in writing to extend the period.
- (4) The Registrar must, in accordance with a request made under subregulation (3), extend a period, unless:
  - (a) the period; or
  - (b) that period as extended under section 224 of the Act or as a result of a previous application of this subregulation;
 would be extended for more than 6 months after the end of the relevant period prescribed in subregulation (1).

*Note 1* If an extension of the time for acceptance of an application is sought after the end of a prescribed period, or of an extended period mentioned in subregulation 4.12 (3), application must be made under section 224 of the Act.

*Note 2* If a period prescribed in subregulation 4.12 (1) has been extended by 6 months, any application for a further extension of time must be made under section 224 of the Act.

#### 4.13 Deferment of acceptance

- (1) The Registrar may, at the request of the applicant in writing, defer acceptance of an application for registration of a trade mark, if:
  - (a) the request is made within a period prescribed in subregulation 4.12 (1); and
  - (b) the Registrar reasonably believes that there are grounds for rejecting the application under subsection 44 (1) or (2) of the Act because of another trade mark:
    - (i) that is registered by another person; or
    - (ii) in respect of which an application for registration has been made by another person; and
  - (c) the applicant:
    - (i) is awaiting the finalisation of proceedings in respect of the application for registration of the other trade mark; or
    - (ii) is seeking to satisfy the Registrar as to a matter mentioned in paragraph 44 (3) (a) or (b) of the Act or as to the matters mentioned in subsection 44 (4) of the Act in relation to the applicant's trade mark and the other trade mark; or
    - (iii) has filed an application under section 92 of the Act (which deals with the removal of trade marks) in respect of the other trade mark, and is awaiting the finalisation of proceedings in respect of that application; or
    - (iv) has begun proceedings to have the Register rectified in respect of the other trade mark and the proceedings have not been determined or otherwise disposed of; or
    - (v) is awaiting renewal of the registration of the other trade mark in the period of 12 months after registration of the other trade mark has expired, or removal of the other trade mark from the Register.
- (2) The Registrar may, on his or her own initiative, defer acceptance of the application within a period that is prescribed in subregulation 4.12 (1) or that is extended under section 224 of the Act or subregulation 4.12 (4), if:
  - (a) the time within which proceedings mentioned in paragraph (b) may be begun, or an application mentioned in paragraph (c) may be made, has not ended; or
  - (b) appeal proceedings under a provision of the Act have begun in a prescribed court in relation to the application; or
  - (c) an application has been made to the Administrative Appeals Tribunal for review of a decision of the Registrar in relation to the first-mentioned application; or
  - (d) the Registrar is informed in writing that the applicant has died.
- (3) The Registrar must defer acceptance of an application for registration of a certification trade mark when a copy of the rules governing the use of the certification trade mark is sent to the Commission in accordance with regulation 16.2.
- (4) The Registrar must notify an applicant in writing:
  - (a) if the applicant requests the Registrar to defer acceptance of an application — of the Registrar's decision to defer, or not to defer, acceptance of the application; and

- (b) if the Registrar otherwise defers acceptance of an application — of the provision under which acceptance of the application is deferred.

#### 4.14 Period for which acceptance is deferred

- (1) The period for which acceptance of an application is deferred (in this regulation called *the deferment period*) begins immediately after the date of the notice of deferment issued under subregulation 4.13 (4).
- (2) The deferment period ends:
  - (a) when the application is withdrawn; or
  - (b) if paragraph (a) does not apply — when the Registrar is reasonably satisfied that there are no longer grounds for rejecting the application under subsection 44 (1) or (2) of the Act; or
  - (c) if paragraphs (a) and (b) do not apply — in accordance with subregulation (3).
- (3) For the purposes of paragraph (2) (c), the deferment period ends:
  - (a) if acceptance is deferred because of subparagraph 4.13 (1) (c) (i) — when proceedings relating to the registration of the other trade mark are finalised; and
  - (b) if acceptance is deferred because of subparagraph 4.13 (1) (c) (ii) — at the end of 6 months from the date of the notice of deferment; and
  - (c) if acceptance is deferred because of subparagraph 4.13 (1) (c) (iii) — when proceedings under Part 9 of the Act in respect of the other trade mark are finalised; and
  - (d) if acceptance is deferred because of subparagraph 4.13 (1) (c) (iv) — when the proceedings to have the Register rectified in respect of the other trade mark are determined or otherwise disposed of; and
  - (e) if acceptance is deferred because of subparagraph 4.13 (1) (c) (v) — when the registration of the other trade mark is renewed or the other trade mark is removed from the Register; and
  - (f) if acceptance is deferred because of paragraph 4.13 (2) (a) — at the end of 2 months after the beginning of the period in which:
    - (i) proceedings mentioned in paragraph 4.13 (2) (b) may be begun; or
    - (ii) an application mentioned in paragraph 4.13 (2) (c) may be made; and
  - (g) if acceptance is deferred because of paragraph 4.13 (2) (b) or (c) — at the end of:
    - (i) 3 months after the determination, or other disposal, of the proceedings or review; or
    - (ii) such time as the court to which any appeal is brought or the Administrative Appeals Tribunal, or a court to which any appeal arising from review by the Tribunal is brought, allows;
  - (h) if acceptance is deferred because of paragraph 4.13 (2) (d) — at the end of a period after the death of the applicant that the Registrar reasonably regards as sufficient in the circumstances; and
  - (j) if acceptance is deferred because of subregulation 4.13 (3):

- (i) if the Commission gives a certificate under subsection 175 (2) of the Act in respect of the application — when the Registrar accepts the certification trade mark for registration; and
  - (ii) if the Commission does not give a certificate under that subsection — at the end of 2 months after the date of the notice to the Registrar under subsection 175 (4) of the Act.
- (4) If acceptance of an application is deferred as a result of the operation of more than 1 of the provisions of paragraph 4.13 (1) (c) and subregulation 4.13 (2), the deferment period ends in accordance with the relevant provision of subregulation (3) under which the deferment period ends later or last, as the case requires.
- (5) The Registrar must notify the applicant in writing of:
- (a) the end of a period of deferment; and
  - (b) if acceptance is deferred under subregulation 4.13 (1) — the last day of the relevant period prescribed by paragraph 4.12 (1) (a) or (b).

#### **4.15 Trade marks containing etc certain signs**

For the purposes of paragraph 39 (2) (a) of the Act (which deals with signs), the following signs are prescribed:

- (a) the words “Patent”, “Patented”, “By Royal Letters Patent”, “Registered”, “Registered Design”, “Copyright” “Plant Breeder’s Rights”, “EL rights”, or words or symbols to the same effect (including the symbols “©” and “®”);
- (b) the words “To counterfeit this is a forgery”, or words to the same effect;
- (c) a representation of the Arms, or of a flag or seal, of the Commonwealth or of a State or Territory;
- (d) a representation of the Arms or emblem of a city or town in Australia or of a public authority or public institution in Australia;
- (e) a representation of a mark notified by the International Union for the Protection of Industrial Property as not entitled to registration under international arrangements;
- (f) a sign specified in Schedule 2.

*Note 1* For the meaning of *EL rights*, see section 5 of the *Circuit Layouts Act 1989*.

*Note 2* A list of the marks mentioned in paragraph 4.15 (e) is available at the Trade Marks Office and sub-offices.

#### **4.16 Divisional applications relating to part of trade mark — period for application**

For the purposes of subsection 47 (2) of the Act (which deals with divisional applications), the period in relation to a divisional application for the registration of part of a trade mark is 6 months after filing the initial application for the registration of the trade mark.

#### **4.17 Divisional applications relating to excluded goods and/or services — prescribed periods**

For the purposes of subsections 49 (2) and (4) of the Act (which deal with divisional applications), the period in relation to a divisional application for the registration of the trade mark in respect of goods and/or services excluded from the initial



application is 1 month from the date of the notice of the amendment of the initial application for the registration of the trade mark given under regulation 6.4.

#### **4.18 Request for expedited examination of application**

- (1) A person who applies, or has applied, for the registration of a trade mark:
  - (a) may request in writing expedited examination of the application; and
  - (b) must include with the request a declaration stating the reasons for the request.
- (2) As soon as practicable after making a decision in relation to a request, the Registrar must give written notice of the decision to the person who made the request.

#### **4.19 Expedited examinations**

- (1) The Registrar must, to the extent that is practicable, examine applications for the registration of trade marks in relation to which requests under regulation 4.18 are granted:
  - (a) in the order in which the requests are filed; and
  - (b) before examination of an application for registration of a trade mark in relation to which:
    - (i) a request under regulation 4.18 is not made; or
    - (ii) a request made under that regulation is not granted.
- (2) In the absence of a request for expedited examination of an application for registration of a trade mark, the Registrar may expedite examination of the application if he or she reasonably believes that expedited examination is warranted.
- (3) The relationship of an application mentioned in subregulation (2) to another application for registration of a trade mark is a relevant circumstance for the purposes of that subregulation.

### **Part 5 Opposition to registration**

#### **5.1 Time for filing notice of opposition**

For the purposes of subsection 52 (2) of the Act (which deals with notice of opposition), the period for filing a notice of opposition is 3 months from the day on which the acceptance of the application is advertised in the *Official Journal*.

#### **5.2 Extension of time for filing — grounds**

- (1) A person may apply to the Registrar for an extension of time in which to file a notice of opposition.
- (2) An application for an extension of time may be made within the period for filing a notice of opposition referred to in regulation 5.1 on 1, or more than 1, of the following grounds and on no other ground:
  - (a) an error or omission by a trade marks officer;
  - (b) an error or omission by the person applying for the extension of time, or by the person's agent;

- (c) circumstances beyond the control of the person applying for the extension of time;
  - (d) the conduct of genuine negotiations between that person and the applicant for registration;
  - (e) the undertaking of genuine research to decide:
    - (i) whether opposition is justified; or
    - (ii) on the grounds of opposition.
- (3) If the period for filing a notice of opposition has ended, an application for extension of time may be made at any time before the trade mark is registered on 1, or more than 1, of the grounds set out in paragraph (2) (a), (b) or (c) and on no other ground.

### **5.3 Extension of time for filing — applications**

An application for an extension of time in which to file a notice of opposition must:

- (a) be in an approved form; and
- (b) be accompanied by a declaration stating:
  - (i) the facts on which the grounds specified in the application are based; and
  - (ii) if the period for filing a notice of opposition has ended — the reason why the application was not made before the end of that period.

*Note* Regulations 21.6 and 21.7 deal with making and filing declarations.

### **5.4 Extension of time for filing — grant of extension**

- (1) Subject to subregulations (2) and (4), if the Registrar is reasonably satisfied as to the grounds set out in an application for an extension of time to file a notice of opposition, the Registrar must grant the extension of time.
- (2) The Registrar must not grant the extension of time, unless the Registrar:
  - (a) is reasonably satisfied that the person applying for the extension of time has served a copy of the application, and the accompanying declaration, on the applicant for registration of the trade mark; and
  - (b) has given to both the person applying for the extension of time and the applicant for registration of the trade mark a reasonable opportunity to make representations concerning the application for extension of time.
- (3) For the purposes of paragraph (2) (b), the representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.
- (4) If an application for extension of time is made after the period for filing a notice of opposition has ended, the Registrar must not grant the extension unless the Registrar is reasonably satisfied that there is sufficient reason for the application not being made before the end of that period.
- (5) An extension of time must be for such period:

- (a) in the case of an extension of time that is granted on a ground set out in paragraphs 5.2 (2) (a), (b) and (c) — as the Registrar believes is reasonable; or
- (b) in the case of an extension of time that is granted on a ground set out in paragraphs 5.2 (2) (d) and (e) — not exceeding 3 months as the Registrar believes is reasonable.

