



Trade Marks Amendment Regulations 1998 (No. 4)

Statutory Rules 1998 No. 346

I, WILLIAM PATRICK DEANE, Governor-General of the Commonwealth of Australia, acting with the advice of the Federal Executive Council, make the following regulations under the *Trade Marks Act 1995*.

Dated 17 December 1998.

WILLIAM DEANE
Governor-General

By His Excellency's Command,

NICK MINCHIN
Minister for Industry, Science and Resources



Trade Marks Amendment Regulations 1998 (No.4)¹

Statutory Rules 1998 No. 346²

made under the

Trade Marks Act 1995

Contents

- 1 Name of regulations
- 2 Commencement
- 3 Amendment of Trade Marks Regulations 1995

Schedule 1 Amendment of Trade Marks Regulations 1995

1 Name of regulations

These regulations are the *Trade Marks Amendment Regulations 1998 (No. 4)*.

2 Commencement

These regulations commence on 27 January 1999.

3 Amendment of Trade Marks Regulations 1995

Schedule 1 amends the Trade Marks Regulations 1995.

Schedule 1 **Amendment of Trade Marks Regulations 1995** (regulation 3)

[1] **Regulation 2.1**

insert

accredited course of study means a course of study that is accredited by the Board under regulation 20.2A of the *Patents Regulations 1991*.

[2] **After Part 19**

insert

Part 20 Registered trade marks attorneys

20.1 Qualifications

- (1) For paragraph 228A (4) (a) of the Act, the qualifications are:
 - (a) for each of topic groups A, B, C and D mentioned in Schedule 5 to the Patents Regulations 1991 — a pass in:
 - (i) an accredited course of study that includes the subject matter in the topic group; or
 - (ii) the examination conducted by the Board under regulation 20.6 of the Patents Regulations 1991; and
 - (b) an award or the entitlement to an award of a degree, diploma or postgraduate qualification in any field of study.
- (2) For paragraph (1) (a), an exemption under regulation 20.13 of the Patents Regulations 1990 is taken to be a pass in the topic group for which the exemption was granted.
- (3) For paragraph 228A (4) (c) of the Act, an offence against the Act, the Designs Act 1906 or the Patents Act 1990 is a prescribed offence.
- (4) For paragraph 228A (4) (d) of the Act, an offence of dishonesty for which the maximum penalty is imprisonment for at least 2 years is a prescribed offence.

20.2 Currency of pass or exemption

For paragraph 20.1 (1) (a), a pass in a topic group or an exemption under regulation 20.13 of the Patents Regulations 1991 remains current for the purpose of completing topic groups A, B, C and D:

- (a) if the institution has a policy on time periods to complete courses of study — for the period that accords with that policy; or
- (b) for the Board, or if the institution has no policy — for 5 years from the year of notification that the candidate:

- (i) has passed the first examination in a subject in 1 of the topic groups; or
- (ii) has been exempted under regulation 20.13 of the Patents Regulations 1991 from having to pass a subject in 1 of the topic groups.

20.3 Procedure for registration

A person may apply for registration as a trade marks attorney in the approved form together with:

- (a) a written statement by the Board that the person has met the requirements of paragraph 228A (4) (a) of the Act; and
- (b) a statutory declaration by the person that the person:
 - (i) has not committed an offence prescribed by subregulation 20.1 (3); and
 - (ii) is not under sentence of imprisonment for an offence prescribed by subregulation 20.1 (4); and
- (c) a statutory declaration, by another person, that the person is of good fame, integrity and character; and
- (d) the fee mentioned in item 22 of Schedule 9.

20.4 Certificate of registration

When the Designated Manager registers a person as a trade marks attorney, the Designated Manager must give to the person a certificate of registration in the approved form.

20.5 Examinations

Division 2 of Part 2 of Chapter 20 of the *Patents Regulations 1991* applies to an examination mentioned in regulation 20.1.

20.6 Advice of completion of examinable subjects and of academic qualifications

The Board must give to a person a written statement that the person has the qualifications mentioned in subregulation 20.1 (1) if:

- (a) the person applies in the approved form; and
- (b) there are reasonable grounds for believing that the person has the qualifications.

20.7 Annual registration fee

- (1) The annual registration fee mentioned in item 23 or 24 of Schedule 9 is payable by a registered trade marks attorney on 1 July in each year.
- (2) The Designated Manager must give to each registered trade marks attorney no later than 1 June in each year notice of the fee that is payable.
- (3) If a registered trade marks attorney does not pay the fee within 14 days after it is payable, the Designated Manager must:

- (a) remove the name of the attorney from the Register of Trade Marks Attorneys; and
- (b) notify the attorney of that removal.

20.8 Restoration