### **5.5 Copy of earlier application to be available to opponent**

- (1) In opposition proceedings relating to an application in respect of which the applicant claims a right of priority, an opponent may in writing ask the Registrar for a copy of an earlier application to be made available.
- (2) On receipt of a request under subregulation (1), the Registrar must require in writing the applicant to file:
  - (a) a copy of the earlier application certified in the trade marks office (or its equivalent) of the Convention country in which it was filed; and
  - (b) if the earlier application is not in English:
    - (i) a translation of the earlier application into English; and
    - (ii) a certificate of verification relating to the translation.
- (3) If the applicant is the successor in title to the person who made the earlier application, the Registrar may require in writing the applicant to provide documentary evidence that is sufficient to establish the passing of title to the applicant.
- (4) Subregulation (2) does not apply if the applicant has already filed the documents mentioned in that subregulation.
- (5) The Registrar must send a copy of the documents mentioned in subregulation (2) to the opponent.

### **5.6 Opposition proceedings**

For the purposes of subsection 54 (2) of the Act (which deals with opposition proceedings), regulations 5.7 to 5.17 set out the procedure to be followed in dealing with an opposition after a notice of opposition is filed.

### **5.7 Evidence in support**

- (1) If the opponent intends to rely on evidence in support of the opposition, the opponent must serve a copy of the evidence in support on the applicant within 3 months from the day on which the notice of opposition is filed.
- (2) As soon as practicable after the opponent serves a copy of the evidence in support on the applicant, the opponent must file with the Registrar:
  - (a) the original evidence; and
  - (b) a statement setting out the date, place and manner of service of the copy of the evidence on the applicant.

### **5.8 Notice that opponent will not rely on evidence in support**

- (1) If the opponent does not intend to rely on evidence in support of the opposition, the opponent must, within 3 months from the day on which the notice of opposition is filed, serve on the applicant a copy of a notice stating that the opponent does not intend to rely on evidence in support of the opposition.
- (2) As soon as practicable after the opponent serves a copy of the notice on the applicant, the opponent must file with the Registrar:
  - (a) the original notice; and
  - (b) a statement setting out the date, place and manner of service of the copy of the notice on the applicant.

### **5.9 Evidence in answer**

- (1) If the applicant intends to rely on evidence in answer to the opposition, the applicant must serve a copy of the evidence in answer on the opponent within the period for service of a copy of that evidence under regulation 5.10.
- (2) As soon as practicable after the applicant serves a copy of the evidence in answer on the opponent, the applicant must file with the Registrar:
  - (a) the original evidence; and
  - (b) a statement setting out the date, place and manner of service of the copy of the evidence on the opponent.

### **5.10 Period for service of a copy of the evidence in answer**

- (1) If the opponent complies with regulation 5.7 or 5.8, the period for service of a copy of the evidence in answer to the opposition is 3 months from the day on which the opponent serves on the applicant:
  - (a) the copy of the evidence in support referred to in subregulation 5.7 (1); or
  - (b) the copy of the notice referred to in subregulation 5.8 (1).
- (2) If the opponent does not comply with regulation 5.7 or 5.8:
  - (a) the period for service of a copy of the evidence in answer to the opposition is the period of 3 months beginning on the day notified by the Registrar under paragraph (b); and
  - (b) the Registrar must, after the end of the period of 3 months referred to in subregulations 5.7 (1) and 5.8 (1), notify the parties in writing of the day on which the period for service of a copy of the evidence in answer to an opposition is to begin.

### **5.11 Notice that applicants will not rely on evidence in answer**

- (1) If an applicant does not intend to rely on evidence in answer to the opposition, the applicant must serve on the opponent, within the period for service of a copy of the evidence in answer, a copy of a notice stating that the applicant does not intend to rely on evidence in answer to the opposition.
- (2) As soon as practicable after the applicant serves a copy of the notice on the opponent, the applicant must file with the Registrar:

- (a) the original notice; and
- (b) a statement setting out the date, place and manner of service of the copy of the notice on the opponent.

#### **5.12 Evidence in reply to evidence in answer**

- (1) If an opponent intends to rely on evidence in reply to the evidence in answer to the opposition, the opponent must serve a copy of the evidence in reply on the applicant within 3 months after the service on the opponent of a copy of the evidence in answer.
- (2) As soon as practicable after the opponent serves a copy of the evidence in reply on the applicant, the opponent must file with the Registrar:
  - (a) the original evidence; and
  - (b) a statement setting out the date, place and manner of service of the copy of the evidence on the applicant.

#### **5.13 Notice that opponents will not rely on evidence in reply to evidence in answer**

- (1) If an opponent does not intend to rely on evidence in reply to the evidence in answer to the opposition, the opponent must serve on the applicant, within 3 months after the service on the opponent of a copy of the evidence in answer, a copy of a notice stating that the opponent does not intend to rely on evidence in reply to the evidence in answer to the opposition.
- (2) As soon as practicable after the opponent serves a copy of the notice on the applicant, the opponent must file with the Registrar:
  - (a) the original notice; and
  - (b) a statement setting out the date, place and manner of service of the copy of the notice on the applicant.

#### **5.14 Hearing of opposition**

- (1) An applicant may ask the Registrar to hear the parties to opposition proceedings, if:
  - (a) the opponent serves a copy of a notice under subregulation 5.8 (1); or
  - (b) at the end of the period for service of:
    - (i) a copy of the evidence in support under subregulation 5.7 (1); or
    - (ii) a copy of the notice under subregulation 5.8 (1);
 the opponent has not served a copy of the evidence in support or a copy of the notice.
- (2) A party to opposition proceedings may ask the Registrar to hear the parties to the opposition proceedings, if:
  - (a) the applicant serves a copy of a notice under subregulation 5.11 (1); or
  - (b) at the end of the period for service of:
    - (i) a copy of the evidence in answer under subregulation 5.9 (1); or
    - (ii) a copy of the notice under subregulation 5.11 (1);

the applicant has not served a copy of the evidence in answer or a copy of the notice; or

- (c) the opponent serves a copy of the evidence in reply under subregulation 5.12 (1) or a copy of a notice under subregulation 5.13 (1); or
- (d) at the end of the period for serving:

- (i) a copy of the evidence in reply under subregulation 5.12 (1); or
  - (ii) a copy of a notice under subregulation 5.13 (1);
- the opponent has not served a copy of the evidence in reply or a copy of the notice.

- (3) The Registrar must comply with a request made in accordance with subregulation (1) or (2).

- (4) If:

- (a) an applicant may make a request to the Registrar under subregulation (1); or
- (b) a party to opposition proceedings may make a request to the Registrar under subregulation (2);

and a request is not made, the Registrar may, on his or her own initiative, give an opportunity to the parties to the opposition proceedings to be heard in relation to those proceedings.

*Note* Regulations 21.15 and 21.16 deal with hearings.

### **5.15 Extension of period to serve evidence and service of further evidence**

- (1) A party to the opposition proceedings may apply to the Registrar:
  - (a) for an extension of the period for serving a copy of the evidence under regulation 5.7, 5.10 or 5.12; or
  - (b) for permission to serve a copy of further evidence on the other party.
- (2) The Registrar may grant an application on reasonable terms specified by the Registrar.
- (3) The Registrar must not grant an application unless the Registrar:
  - (a) is reasonably satisfied that the applicant has served a copy of the application, and of any documents accompanying the application, on the other party; and
  - (b) has given the parties a reasonable opportunity to make representations concerning the application; and
  - (c) is reasonably satisfied that:
    - (i) in the case of an application to which paragraph (1) (a) applies — the extension of the period for serving a copy of the evidence; and
    - (ii) in the case of an application to which paragraph (1) (b) applies — permission to serve a copy of further evidence;
 is appropriate.
- (4) For the purposes of paragraph (3) (b), the representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.

- (5) If the Registrar grants an application under paragraph (1) (b) on terms that include service of a copy of the further evidence within a specified period, a party to the opposition proceedings may apply to the Registrar for an extension of that period.
- (6) Subregulations (2), (3) and (4) apply to an application under subregulation (5).

#### **5.16 Conduct of opposition proceedings generally**

- (1) The Registrar may, at the request of a party to the opposition proceedings or on the initiative of the Registrar, give a direction in relation to the procedure in the proceedings.
- (2) A direction given under subregulation (1) must not be inconsistent with these regulations.
- (3) The Registrar must not give a direction unless the Registrar:
  - (a) is reasonably satisfied that parties to the proceedings have been notified of the proposed direction; and
  - (b) has given the parties a reasonable opportunity to make representations concerning the proposed direction; and
  - (c) is reasonably satisfied that the proposed direction is appropriate.
- (4) For the purposes of paragraph (3) (b), the representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.

#### **5.17 Registrar to give notice of dismissal of proceedings**

If opposition proceedings are dismissed under section 222 of the Act (which deals with security for costs) or discontinued, the Registrar must notify the parties in writing that the opposition proceedings have been dismissed or discontinued.

### **Part 6 Amendment of application for registration of a trade mark and other documents**

#### **6.1 Amendment of applications by Registrar**

- (1) For the purposes of subsection 63 (2) of the Act (which deals with amendment), if the Registrar proposes to amend an application for the registration of a trade mark, the Registrar must give notice in writing to the applicant:
  - (a) setting out the proposed amendment and the reason for making the amendment; and
  - (b) stating that the proposed amendment will be made at the end of a reasonable period stated in the notice, unless the applicant objects to the amendment within that period.
- (2) If an applicant objects to an amendment proposed by the Registrar within the period mentioned in paragraph (1) (b), the Registrar must not make the amendment unless the objection is withdrawn.

#### **6.2 Request to amend before publication of details**

For the purposes of paragraph 64 (b) of the Act (which deals with amendments before publication), the period for requesting an amendment is 14 days after filing the application for the registration of the trade mark.

### **6.3 Filing of declarations**

If a person requests an amendment under section 64 of the Act (which deals with amendments before publication) or paragraph 66 (a) of the Act (which deals with amendment of other documents), the Registrar may require the applicant to file a declaration stating:

- (a) that a clerical error or obvious mistake was made in the application; and
- (b) the circumstances in which the error or mistake was made.

*Note* Regulations 21.6 and 21.7 deal with making and filing declarations.

### **6.4 Notification of amendments**

If the Registrar amends an application, notice or document under Part 6 of the Act, the Registrar must give notice in writing of the amendment to:

- (a) the person who requested the amendment; and
- (b) any other person that the Registrar thinks appropriate.

## **Part 7 Registration of trade marks**

### **7.1 Period in which a trade mark can be registered**

- (1) For the purposes of subsection 68 (1) of the Act (which deals with registration), the period for the registration of a trade mark that has been accepted for registration is:
  - (a) except if paragraph (b) applies — the period from the beginning of the day on which the acceptance is advertised in the *Official Journal* to the end of:
    - (i) the day that is 6 months after that day; or
    - (ii) if a later day is specified under subregulation (2) or (3) — the day specified in that subregulation; and
  - (b) in the case of the death of an applicant for registration of the trade mark — within 12 months of the date of death or within such further period as the Registrar reasonably allows.
- (2) If:
  - (a) proceedings in relation to the registration of the trade mark before a prescribed court or the Administrative Appeals Tribunal are not determined or otherwise disposed of; and
  - (b) the prescribed court or the Tribunal is satisfied that the registration of the trade mark cannot take place on or before the first-mentioned day in subparagraph (1) (a) (i);
 the prescribed court or the Tribunal may specify for the purposes of subparagraph (1) (a) (ii) a day that is later than the first-mentioned day in subparagraph (1) (a) (i).



- (3) If:
- (a) proceedings in relation to the registration of the trade mark are before the Registrar; and
  - (b) the Registrar is reasonably satisfied that:
    - (i) the registration of the trade mark cannot take place on or before the first-mentioned day in subparagraph (1) (a) (i); and
    - (ii) it is appropriate to do so;
- the Registrar may specify, for the purposes of subparagraph (1) (a) (ii), a day that is later than the first-mentioned day in subparagraph (1) (a) (i).

## **7.2 Particulars to be entered in the Register**

For the purposes of paragraph 69 (2) (c) of the Act (which deals with particulars), the following other particulars of a trade mark must be entered in the Register:

- (a) if the trade mark is registered as a certification trade mark, a collective trade mark or a defensive trade mark — an indication to that effect;
- (b) the date of the registration;
- (c) the date on which the Registrar enters the particulars of the registration in the Register under subsection 69 (1) of the Act;
- (d) the particulars of any right of priority claimed under section 29 of the Act;
- (e) the filing date of the initial application on which any divisional application is based;
- (f) any number allocated to the initial application for registration of the trade mark;
- (g) the class numbers of the goods and/or services in respect of which the trade mark is registered;
- (h) the address of the owner of the trade mark;
- (i) any other particulars relating to the trade mark that the Registrar reasonably believes to be appropriate.

## **7.3 Period for request for renewal**

For the purposes of subsection 75 (1) of the Act (which deals with requests for renewal), the period within which a person may request the Registrar to renew the registration of a trade mark is 12 months ending on the day on which the registration of the trade mark expires.

#### **7.4 Notice of renewal due — when and how given**

- (1) For the purposes of section 76 of the Act (which deals with notice of renewal due), the period in relation to notifying a registered owner that renewal of the registration of a trade mark is due is 2 months ending on the day on which the registration of the trade mark expires.
- (2) A notice that the renewal is due must include:
  - (a) a statement of the date on which the registration of the trade mark will expire; and
  - (b) a statement of any fee payable.

#### **7.5 Notice of renewal**

For the purposes of subsection 77 (2) of the Act (which deals with renewal), a notice of the renewal of the registration of a trade mark must include:

- (a) a statement that the registration is renewed; and
- (b) the period for which it is renewed.

### **Part 8 Amendment and cancellation of registration**

#### **8.1 Notice of cancellation**

- (1) The Registrar must, after receiving a request from the owner of a registered trade mark under subsection 84 (1) of the Act, cancel registration of the trade mark if the Registrar is not obliged under subsection 84 (2) of the Act to notify a person.
- (2) If the Registrar must notify a person under that subsection, the notice must state that unless:
  - (a) the request from the owner is sooner withdrawn; or
  - (b) a prescribed court determines that the Registrar must not cancel registration of the trade mark;
 the Registrar will cancel the trade mark at the end of a period of 2 months from the date of the notice.
- (3) If:
  - (a) before the end of the period of 2 months, each person who is notified advises the Registrar in writing that the person does not object to cancellation of registration of the trade mark — the Registrar must cancel registration of the trade mark; or
  - (b) paragraph (a) does not apply — the Registrar must cancel registration of the trade mark after the end of that period;
 unless the request from the owner is withdrawn or a prescribed court determines otherwise.

#### **8.2 Amendment or cancellation — matters for the court**

For the purposes of paragraph 89 (2) (a) of the Act (which deals with amendment or cancellation by a prescribed court), a prescribed court, in making a decision under

subsection 89 (1) of the Act on an application for rectification of the Register, must take into account the following matters, so far as they are relevant:

- (a) the extent to which the public interest will be affected if registration of the trade mark is not cancelled;
- (b) whether any circumstances that gave rise to the application have ceased to exist;
- (c) the extent to which the trade mark distinguished the relevant goods and/or services before the circumstances giving rise to the application arose;
- (d) whether there is any order or other remedy, other than an order for rectification, that would be adequate in the circumstances.

## **Part 9 Removal of trade mark from register for non-use**

### **9.1 Applications for removal etc**

For the purposes of paragraph 92 (2) (a) of the Act (which deals with applications), an application for the removal of a trade mark from the Register:

- (a) must be in an approved form; and
- (b) must be accompanied by a declaration made by, or on behalf of, the applicant:
  - (i) stating that an inquiry into the use of the trade mark has been conducted by, or on behalf of, the applicant; and
  - (ii) setting out the findings of that inquiry that support the grounds referred to in subsection 92 (4) of the Act in reliance on which the application is made.

*Note* Regulations 21.6 and 21.7 deal with making and filing declarations.

### **9.2 Notification of applications**

- (1) For the purposes of subsection 95 (1) of the Act (which deals with notification), the Registrar must give notice of an application under section 92 of the Act within 1 month after the application is filed in accordance with these regulations.
- (2) The notice must be given by sending a copy of the application, and the accompanying declaration, to each person who, in the opinion of the Registrar, needs to know that the application has been filed.

### **9.3 Notice of opposition to removal**

- (1) For the purposes of subsection 96 (2) of the Act (which deals with notice of opposition), a notice of opposition to an application under section 92 of the Act must be filed with the Registrar within 3 months from the day on which the application is advertised in the *Official Journal*.
- (2) The opponent must serve a copy of the notice of opposition on the applicant as soon as practicable after the notice is filed.

*Note* For the requirement to notify the Registrar of service, see regulation 21.8.

### **9.4 Opposition proceedings before the Registrar**

- (1) For the purposes of section 99 of the Act (which deals with opposition proceedings), regulations 5.7 to 5.17 (inclusive) apply, subject to subregulations (2) and (3), to an opposition to an application under section 92 of the Act.
- (2) The Registrar must, if asked to do so by the opponent within the period for serving:
  - (a) a copy of the evidence in support under subregulation 5.7 (1); or
  - (b) a copy of the notice under subregulation 5.8 (1);
 hear the parties to the opposition proceedings.
- (3) If the opponent:
  - (a) does not serve a copy of the evidence in support in accordance with subregulation 5.7 (1); or
  - (b) serves a copy of a notice under subregulation 5.8 (1); or
  - (c) does not serve a copy of that notice within the time allowed in that subregulation;
 and the opponent does not request a hearing under subregulation (2), the opposition proceedings are taken to have ended, but are not taken to have been discontinued or dismissed.
 

*Note* Regulations 21.15 and 21.16 deal with hearings.
- (4) If:
  - (a) under subregulation (3) opposition proceedings are taken to have ended, but are not taken to have been discontinued or dismissed; and
  - (b) the Registrar is satisfied that the grounds on which the opposed application was made have been established;
 the Registrar must determine the application in accordance with section 101 of the Act.

## **Part 10 Assignment and transmission of trade marks**

### **10.1 Applications for assignment etc to be recorded or entered**

For the purposes of paragraphs 107 (2) (b) and 109 (2) (b) of the Act (which deal with assignment and transmission), the following documents are prescribed:

- (a) a document that establishes the title to a trade mark of the assignee, or of the person to whom the trade mark has been transmitted;
- (b) evidence in writing of consent of the Commission to the assignment or transmission of a registered certification trade mark.

### **10.2 Recording of assignment etc — trade marks not registered**

- (1) For the purposes of paragraph 108 (1) (a) of the Act (which deals with assignment and transmission), the Registrar must record particulars of the assignment or transmission of a trade mark in accordance with this regulation unless:
  - (a) the application to assign or transmit the trade mark is withdrawn; or
  - (b) a prescribed court determines otherwise.

- (2) If there is no record made under Part 11 of the Act of a person claiming an interest in, or a right in respect of, the trade mark, the Registrar must record the particulars after ascertaining that a claim has not been recorded.
- (3) If:
- (a) there is a record made under Part 11 of the Act of a person, or persons, claiming an interest in, or a right in respect of, the trade mark; and
  - (b) the Registrar has notified that person, or each of those persons, under subregulation 10.5 (1); and
  - (c) that person or each of those persons has, within the period of 2 months from the date of the notice mentioned in paragraph (b), given written notice to the Registrar consenting to the assignment or transmission;
- the Registrar must record the particulars after the Registrar has received the last notice consenting to the assignment or transmission.
- (4) If:
- (a) paragraphs (3) (a) and (b) apply; and
  - (b) the person, or any of the persons, notified by the Registrar under subregulation 10.5 (1) has not consented in writing to the assignment or transmission of the trade mark within the period of 2 months from the date of the notice;
- the Registrar must record the particulars as soon as practicable after the end of that period.

### **10.3 Particulars of recorded assignment or transmission to be published**

For the purposes of paragraph 108 (1) (b) of the Act (which deals with assignment and transmission):

- (a) the following particulars of an assignment or transmission of a trade mark for which registration is sought must be published:
  - (i) if a number has been allocated in the Trade Marks Office to the application for registration of the trade mark — the number;
  - (ii) the name of the person to whom the trade mark is recorded as having been assigned or transmitted;
  - (iii) the day on which the particulars of the assignment or transmission were recorded; and
- (b) if details of an application for registration of the trade mark have been published in a way described in subregulation 4.7 (2) — the particulars of the assignment or transmission mentioned in paragraph (a) must be published in the same way.

### **10.4 Recording of assignment etc of registered trade marks**

- (1) For the purposes of paragraph 110 (1) (a) of the Act (which deals with assignment and transmission), the Registrar must record particulars of the assignment or transmission of a trade mark in accordance with this regulation, unless:
- (a) the application to assign or transmit the trade mark is withdrawn; or
  - (b) a prescribed court determines otherwise.

- (2) If there is no record made under Part 11 of the Act of a person claiming an interest in, or a right in respect of, the trade mark, the Registrar must record the particulars in the Register after ascertaining that a claim has not been recorded.
- (3) If:
- (a) there is a record made under Part 11 of the Act of a person, or persons, claiming an interest in, or a right in respect of, the trade mark; and
  - (b) the Registrar has notified that person, or each of those persons, under subregulation 10.5 (1); and
  - (c) that person or each of those persons has, within the period of 2 months from the date of the notice mentioned in paragraph (b), given written notice to the Registrar consenting to the assignment or transmission;
- the Registrar must record the particulars in the Register after the Registrar has received the last notice consenting to the assignment or transmission.
- (4) If:
- (a) paragraphs (3) (a) and (b) apply; and
  - (b) the person, or any of the persons, notified by the Registrar under subregulation 10.5 (1) has not consented in writing to the assignment or transmission of the trade mark within the period of 2 months from the date of the notice;
- the Registrar must record the particulars in the Register as soon as practicable after the end of that period.

#### **10.5 Notice to persons recorded as claiming right or interest in trade marks**

- (1) For the purposes of section 111 of the Act, the Registrar must give notice in writing to a person recorded under Part 11 of the Act as claiming an interest in, or a right in respect of, a trade mark stating that the Registrar will record the assignment or transmission of the trade mark at the end of a period of 2 months from the date of the notice, unless:
- (a) the application to assign or transmit the trade mark is withdrawn; or
  - (b) a prescribed court determines otherwise; or
  - (c) each person to whom the Registrar must give notice under this subregulation has already notified the Registrar in writing that the person consents to the assignment or transmission.
- (2) Each notice under subregulation (1) in respect of a particular trade mark must be given on the same day.

### **Part 11 Voluntary recording of claims to interests in and rights in respect of trade marks**

#### **11.1 Amendment of particulars — claimed interests or rights**

- (1) For the purposes of sections 115 and 119 of the Act (which deal with amendment and cancellation of particulars), particulars of a claim to an interest in, or to a right in respect of, a trade mark (other than the name, address or address for service of a person whose claim is recorded) entered in the Register or recorded under Division 3 of Part 11 of the Act may be amended in accordance with this regulation.

- (2) A request to amend particulars of a claim to an interest in, or to a right in respect of, a trade mark must be made in writing:
- (a) together by the person whose claim is recorded and the owner of the trade mark; or
  - (b) if the request has with it the written consent to the amendment of 1 of the persons mentioned in paragraph (a) — by the other person mentioned in that paragraph.
- (3) If a request is made in accordance with subregulation (2), the Registrar must amend the particulars in accordance with the request.

## **11.2 Amendment of name, address and address for service — claims not in the Register**

If a person:

- (a) whose claim to an interest in, or to a right in respect of, a trade mark for which registration is sought is recorded; and
  - (b) whose name, address or address for service has changed since the claim was recorded;
- gives notice of the new name or address to the Registrar, the Registrar must amend the record accordingly.

*Note* In relation to change of a person's name, address or address for service that is recorded in the Register, see sections 215 and 216 of the Act and regulation 21.3.

## **11.3 Cancellation of particulars — claimed interests or rights**

- (1) For the purposes of sections 115 and 119 of the Act (which deal with amendment and cancellation of particulars), particulars of a claim to an interest in, or to a right in respect of, a trade mark, entered in the Register or recorded under Division 3 of Part 11 of the Act may be cancelled in accordance with this regulation.
- (2) A request to cancel particulars of a claim to an interest in, or to a right in respect of, a trade mark must be made in writing:
- (a) by the person whose claim is recorded; or
  - (b) by the owner of the trade mark; or
  - (c) together by the person whose claim is recorded and the owner of the trade mark; or
  - (d) if the request has with it the written consent to the cancellation of 1 of the persons mentioned in paragraph (c) — by the other person mentioned in that paragraph.
- (3) If a request is made under paragraph (2) (a), (c) or (d), the Registrar must cancel the particulars in accordance with the request.
- (4) If a request is made under paragraph (2) (b), the Registrar must notify in writing the person whose claim is recorded that:
- (a) the request has been made; and
  - (b) unless the request is withdrawn or a prescribed court orders otherwise, the Registrar will cancel particulars of the claim in accordance with the request

as soon as practicable after the end of a period of 2 months from the date of the notice.

- (5) Unless a request made under paragraph (2) (b) is withdrawn or a prescribed court determines otherwise, the Registrar must, as soon as practicable:
- (a) if, before the end of the period mentioned in paragraph (4) (b), a person the particulars of whose claim are recorded informs the Registrar in writing that the person does not object to cancellation of the particulars — cancel the particulars in accordance with the request; or
  - (b) if paragraph (a) does not apply — cancel the particulars after the end of that period in accordance with the request.

## **Part 13 Importation of goods infringing Australian trade marks**

### **13.1 Notice of objection to importation — accompanying documents**

For the purposes of subsection 132 (1) of the Act (which deals with notices of objection), the following documents are prescribed in relation to a notice given under that subsection, namely a copy of the particulars of registration of the registered trade mark that is:

- (a) certified by the Registrar as being a true copy; and
- (b) issued no more than 2 months before the date of the notice given under that subsection.

### **13.2 Notice of objection to importation — authorised users**

- (1) For the purposes of subsection 132 (3) of the Act (which deals with notices of objection), the period in relation to a request by an authorised user under subsection 132 (2) of the Act is 2 months from the day on which the request is made.
- (2) For the purposes of subsection 132 (3) of the Act, the following documents are prescribed, namely documents that establish that:
- (a) the authorised user has the power to give a notice of objection under subsection 132 (1) of the Act;
  - (b) the registered owner was asked to give the notice;
  - (c) since the request mentioned in paragraph (b) was made, the period prescribed by subregulation (1) in relation to the request has ended.

*Note 1* Examples of documents to which paragraph 13.2 (2) (a) refers include an agreement between the registered owner of a trade mark and the authorised user of the trade mark and a declaration of the registered owner that the authorised user of the trade mark is able to give notice of objection.

*Note 2* An authorised user must also give the documents prescribed by regulation 13.1 to the Comptroller.



### **13.3 Period for compliance with Comptroller's request for information etc**

For the purposes of subsection 143 (2) of the Act (which deals with giving information to the Comptroller), the period for complying with a request under subsection 143 (1) of the Act is 10 working days from the day on which the request is made.

### **13.4 Modification of the Act in its application to Norfolk Island**

Part 13 of the Act in its application to Norfolk Island is modified as set out in Schedule 3.

### **13.5 Modification of the Act in its application to Christmas Island**

Part 13 of the Act in its application to Christmas Island is modified as set out in Schedule 4.

### **13.6 Modification of the Act in its application to Cocos (Keeling) Islands**

Part 13 of the Act in its application to the Cocos (Keeling) Islands is modified as set out in Schedule 5.

## **Part 16 Certification trade marks**

### **16.1 Copy of rules to be filed**

For the purposes of subsection 173 (1) of the Act, (which deals with rules governing use) an applicant for registration of a certification trade mark must file a copy of the rules governing the use of the certification trade mark at, or as soon as practicable after, the time of filing of the application.

### **16.2 Documents sent to Commission with applications for registration**

For the purposes of subsection 174 (1) of the Act (which requires the Registrar to send documents), the following documents are prescribed:

- (a) a notification of any amendment made to the application for registration of a certification trade mark;
- (b) a copy of the rules governing the use of the certification trade mark;
- (c) any other document that is relevant to the application.

*Note* Under subsection 174 (1) of the Act, the Registrar must also send to the Commission a copy of the application for registration.

### **16.3 Initial assessment of applications by Commission**

- (1) For the purposes of subsection 175 (1) of the Act (which deals with consideration of applications), the Commission must make an initial assessment of an application and of any documents received under regulation 16.2 in relation to the application as soon as practicable after receipt.
- (2) As soon as practicable after the initial assessment, the Commission must:
  - (a) notify the applicant and the Registrar of the initial assessment; and
  - (b) state in the notice to the applicant that the initial assessment will be advertised in the *Official Journal*; and

- (c) state in the notice to the applicant that the applicant, or another person, may:
  - (i) respond in writing to the Commission; and
  - (ii) request the Commission in writing to hold a conference; in relation to the initial assessment not more than 1 month after the date of publication of the *Official Journal* in which the advertisement is published.
- (3) After receiving notice from the Commission, the Registrar must:
  - (a) advertise the initial assessment in the *Official Journal*; and
  - (b) include in the advertisement a statement mentioned in paragraph (2) (c).
- (4) If, in the period that ends 1 month after the date of the advertisement in the *Official Journal* of an initial assessment:
  - (a) a person responds in writing to the Commission in relation to a notice under subregulation (2) or an advertisement under subregulation (3); and
  - (b) no person requests the Commission in writing to hold a conference on a matter included in the initial assessment;
 

the Commission must, before making a decision on the application:
  - (c) give to the applicant and each respondent a copy of each response to which paragraph (a) refers that is received from another person; and
  - (d) invite the applicant and each respondent to make a written submission on each response mentioned in paragraph (c).

#### **16.4 Holding of conferences**

- (1) If, in the period that ends 1 month after the date of the advertisement in the *Official Journal* of an initial assessment:
  - (a) a person requests the Commission in writing to hold a conference on a matter included in the initial assessment; and
  - (b) no person otherwise responds in writing to the Commission in relation to a notice under subregulation 16.3 (2) or an advertisement under subregulation 16.3 (3);
 

the Commission must hold the conference before it makes a decision on the application.
- (2) As soon as practicable after the Commission receives a request under subregulation (1) for a conference, the Commission must:
  - (a) invite the applicant and any other person mentioned in subregulation (1):
    - (i) to attend the conference; and
    - (ii) to make an oral or written submission at the conference on the views expressed by another person that are mentioned in subparagraph (b) (ii); and
  - (b) give to the applicant and any other person mentioned in subregulation (1):
    - (i) reasonable notice of the time, date and place of the conference; and

- (ii) a reasonable opportunity to express views that are relevant to the conference, either orally at, or by written submission before or during, the conference; and
  - (iii) a copy of each written submission to which subparagraph (ii) refers that is made by another person.
- (3) If, in the period that ends 1 month after the date of the advertisement in the *Official Journal* of an initial assessment:
  - (a) a person requests the Commission in writing to hold a conference on a matter included in the initial assessment; and
  - (b) a person otherwise responds in writing to the Commission in relation to a notice under subregulation 16.3 (2) or an advertisement under subregulation 16.3 (3);
 the Commission must hold the conference before it makes a decision on the application.
- (4) As soon as practicable after the Commission receives a request under subregulation (3) for a conference, the Commission must:
  - (a) invite the applicant and any person who has responded in writing to the Commission:
    - (i) to attend the conference; and
    - (ii) to make an oral or written submission at the conference on the views expressed by another person that are mentioned in subparagraph (b) (ii); and
  - (b) give to the applicant and any person who has responded in writing to the Commission:
    - (i) reasonable notice in writing of the time, date and place of the conference; and
    - (ii) a reasonable opportunity to express views that are relevant to the conference, either orally at, or by written submission before or during, the conference; and
    - (iii) a copy of each response to which paragraph (3) (b) refers, and of each written submission to which subparagraph (ii) refers, that is made by another person.
- (5) If a person who is invited to attend a conference:
  - (a) informs the Commission that the person does not wish to attend the conference; or
  - (b) does not attend the conference;
 the conference may proceed in the absence of the person.

## **16.5 Consideration of applications**

- (1) In considering an application for registration of a certification trade mark for the purposes of making a decision under subsection 175 (2), (3) or (4) of the Act (which deal with consideration of applications), the Commission must have regard to the matters specified in subregulation (2).

- (2) The Commission must have regard to:
- (a) the initial assessment; and
  - (b) any response in relation to a notice under subregulation 16.3 (2) or an advertisement under subregulation 16.3 (3) that is relevant; and
  - (c) any relevant submission that is made to the Commission in writing about the initial assessment, whether or not the submission is made in relation to a conference; and
  - (d) any relevant oral submission made during a conference; and
  - (e) any other relevant matter.

#### **16.6 Criteria for Commission consideration of rules**

For the purposes of paragraph 175 (2) (b) of the Act (which deals with criteria for rules governing use), the Commission must have regard to the following criteria:

- (a) the principles relating to restrictive trade practices set out in Part IV of the *Trade Practices Act 1974*;
- (b) the principles relating to unconscionable conduct set out in Part IVA of that Act;
- (c) the principles relating to unfair practices, product safety and product information set out in Part V of that Act.

#### **16.7 Matters to be included in advertisement of adverse decision**

For the purposes of paragraph 175 (4) (b) of the Act (which deals with advertisement of a decision of the Commission not to give a certificate), the advertisement in the *Official Journal* must include a statement to the effect that, subject to the *Administrative Appeals Tribunal Act 1975*, application may be made to the Administrative Appeals Tribunal for the review of the decision to which the advertisement relates.

#### **16.8 Applications to vary rules**

- (1) For the purposes of subsection 178 (1) of the Act (which deals with the variation of rules), the registered owner of a certification trade mark may apply to the Commission to approve a variation of the rules governing the use of the certification trade mark.
- (2) An application to approve the variation of the rules governing the use of a registered certification trade mark must:
  - (a) be in writing; and
  - (b) have with it a copy of the rules governing the use of the registered certification trade mark that incorporate the proposed variation.

### 16.9 Consideration of applications to vary rules

- (1) The Commission must make an initial assessment of an application for approval of the variation of the rules governing the use of a registered certification trade mark as soon as practicable after it receives the application.
- (2) Subregulations 16.3 (2), (3) and (4) and regulation 16.4 apply to an application to approve the variation of the rules governing the use of a registered certification trade mark as if a reference in those provisions to an application for registration of a certification trade mark were a reference to an application to approve the variation of the rules governing the use of a registered certification trade mark.
- (3) Subregulation 16.5 (2) applies to a decision whether to approve an application for variation of the rules governing the use of a registered certification trade mark.

*Note* Subsection 178 (3) of the Act requires the Commission, in deciding whether to approve a variation, to have regard to prescribed criteria, which are the criteria set out in regulation 16.6.

### 16.10 Matters to be included in notices of variation

For the purposes of subsection 178 (4) of the Act (which deals with notice of its decisions by the Commission), the notice to be advertised in the *Official Journal* must include a statement to the effect that, subject to the *Administrative Appeals Tribunal Act 1975*, application may be made to the Administrative Appeals Tribunal for review of the decision to which the notice relates.

### 16.11 Assignment of registered certification trade marks

- (1) An application to the Commission for its consent to the assignment of a registered certification trade mark must:
  - (a) be made by the registered owner of the certification trade mark; and
  - (b) state the name, address, and address for service of the prospective assignee; and
  - (c) state whether the prospective assignee proposes to continue after assignment to apply the same rules governing use of the registered certification trade mark that the registered owner of the trade mark applies; and
  - (d) if the prospective assignee does not propose to continue to apply those rules:
    - (i) state any variation of the rules that the prospective assignee proposes to apply after assignment; and
    - (ii) have with it a copy of the rules incorporating the proposed variation that the prospective assignee proposes to apply after assignment.
- (2) In considering an application, the Commission must have regard to the following matters:
  - (a) whether the prospective assignee, or any prospective approved certifier within the meaning of paragraph 173 (2) (a) of the Act, is competent to certify the goods and/or services in respect of which the certification trade mark is registered;
  - (b) if the prospective assignee does not propose after the assignment to continue to apply the same rules governing use of the registered certification trade mark as the registered owner of the trade mark applies — whether, if the

application were an application to approve the variation of those rules that the prospective assignee proposes to vary after the assignment, the application would be approved by the Commission.

## **Part 17        Defensive trade marks**

### **17.1    Evidence in support of applications**

An applicant for registration of a defensive trade mark must file evidence in support of the application at, or as soon as practicable after, the time of filing of the application.

## **Part 19        Administration**

### **19.1    Trade Marks Office and sub-offices — business hours**

The hours of business of the Trade Marks Office and each sub-office of the Trade Marks Office are from 10 a.m. to 4 p.m. on each day other than:

- (a) a Saturday or a Sunday; or
- (b) a public holiday:
  - (i) where the Office or sub-office is located; or
  - (ii) for the purposes of the Australian Public Service in that place.

### **19.2    Persons to whom Registrar may delegate (Act, s 206 (1))**

For subsection 206 (1) of the Act, a person holding, or performing the duties of, an office in the Trade Marks Office stated in Schedule 6 is a person to whom the Registrar may delegate all or any of the Registrar's powers or functions under the Act.

## **Part 21        Miscellaneous**

### **Division 1    Applications and other documents**

#### **21.1    Compliance with instructions on approved forms**

If:

- (a) an application, notice or request under the Act or these regulations is required to be in an approved form; and
- (b) a blank form that may be used in making an application or request or giving notice:
  - (i) is supplied by the Registrar; and
  - (ii) contains directions about completing that form;
 the person who completes the form must comply with those directions.

### **21.2 Filing of documents — requirements as to form**

- (1) A document to be filed at the Trade Marks Office must comply with the requirements set out in Schedule 7.
- (2) If the document does not comply with the requirements in Schedule 7, the Registrar may return the document to the person from whom it was received with a statement setting out the requirements that have not been complied with.
- (3) A document may be filed by facsimile transmission:
  - (a) if no fee is payable on filing the document; or
  - (b) if a fee is payable on filing the document — if the document is accompanied by:
    - (i) documentary evidence that the fee has been paid; or
    - (ii) written authorisation of the payment.
- (4) If a document is filed by a person by facsimile transmission, the Registrar may require the person to file the original document from which the facsimile was transmitted.

### **21.3 Filing of documents — common requirements**

- (1) A person who files an application, notice or request must include in the application, notice or request the business or residential address of:
  - (a) the person making the application or request or giving the notice; or
  - (b) the person on whose behalf the application, notice or request is made.
- (2) If an address recorded in the Register or included in an application, notice or request that is filed changes, the person whose address changes, or a person acting on behalf of that person, must notify the Registrar of the new address.
- (3) If the Registrar is notified of a new address, the Registrar must amend the Register, application, notice or request accordingly.
- (4) An application, notice or request that is to be filed must be signed by, or on behalf of, the person making the application or request, or giving the notice, and dated by the signatory.

*Note* Section 212 of the Act also deals with the making and signing of applications, notices and requests.

### **21.4 Filing of documents — treatment of non-complying documents**

If a document received for filing at the Trade Marks Office fails to comply with the Act or these regulations, the Registrar may:

- (a) treat the document as not having been filed at the Trade Marks Office; or
- (b) treat the document as having been filed, but require the person who filed the document to make, or cause to be made, any alterations to the document that are necessary to enable the document to so comply.

*Note* Regulation 4.2 sets out requirements with which applications for the registration of trade marks must comply to be taken as having been filed.

### 21.5 Filing of documents — date of receipt to be marked

- (1) A document that is received for filing must be marked by the Registrar with the date on which it is received.
- (2) If the Trade Marks Office or a sub-office provides a facility for the receipt of documents (other than documents filed electronically or by facsimile transmission), when the Trade Marks Office or sub-office is not open to the public for business, a document received by means of that facility is taken to have been received on the day on which the Trade Marks Office or sub-office was last open to the public for business before the document was received.
- (3) Except as otherwise provided by the Act or these regulations, a document is taken to be filed at the Trade Marks Office on the date on which it is received by the Trade Marks Office.

### 21.6 Declarations

- (1) In this regulation:

*diplomatic or consular officer* means a person who holds any of the following offices of the Commonwealth in a country other than Australia:

- (a) ambassador;
- (b) high commissioner;
- (c) minister;
- (d) chargé d'affaires;
- (e) counsellor or second or third secretary at an embassy, high commission or other post;
- (f) consul-general;
- (g) consul;
- (h) vice-consul.

- (2) A declaration required by the Act or these regulations must:
  - (a) be headed with the title of the matter in respect of which the declaration is made; and
  - (b) be expressed in the first person; and
  - (c) state:
    - (i) the name and address of the declarant; and
    - (ii) if the declaration is made on behalf of another person — the name and address of the other person; and
  - (d) if the declaration is made for the purposes of a business the details of which are set out in the declaration — state:
    - (i) the office or position held by the person by whom the declaration is made; and
    - (ii) the address of the place where the business is conducted or principally conducted; and



- (e) be divided into paragraphs, each of which must be numbered consecutively and, as far as practicable, be confined to 1 subject.
- (3) A declaration may be made before:
- (a) a magistrate; or
  - (b) a justice of the peace; or
  - (c) a commissioner for affidavits; or
  - (d) a commissioner for declarations; or
  - (e) a notary public; or
  - (f) a patent attorney; or
  - (g) a person before whom a statutory declaration may be made under the *Statutory Declarations Act 1959* or the law of the State, Territory or foreign country where the declaration is made; or
  - (h) a diplomatic or consular officer.
- (4) The name and title of the person before whom the declaration is made and the date when, and the place where, it was made must be stated in the declaration.

#### **21.7 Declarations — additional material**

- (1) If:
- (a) a person is required by the Act or these regulations to file a declaration or serve a copy of the declaration; and
  - (b) it is not practicable to include in, or attach to, the declaration or copy any material to which the declaration refers;
- the person must file or serve the material to which the declaration refers, or a copy of the material, at the same time as the declaration or as soon as practicable after that time.
- (2) A declaration is not taken to have been filed or served until any material to which the declaration refers, or any copy of the material, is filed or served.

#### **21.8 Notification of service**

A person who is required by the Act or these regulations to serve a document on another person must, as soon as practicable after the document is served, notify the Registrar in writing of the date, place and manner of service.

#### **21.9 Notice of withdrawal of applications etc**

- (1) For the purposes of section 214 of the Act (which deals with withdrawal of applications, notices and requests):
- (a) a person who has filed an application, notice or request; or
  - (b) another person in whom the right or interest in reliance on which the application, notice or request was filed has become vested;
- may withdraw the application, notice or request by giving notice in writing of the withdrawal to the Registrar.
- (2) If:

- (a) the application, notice or request was filed by, or on behalf of, more than 1 person; or
  - (b) the right or interest mentioned in paragraph (1) (b) has become vested in more than 1 person;
- the notice of withdrawal must be signed by, or on behalf of, each of those persons.
- (3) If a person mentioned in paragraph (1) (b) withdraws an application, notice or request, the Registrar may require in writing that person to file documentary evidence that is sufficient to establish that the right or interest mentioned in that paragraph is vested in the person.

#### **21.10 Withdrawal of application etc — Registrar’s notice to applicants**

If an application, notice or request is withdrawn in accordance with regulation 21.9, the Registrar must notify in writing each person by, or on behalf of whom, the application, notice or request was filed of the withdrawal.

#### **21.11 Change of address for service — notice to interested persons**

A person:

- (a) who has filed an application, notice or request stating an address for service; and
  - (b) who notifies the Registrar of another address for service for the purposes of paragraph 215 (1) (b) of the Act (which deals with address for service);
- must give a copy of the notification to:
- (c) any party to proceedings relating to the application, notice or request; and
  - (d) to any other person as directed by the Registrar.

### **Division 2 Proceedings before the Registrar**

#### **21.12 Applications for costs**

- (1) For the purposes of section 221 of the Act (which deals with costs), a party to proceedings before the Registrar may apply to the Registrar, in an approved form, for an award of costs in relation to the proceedings.
- (2) An application must be made:
- (a) during the proceedings; or
  - (b) within 3 months from:
    - (i) the day on which the Registrar makes a decision in the proceedings that ends those proceedings; or
    - (ii) the date of the Registrar’s notice to the party that the proceedings have been discontinued or dismissed;
 as the case requires.
- (3) Before awarding costs in respect of the proceedings, the Registrar must give each party to the proceedings a reasonable opportunity to be heard in relation to the award of costs.
- (4) If a bill of costs is filed in relation to the proceedings, the bill of costs must be filed within 3 months from the day on which the costs are awarded.

**21.13 Determination of costs**

- (1) In this regulation, *costs* does not include the costs referred to in paragraph 105 (2) (b) of the Act.
- (2) For the purposes of section 221 of the Act (which deals with costs), costs may only be awarded in respect of a matter set out in Schedule 8.
- (3) The amount of costs must be taxed, allowed and certified by a trade marks officer appointed by the Registrar for that purpose, in accordance with:
  - (a) in the case of an item in Part 1 of Schedule 8 — the amount specified in that item; or
  - (b) in the case a matter set out in a clause in Part 2 of Schedule 8 — that clause.
- (4) The Registrar may review the taxation of costs by a trade marks officer.

**21.14 Conduct of proceedings generally**

- (1) The Registrar may, at the request of a party to proceedings before the Registrar, other than opposition proceedings, give directions in relation to the procedure in the proceedings.
- (2) Directions given under subregulation (1) must not be inconsistent with these regulations.
- (3) The Registrar must not give directions under subregulation (1) unless the Registrar:
  - (a) is reasonably satisfied that any person affected by the proposed directions has been notified of the proposed directions; and
  - (b) has given any person affected a reasonable opportunity to make representations concerning the proposed directions; and
  - (c) is reasonably satisfied that the proposed directions are appropriate.
- (4) For the purposes of paragraph (3) (b), representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.
- (5) Subject to these regulations, the Registrar may determine the procedure to be followed in proceedings before the Registrar.

*Note* Regulation 5.16 deals with directions as to procedure in opposition proceedings.

**21.15 Hearings by Registrar**

- (1) This regulation applies if the Act or these regulations provide for a person to be heard by the Registrar.
- (2) A request for a hearing by the Registrar must be in an approved form.
- (3) On request, or on his or her own initiative, the Registrar may:
  - (a) fix a time, date and place for the hearing; and
  - (b) give the parties to the hearing at least 10 days' notice in writing of the hearing and of the time, date and place fixed for the hearing.
- (4) A party must, as soon as practicable after being notified of a hearing, inform the Registrar in writing whether the party wants to be heard.
- (5) A party may attend a hearing in person or by such means as the Registrar reasonably allows.
- (6) A party may make representations in writing before or during a hearing.
- (7) A hearing must be conducted with as little formality and technicality, and with as much expedition, as the requirements of the Act and these regulations and a proper consideration of the matters before the Registrar, allow.
- (8) The Registrar is not bound by the rules of evidence but may inform himself or herself on any matter that is before him or her in any way that the Registrar reasonably believes to be appropriate.
- (9) The Registrar may adjourn a hearing by notifying each party to the hearing accordingly.
- (10) Subject to these regulations, the Registrar may give a direction that is reasonably necessary for the conduct of the hearing.

**21.16 Registrar not required to hold hearings**

- (1) The Registrar is not required to proceed to hear a matter if:
  - (a) the Registrar reasonably believes that no party wishes to be heard in the matter; or
  - (b) at least 1 of the following circumstances applies in relation to each party notified of the hearing under subregulation 21.15 (3):
    - (i) the party has not indicated to the Registrar that the party wishes to be heard; or
    - (ii) the party has informed the Registrar that the party does not wish to be heard; or
    - (iii) the party does not attend the hearing.
- (2) The Registrar may decide a matter to which subregulation (1) refers:
  - (a) without a hearing; and

- (b) by reference to relevant information about the matter that is held in the Trade Marks Office.

### **21.17 Evidence in proceedings**

- (1) Evidence that is given in writing in any proceedings before the Registrar must be in the form of a declaration.
- (2) The Registrar may require a person who has made a declaration that is filed in the proceedings to attend before the Registrar to give evidence orally on oath or affirmation instead of, or in addition to, the evidence contained in the declaration.
- (3) The Registrar may permit a party to cross-examine a person who attends under subregulation (2).

*Note* Regulations 21.6 and 21.7 deal with making and filing declarations.

### **21.18 Documents not in English**

If a document that is filed as evidence in proceedings before the Registrar is not in English, the party who files the document must file with it:

- (a) a translation of the document into English; and
- (b) a certificate of verification in relation to the translation.

### **21.19 Registrar may use information available**

- (1) If:
  - (a) information that is available to the Registrar is relevant to proceedings before the Registrar; and
  - (b) the Registrar has reason to believe that the information is not known to a party to the proceedings; and
  - (c) the Registrar proposes to take the information into account in making a decision in the proceedings;
 before making the decision the Registrar must:
  - (d) provide the information to the party; and
  - (e) give the party a reasonable opportunity to make representations about the information.
- (2) For the purposes of paragraph (1) (e), the representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.

### **21.20 Statements of reasons for decision**

If:

- (a) the Registrar notifies a party to proceedings before the Registrar of a decision of the Registrar in the proceedings; and
- (b) the party requests the Registrar in writing for the reasons for the decision; the Registrar must comply with the request.

### **Division 3      General**

#### **21.21    What fees are payable**

- (1) For subsection 223 (1) of the Act (which deals with fees), the fees specified in column 3 of an item in Schedule 9 are payable in respect of a matter specified in column 2 of that item.
- (2) If a person asks the Registrar, under subsection 75 (1) of the Act, to renew the registration of a trade mark before it expires, the fee payable for the renewal is the fee that would be payable if the person had asked for renewal of the registration on the day when it would otherwise expire.
- (3) Subregulation (4) applies if a person asks the Registrar, under section 79 of the Act, to renew the registration of a trade mark after it expires.
- (4) The fees payable for the renewal are:
  - (a) the fee that would have been payable if the person had asked for renewal of the registration on the day when it expired; and
  - (b) the additional fee stated in item 9 of Schedule 9 for the period:
    - (i) beginning on the day after the day when the registration expires; and
    - (ii) ending on the day when the request for renewal is filed.

#### **21.22    How fees are to be paid**

- (1) For the purposes of subsection 223 (2) of the Act (which deals with payment of fees), a fee, other than a fee payable under Part 13 of the Act, must be paid to the Registrar at the Trade Marks Office or at a sub-office of the Trade Marks Office.
- (2) A fee payable under Part 13 of the Act must be paid to the Comptroller.
- (3) A fee must be paid in accordance with a direction given:
  - (a) in the case of a fee that is paid to the Registrar — by the Registrar; and
  - (b) in the case of a fee that is paid to the Comptroller — by the Comptroller; as to the way in which it is to be paid.

#### **21.23    Notice of non-payment of fee**

For the purposes of subsection 223 (5) of the Act (which deals with non-payment of fees), the Registrar or the Comptroller must notify in writing the person concerned, or his or her agent, that the fee has not been paid, within 14 days after the doing of the act, or the filing of the document, for which the fee is payable.

#### **21.24    Refunds etc of fees**

- (1) If, because of an error or omission by a trade marks officer, a person becomes liable to pay a fee for which the person would not otherwise have been liable, the Registrar may:
  - (a) remit the whole or part of the fee; or
  - (b) if the fee has been paid — refund the whole or part of the fee to that person.

- (2) If:
- (a) the acceptance of an application for registration of a trade mark; or
  - (b) the registration of a trade mark;
- is delayed because of an error or omission by a trade marks officer, the period that the Registrar reasonably believes to be equal to the period of the delay resulting from the error or omission is not to be taken into account for the purposes of calculating the amount of the fee for the matter in relation to which the error or omission was made.

#### **21.25 Extension of time — application**

For the purposes of subsections 224 (2) and (3) of the Act (which deal with extensions of time), an application for an extension of time for doing a relevant act:

- (a) must be in an approved form; and
- (b) must be accompanied by a declaration stating:
  - (i) the facts on which the grounds specified in the application are based; and
  - (ii) if the period for doing the relevant act has ended — the reason why the application was not made before the period ended.

*Note* Regulations 21.6 and 21.7 deal with making and filing declarations.

#### **21.26 Extension of time — notice of opposition**

- (1) For the purposes of subsection 224 (6) of the Act (which deals with opposition to an extension), a person may oppose an application for an extension of time for more than 3 months by filing a notice of opposition with the Registrar.
- (2) A notice of opposition:
  - (a) must be in an approved form; and
  - (b) must be filed within 1 month after the application for an extension of time is advertised in the *Official Journal*.
- (3) The opponent must serve a copy of the notice on the applicant.

#### **21.27 Extension of time — opposition proceedings**

For the purposes of subsection 224 (6) of the Act (which deals with opposition to an extension), regulations 5.7 to 5.17 (inclusive) apply to an opposition to an application for an extension of time.

#### **21.28 Extension of time — prescribed acts and documents**

- (1) For the purposes of paragraph (a) of the definition of *relevant act* in subsection 224 (8) of the Act, the following acts are prescribed:
  - (a) complying with the requirements of subregulation 4.2 (1);
  - (b) claiming a right of priority for an application for the registration of a trade mark under subsection 29 (1) of the Act;

- (c) making a divisional application for the registration of a part of a trade mark under subsection 47 (2) of the Act;
  - (d) making a divisional application for the registration of a trade mark under subsection 49 (2) of the Act;
  - (e) making a divisional application for the registration of a trade mark under subsection 49 (4) of the Act;
  - (f) serving a copy of the evidence under regulation 5.7, 5.9 or 5.12;
  - (g) serving a copy of a notice under regulation 5.8, 5.11 or 5.13;
  - (h) serving a copy of further evidence under regulation 5.15;
  - (i) responding to a notice to which subregulation 8.1 (2) applies;
  - (j) requesting that an application for the registration of a trade mark be amended under paragraph 64 (b) of the Act;
  - (k) requesting renewal of the registration of a trade mark under section 79 of the Act;
  - (l) responding to a notice to which subregulation 10.5 (1) applies;
  - (m) responding to a notification of the Registrar under subregulation 11.3 (4);
  - (n) complying with the authorised user's request referred to in regulation 13.2;
  - (o) complying with a request for information referred to in regulation 13.3;
  - (p) responding to a notice under subregulation 16.3 (2);
  - (q) responding to an advertisement under subregulation 16.3 (3);
  - (r) making a claim for priority under section 29 of the Act for an application for the registration of a trade mark in the circumstances mentioned in section 244 of the Act.
- (2) For the purposes of paragraph (b) of the definition of *relevant act* in subsection 224 (8) of the Act, the following documents are prescribed:
- (a) a notice of opposition to the registration of a trade mark under section 52 of the Act;
  - (b) a notice of opposition to which subregulation 21.26 (1) applies.

### 21.29 Convention countries

- (1) For the purposes of section 225 of the Act (which deals with Convention countries), each of the countries specified in Schedule 10 is a Convention country for the purposes of the Act.
- (2) For the purposes of subsection 225 (2) of the Act, an application for the registration of a trade mark, being an application that is made under the treaty done at Bangui in the Central African Republic on 2 March 1977 entitled the *Agreement Relating to the Creation of an African Intellectual Property Organisation, Constituting a Revision of the Agreement Relating to the Creation of an African and Malagasy Office of Industrial Property* (a treaty subsisting between 2 or more Convention countries), is, in accordance with the terms of that treaty, declared to be equivalent to an application made in each of those Convention countries.
- (3) For the purposes of subsection 225 (2) of the Act, an application for the registration of a trade mark, being an application that is made under the *Benelux Convention Concerning Trademarks* done at Brussels on 19 March 1962 (being a treaty subsisting between 2 or more Convention countries), is, in accordance with the terms of that treaty, declared to be equivalent to an application made in each Convention country that is a High Contracting party within the meaning of that treaty.

### 21.30 Rights of patent attorneys



A patent attorney has, in relation to the documents and property of a client, the same right of lien that a solicitor has in relation to the documents and property of a client.

### **21.31 Incapacity of certain persons**

- (1) If a person is incapable of doing anything required or permitted by the Act or these regulations to be done because of infancy or physical or mental disability, a court may, on the application of a person acting on behalf of the incapable person or of another person interested in the thing being done:
  - (a) do the thing; or
  - (b) appoint a person to do the thing; in the name, and on behalf, of the incapable person.
- (2) A thing done in the name of, and on behalf of, an incapable person is taken to have been done by that person as if the person had not been incapable when the thing was done.

### **21.32 Destruction of documents**

- (1) The Registrar may order the destruction of documents relating to trade marks the registration of which ceased not less than 25 years before the date of the order.
- (2) Subregulation (1) does not authorise the destruction of:
  - (a) the Register; or
  - (b) documents that are considered by the Registrar or the Director-General of the Australian Archives to be of legal or historical interest.

### **21.33 Directions not otherwise prescribed**

If the Registrar reasonably believes that it is necessary for the proper conduct of proceedings for a person to perform an act, file a document or produce evidence that the person is not required by the Act or these regulations to perform, file or produce, the Registrar may give notice in writing to the person requiring him or her:

- (a) to perform the act; or
  - (b) file the document; or
  - (c) to produce the evidence;
- that is specified in the notice.

### **21.34 Requirements cannot be complied with for reasonable cause**

If:

- (a) under these regulations, a person is required to do an act or thing, sign a document, make a declaration or file or give to the Registrar a document or evidence; and
  - (b) the Registrar is reasonably satisfied that the person cannot comply with the requirement;
- subject to any condition that the Registrar may reasonably impose, the Registrar may dispense with the requirement.

## **Part 22 Transitional provisions**

## 22.1 Application of the Act

- (1) If:
  - (a) an application for the registration of a trade mark is lodged under the *Trade Marks Act 1955*; and
  - (b) the Registrar has issued a report on the application under the *Trade Marks Act 1955*; and
  - (c) immediately before the commencement of these regulations, the application is pending and has not been accepted;
 the report is taken to have been issued by the Registrar under the Act on the date on which it was issued under the *Trade Marks Act 1955*.
  
- (2) If:
  - (a) an application under the *Trade Marks Act 1955* for the registration of a trade mark is amended under the *Trade Marks Act 1955*; and
  - (b) immediately before the commencement of these regulations, the application is pending and has not been accepted;
 the amendment is taken to have been made under the Act on the date on which it was made under the *Trade Marks Act 1955*.
  
- (3) If the particulars of an application for the registration of a trade mark have been published before the commencement of these regulations:
  - (a) in the *Official Journal*; or
  - (b) by listing in a computer database maintained by the Trade Marks Office; or
  - (c) by making a record of the application available, in electronic or other form, in each of the sub-offices of the Trade Marks Office;
 then, for the purposes of subsection 45 (2), paragraph 64 (a), subsection 65 (1) and paragraph 83 (1) (a) of the Act, those particulars are taken to have been published under section 30 of the Act.

## 22.2 Fees payable in relation to certain matters

- (1) Subject to subregulation (2), a fee payable in relation to proceedings:
  - (a) relating to an application for the registration of a trade mark of a kind mentioned in subsection 241 (2) of the Act (which deals with pending applications for registration of trade marks); or
  - (b) of a kind mentioned to which section 251 of the Act (which deals with action for removal of trade marks from the Register for non-use) applies;
 is the fee that would have been payable if these regulations had applied to the proceedings.
  
- (2) The fee payable for the registration of a trade mark of a kind mentioned in subsection 241 (2) of the Act is the fee that was payable under regulations made under the *Trade Marks Act 1955*, being the regulations as in force when the application was accepted.
  
- (5) If:
  - (a) under the repealed Act the registration of a trade mark expires in 1995; and

- (b) a request is made to renew the registration of the trade mark within the period of 12 months following the expiry;  
the fee payable in relation to the request is the fee that would have been payable for lodgment of an application for restoration of the trade mark under subsection 71 (1) of the repealed Act.

### **22.3 Certain delegations continue**

If, immediately before the commencement of these regulations, a person:

- (a) was a delegate of the Registrar of Trade Marks under the repealed Act; and
- (b) was exercising the powers of the Registrar in relation to a matter to which, under Division 3 of Part 22 of the Act, the repealed Act continues to apply;  
the delegation of that person continues in relation to the matter.

### **22.4 Certain deferments continue**

(1) If:

- (a) the Registrar has deferred acceptance of an application for registration of a trade mark under subsection 33 (3) of the *Trade Marks Act 1955*; and
- (b) the deferment was in force immediately before the commencement of these regulations;  
the deferment is in force under subregulation 4.13 (1) after the commencement of these regulations as if the Registrar had deferred acceptance of the application on the day on which it was deferred under the *Trade Marks Act 1955*.

(2) Subject to paragraph 4.14 (2) (a), the deferment period for an application referred to in subregulation (1) ends:

- (a) when the Registrar is reasonably satisfied that there are no longer grounds for rejecting the application under subsection 44 (1) or (2) of the Act because of another trade mark in respect of which an application for registration has been made by another person; or
- (b) if the period does not end in accordance with paragraph (a) — when proceedings in respect of the application for registration of the other trade mark are finalised.

(3) If acceptance of the application is deferred as a result of the operation of more than 1 provision of these regulations, the deferment period ends in accordance with whichever of the provisions of:

- (a) paragraph (2) (b); and
- (b) subregulation 4.14 (3), other than paragraph 4.14 (3) (a);  
under which the deferment period ends later or last, as the case requires.

### **22.5 Certain extensions of time continue**

If:

- (a) the Registrar has extended a period of time under section 130 or 131 of the *Trade Marks Act 1955*; and
- (b) the extended period of time had not ended before the commencement of these regulations;  
the period ends when it would have ended if that section had continued to be in force.

## 22.6 Deferment of acceptance — certain applications

If:

- (a) an applicant requests the Registrar to defer acceptance of an application for registration of a trade mark because of another trade mark that is registered by another person; and
- (b) the applicant has lodged an application under section 23 of the *Trade Marks Act 1955* in respect of the other trade mark;

then:

- (c) regulation 4.13 applies in relation to the first-mentioned application as if the reference in subparagraph 4.13 (1) (c) (iii) to an application under section 92 were a reference to an application under section 23 of the *Trade Marks Act 1955*; and
- (d) regulation 4.14 applies in relation to that application as if the reference in paragraph 4.14 (3) (c) to Part 9 of the *Trade Marks Act 1995* were a reference to section 23 of the *Trade Marks Act 1955*.

## Schedule 1                      Classification of goods and services

(regulation 3.1)

### Part 1                                      Classes of goods

<b>Column 1</b> <b>Item number</b> <b>(Class number)</b>	<b>Column 2</b> <b>Class of goods</b> <b>(Class heading)</b>
1	Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry
2	Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colourants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists
3	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices
4	Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks
5	Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides
6	Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores
7	Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements, other than hand operated; incubators for eggs
8	Hand tools and implements (hand operated); cutlery; side arms; razors
9	Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus
10	Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials
11	Apparatus for lighting, heating, steam generating, cooking, refrigerating,

<b>Column 1 Item number (Class number)</b>	<b>Column 2 Class of goods (Class heading)</b>
	drying, ventilating, water supply and sanitary purposes
12	Vehicles; apparatus for locomotion by land, air or water
13	Firearms, ammunition and projectiles; explosives; fireworks
14	Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments
15	Musical instruments
16	Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks
17	Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal
18	Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery
19	Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal
20	Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics
21	Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes
22	Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials
23	Yarns and threads, for textile use
24	Textiles and textile goods, not included in other classes; bed and table covers
25	Clothing, footwear, headgear
26	Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers
27	Carpets, rugs, mats and matting, linoleum and other materials for covering

<b>Column 1</b> <b>Item number</b> <b>(Class number)</b>	<b>Column 2</b> <b>Class of goods</b> <b>(Class heading)</b>
	existing floors; wall hangings (non-textile)
28	Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees
29	Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats
30	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice
31	Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt
32	Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages
33	Alcoholic beverages (except beers)
34	Tobacco; smokers' articles; matches

**Part 2****Classes of services**

<b>Column 1</b> <b>Item number</b> <b>(Class number)</b>	<b>Column 2</b> <b>Class of services</b> <b>(Class heading)</b>
35	Advertising; business management; business administration; office functions
36	Insurance; financial affairs; monetary affairs; real estate affairs
37	Building construction; repair; installation services
38	Telecommunications
39	Transport; packaging and storage of goods; travel arrangement
40	Treatment of materials
41	Education; providing of training; entertainment, sporting and cultural activities
42	Providing of food and drink; temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services; legal services; scientific and industrial research; computer programming; services that cannot be placed in other classes.

## Schedule 2 Signs that may not be registered as trade marks

(paragraph 4.15 (f))

Austrade

C.E.S.

Olympic Champion

Repatriation

Returned Airman

Returned Sailor

Returned Soldier

## Schedule 3 Modifications of Part 13 of the Act — Norfolk Island

(regulation 13.4)

### Part 1 Classification of goods and services

#### 1 Section 131 (Object of Part)

1.1 Omit “Comptroller”, substitute “Collector”.

1.2 Omit “Australia”, substitute “Norfolk Island”.

#### 2 New section 131A

2.1 After section 131, insert:

#### 131A Definitions

“In this Part, unless the contrary intention appears:

*Administration* and *Administrator* have the same meanings as in the *Norfolk Island Act 1979*;

*Collector* means the Collector of Customs appointed under section 1B of the Customs Ordinance 1913;

*designated owner*, in relation to goods imported into Norfolk Island, means the person identified as the owner of the goods on the entry made in relation to the goods under section 4A of the Customs Ordinance 1913.”.

#### 3 Section 133 (Collector may seize goods infringing trade mark)

3.1 Paragraph 133 (1) (a):  
Omit “Australia”, substitute “Norfolk Island”.



- 3.2 Paragraph 133 (1) (b):  
Omit “Customs Act 1901”, substitute “Customs Ordinance 1913”.
- 3.3 Subsection 133 (2):  
Omit “Comptroller” (wherever occurring), substitute “Collector”.
- 3.4 Subsection 133 (3):  
Omit “Comptroller” and “Commonwealth” (wherever occurring), substitute “Collector” and “Administration”.
- 3.5 Subsection 133 (4):  
Omit “Comptroller”, substitute “Collector”.

**4 Section 139 (Forfeited goods — how to be disposed of)**

- 4.1 Omit “as the Comptroller directs”, substitute “by the Collector in accordance with any direction of the Minister who administers the Customs Ordinance 1913”.

**5 Section 140 (Power of Collector to retain control of goods)**

- 5.1 Omit “Comptroller” (wherever occurring), substitute “Collector”.
- 5.2 Omit “law of the Commonwealth”, substitute “law in force in Norfolk Island”.

**6 Section 141 (Insufficient security)**

- 6.1 Omit “Commonwealth” (wherever occurring), substitute “Administration”.
- 6.2 Omit “Comptroller”, substitute “Collector”.

**7 Section 142 (Administration not liable for loss etc suffered because of seizure)**

- 7.1 Omit “Commonwealth”, substitute “Administration”.
- 7.3 Paragraph 142 (a):  
Omit “Comptroller”, substitute “Collector”.

**8 Section 143 (Power to require information)**

- 8.1 Omit “Australia” (wherever occurring), substitute “Norfolk Island”.
- 8.2 Omit “Comptroller” (wherever occurring), substitute “Collector”.

**Part 2**

The following provisions of Part 13 of the Act are modified by omitting “Comptroller” (wherever occurring) and substituting “Collector”:

Subsections 132 (1), (3), (4) and (5), section 134, subsection 135 (1) and sections 136 and 137.

**Schedule 4 Modifications of Part 13 of the Act — Christmas Island**

(regulation 13.5)

**1 Section 131 (Object of Part)**

1.1 Omit “Australia”, substitute “Christmas Island”.

**2 New section 131A**

2.1 After section 131, insert:

**131A Definitions**

“In this Part, unless the contrary intention appears:

*Comptroller* means the Comptroller of the Indian Ocean Territories Customs Service.

*designated owner*, in relation to goods imported into Christmas Island, means the person identified as the owner of the goods on the entry made in relation to the goods under section 68 of the *Customs Act 1901* (C.I.).”

**3 Section 133 (Comptroller may seize goods infringing trade mark)**

3.1 Paragraph 133 (1) (a):  
Omit “Australia”, substitute “Christmas Island”.

3.2 Paragraph 133 (1) (b):  
Omit “*Customs Act 1901*”, substitute “*Customs Act 1901* (C.I.)”.

3.3 Subsection 133 (3):  
Omit “Commonwealth” (wherever occurring), substitute “Territory of Christmas Island”.

**4 Section 140 (Power of Comptroller to retain control of goods)**

4.1 Omit “law of the Commonwealth”, substitute “law in force in Christmas Island”.

**5 Section 141 (Insufficient security)**

5.1 Omit “Commonwealth” (wherever occurring), substitute “Territory of Christmas Island”.

**6 Section 142 (Territory of Christmas Island not liable for loss etc suffered because of seizure)**

6.1 Omit “Commonwealth”, substitute “Territory of Christmas Island”.

**7 Section 143 (Power to require information)**

7.1 Omit “Australia” (wherever occurring), substitute “Christmas Island”.

## Schedule 5 Modifications of Part 13 of the Act — Cocos (Keeling) Islands

(regulation 13.6)

### 1 Section 131 (Object of Part)

1.1 Omit “Australia”, substitute “the Cocos (Keeling) Islands”.

### 2 New section 131A

2.1 After section 131, insert:

#### 131A Definitions

“In this Part, unless the contrary intention appears:

*Comptroller* means the Comptroller of the Indian Ocean Territories Customs Service.

*designated owner*, in relation to goods imported into the Cocos (Keeling) Islands, means the person identified as the owner of the goods on the entry made in relation to the goods under section 68 of the *Customs Act 1901* (C.K.I.).”

### 3 Section 133 (Comptroller may seize goods infringing trade mark)

3.1 Paragraph 133 (1) (a):

Omit “Australia”, substitute “the Cocos (Keeling) Islands”.

3.2 Paragraph 133 (1) (b):

Omit “*Customs Act 1901*”, substitute “*Customs Act 1901* (C.K.I.)”.

3.3 Subsection 133 (3):

Omit “Commonwealth” (wherever occurring), substitute “Territory of Cocos (Keeling) Islands”.

### 4 Section 140 (Power of Comptroller to retain control of goods)

4.1 Omit “law of the Commonwealth”, substitute “law in force in the Cocos (Keeling) Islands”.

### 5 Section 141 (Insufficient security)

5.1 Omit “Commonwealth” (wherever occurring), substitute “Territory of Cocos (Keeling) Islands”.

### 6 Section 142 (Territory of Cocos (Keeling) Islands not liable for loss etc suffered because of seizure)

6.1 Omit “Commonwealth”, substitute “Territory of Cocos (Keeling) Islands”.

### 7 Section 143 (Power to require information)

7.1 Omit “Australia” (wherever occurring), substitute “the Cocos (Keeling) Islands”.

## **Schedule 6 Offices of persons to whom registrar may delegate**

(regulation 19.2)

Executive level 2  
 Executive level 1  
 Executive level 1 — Examiner of Trade Marks  
 APS level 6 — Examiner of Trade Marks  
 APS level 5 — Examiner of Trade Marks  
 APS level 4 — Examiner of Trade Marks  
 APS level 3 — Examiner of Trade Marks  
 APS level 6  
 APS level 5  
 APS level 4  
 APS level 3  
 APS level 2  
 APS level 1

## **Schedule 7 Requirements for documents in paper form**

(regulation 21.2)

1. Documents, except documents mentioned in regulations 4.11, 5.5 and 22.18, must be written in English.
2. Documents (excluding documents that are to be filed by facsimile transmission) must be written on tough white paper of good quality, preferably international A4 size (297 millimetres by 210 millimetres).
3. The contents of a document must be written on one side only of the paper in a carbonaceous or other permanent ink on which bleaching agents do not have any effect.
4. The contents of a document must be legible and if the document is printed, the type must not be less than pica (12 point).
5. The signature of the person signing a document and the date of signature must be placed on the last sheet of the document.
6. The name of a person signing a document must be legibly written under or beside the signature of that person.
7. An alteration made in a document before it is filed at the Trade Marks Office must be initialled in the margin of the document opposite to the alteration by the person who signs the document.

## Schedule 8 Costs, expenses and allowances

(subregulation 21.13 (3))

### Part 1 Costs

Column 1 Item	Column 2 Matter	Column 3 Amount
1	Notice of opposition	\$180
2	Evidence in support	\$480
3	Receiving and perusing notice of opposition	\$90
4	Receiving and perusing evidence in support	\$210
5	Evidence in answer	\$480
6	Receiving and perusing evidence in answer	\$145
7	Evidence in reply	\$240
8	Receiving and perusing evidence in reply	\$90
9	Preparation of cases for hearing	\$360
10	Attendance at hearing by patent attorney, trade marks agent or solicitor without counsel	\$180 an hour or \$810 a day
11	Attendance at hearing by patent attorney, trade marks agent or solicitor instructing counsel	\$145 an hour or \$650 a day
12	Counsel fees	\$240 an hour or \$1,080 a day

### Part 2 Expenses and allowances

#### Division 1 Expenses

1. A person who has paid a fee prescribed in these regulations in relation to proceedings before the Registrar may be paid the amount of the fee.
2. A person attending proceedings before the Registrar must be paid:
  - (a) a reasonable amount for allowances for transport between the usual place of residence of the person and the place that he or she attends for that purpose; and
  - (b) if the person is required to be absent overnight from his or her usual place of residence — a reasonable amount for allowances up to a daily maximum of \$405 for meals and accommodation.

#### Division 2 Allowances

3. A person who, because of his or her professional, scientific or other special skill or knowledge, is summoned to appear as a witness before the Registrar must be paid:

- (a) if the person is remunerated in his or her occupation by wages, salary or fees — an amount equal to the amount of wages, salary or fees not paid to the person because of his or her attendance for that purpose; and
- (b) in any other case — an amount of not less than \$95, or more than \$475, for each day on which he or she so attends.
4. A person summoned to appear as a witness, other than a witness referred to in clause 3, before the Registrar must be paid:
- (a) if the person is remunerated in his or her occupation by wages, salary or fees — an amount equal to the amount of wages, salary or fees not paid to the person because of his or her attendance for that purpose; and
- (b) in any other case — an amount of not less than \$54, or more than \$89, for each day on which he or she so attends.

## Schedule 9 Fees

(regulation 21.21)

<b>Column 1 Item</b>	<b>Column 2 Matter</b>	<b>Column 3 Fee</b>
1	Filing an application to register a trade mark under subsection 27 (5) of the Act in respect of goods or services in 1 or more of the prescribed classes	\$150 for each class
2	Filing a divisional application under subsection 45 (1)	\$150 for each class
3	Filing an application to register 2 or more trade marks as a series under section 51 of the Act	\$200
4	Request for amendment under section 64 or 65 of the Act to include an additional prescribed class of goods or services in an application	\$150 for each class
5	Filing an application for an extension of period or time under subregulation 4.12 (3) or regulation 5.2, 5.15 or 21.25:	
	(a) for each month or part of a month for which the extension is sought	\$65
	(b) additional fee if the application or request is filed after the end of the period or time to be extended	\$85
6	Filing a notice of opposition under section 52 or 96 or subsection 224 (6) of the Act	\$250
7	Filing an application for permission to serve a copy of further evidence in opposition proceedings under paragraph 5.15 (1) (b)	\$100
8	Single registration of a trade mark under section 68 of the Act:	
	(a) in respect of goods or services in a single prescribed class	\$300
	(b) in respect of goods or services in more than 1 prescribed class	\$300 plus \$260 for each additional class

Column 1 Item	Column 2 Matter	Column 3 Fee
9	Renewal of a single registration of a trade mark under section 75 of the Act:	
	(a) in respect of goods or services in a single prescribed class	\$300
	(b) in respect of goods or services in more than 1 prescribed class	\$300 plus \$150 for each additional class
	(c) as a result of a request made within 12 months after the expiry date to which section 79 of the Act refers	in addition to any fee in relation to paragraph (a) or (b) — \$65 for each class and for each month, or part of a month, after the expiry date
10	Filing an application for removal of a trade mark from the Register for non-use under section 92 of the Act	\$150
11	Request for a hearing:	
	(a) under regulation 5.14 or 9.4 to determine an opposition	\$500
	(b) in relation to any other matter	\$300
12	Attendance at a hearing	
	(a) under regulation 5.14 or 9.4 to determine an opposition	\$500 less any amount paid under item 11 in relation to the hearing
	(b) in relation to any other matter	\$300 less any amount paid under item 11 in relation to the hearing
13	Request for a decision under subregulation 21.16 (2)	\$300
14	Taxation of costs under regulation 21.13	\$65
15	Supply of a certificate signed by the Registrar under section 211 of the Act	\$15 for each certificate
16	Supply of a copy of an extract from the Register or another document	\$10
17	Supply of a copy of a document for which a search is required	\$65
18	Filing an application for linked applications to be considered as a single application under subsection 243 (3) of the Act	\$100

## Schedule 10      Convention countries

(regulation 21.29)

Albania	Estonia
Algeria	Fiji
Angola	Finland
Antigua and Barbuda	France (including all Overseas Departments and Territories)
Argentina	Gabon
Armenia	Gambia
Austria	Georgia
Azerbaijan	Germany
Bahamas	Ghana
Bahrain	Greece
Bangladesh	Grenada
Barbados	Guatemala
Belarus	Guinea
Belgium	Guinea-Bissau
Belize	Guyana
Benin	Haiti
Bolivia	Holy See
Bosnia and Herzegovina	Honduras
Botswana	Hong Kong, China
Brazil	Hungary
Brunei Darussalam	Iceland
Bulgaria	India
Burkina Faso	Indonesia
Burundi	Iran, Islamic Republic of
Cameroon	Iraq
Canada	Ireland
Central African Republic	Israel
Chad	Italy
Chile	Jamaica
China	Japan
Colombia	Jordan
Congo	Kazakhstan
Costa Rica	Kenya
Côte d'Ivoire	Korea, Democratic People's Republic of
Croatia	Korea, Republic of
Cuba	Kuwait
Cyprus	Kyrgyzstan
Czech Republic	Latvia
Democratic Republic of the Congo	Lebanon
Denmark (including Faroe Islands)	Lesotho
Djibouti	Liberia
Dominica	Libyan Arab Jamahiriya
Dominican Republic	Liechtenstein
Ecuador	Lithuania
Egypt	Luxembourg
El Salvador	Macau
Equatorial Guinea	
Madagascar	Senegal



Malawi  
Malaysia  
Maldives  
Mali  
Malta  
Mauritania  
Mauritius  
Mexico  
Moldova  
Monaco  
Mongolia  
Morocco  
Mozambique  
Myanmar  
Namibia  
Netherlands (including the Netherlands Antilles and Aruba)  
New Zealand (excluding the Cook Islands, Niue and Tokelau)  
Nicaragua  
Niger  
Nigeria  
Norway  
Pakistan  
Panama  
Papua New Guinea  
Paraguay  
Peru  
Philippines  
Poland  
Portugal  
Qatar  
Romania  
Russian Federation  
Rwanda  
Saint Kitts and Nevis  
Saint Lucia  
Saint Vincent and the Grenadines  
San Marino  
Sao Tome and Principe, Democratic Republic of  
Sierra Leone  
Singapore  
Slovak Republic  
Slovenia  
Solomon Islands  
South Africa  
Spain  
Sri Lanka  
Sudan  
Surinam  
Swaziland  
Sweden  
Switzerland  
Syrian Arab Republic  
Taiwan  
Tajikistan  
Tanzania  
Thailand  
The former Yugoslav Republic of Macedonia  
Togo  
Trinidad and Tobago  
Tunisia  
Turkey  
Turkmenistan  
Uganda  
Ukraine  
United Arab Emirates  
United Kingdom (including the Isle of Man)  
United Republic of Tanzania  
United States of America (including all territories and possessions, including the Commonwealth of Puerto Rico)  
Uruguay  
Uzbekistan  
Venezuela  
Viet Nam  
Yugoslavia  
Zambia  
Zimbabwe

**Note 1**

The *Trade Marks Regulations 1995* (in force under the *Trade Marks Act 1995*) as shown in this reprint comprise Statutory Rules 1995 No. 341 amended as indicated in the Tables below.

For application, saving and transitional provisions *see* Table A.

**Table of Statutory Rules**

<b>Year and number</b>	<b>Date of notification in Gazette</b>	<b>Date of commencement</b>	<b>Application, saving or transitional provisions</b>
1995 No. 341	6 Nov 1995	1 Jan 1996	
1996 No. 3	25 Jan 1996	R. 9: 1 Jan 1996 Remainder: 25 Jan 1996	—
1996 No. 184	21 Aug 1996	21 Aug 1996	—
1996 No. 272	11 Dec 1996	R. 3: 1 Jan 1997 Remainder: 11 Dec 1996	—
1997 No. 346	9 Dec 1997	Rr. 3 and 4: 1 Feb 1998 Rr. 5 and 6: 1 Jan 1998 Remainder: 9 Dec 1997	R. 3
1998 No. 258	12 Aug 1998	12 Aug 1998	—
1998 No. 265	26 Aug 1998	R. 5: 1 Nov 1998 Remainder: 26 Aug 1998	—

**Table of Amendments**

ad. = added or inserted    am. = amended    rep. = repealed    rs. = repealed and substituted

<b>Provision affected</b>	<b>How affected</b>
R. 1.1 .....	rs. 1998 No. 258
R. 4.5 .....	am. 1997 No. 346
R. 4.7 .....	am. 1996 No. 184
R. 9.1 .....	am. 1996 No. 3
R. 19.2 .....	rs. 1998 No. 258
R. 21.21 .....	am. 1998 No. 265
R. 22.1 .....	am. 1996 No. 3
R. 22.2 .....	am. 1997 No. 346
R. 22.4 .....	am. 1996 No. 3
R. 22.6 .....	ad. 1996 No. 3
Schedule 1 .....	am. 1996 No. 272
Schedule 6 .....	am. 1996 No. 3 rs. 1998 No. 258
Schedule 9 .....	am. 1996 No. 3 rs. 1997 No. 346 am. 1998 No. 265
Schedule 10 .....	am. 1996 No. 3 rs. 1996 No. 272; 1997 No. 346 am. 1998 No. 258

**Table A****Application, Saving or Transitional Provisions****Statutory Rules 1997 No. 346****3 Application**

- 3.1 The amendment of regulation 4.5 of the Trade Marks Regulations by regulation 4 of these regulations applies only to an application filed on or after 1 February 1998.
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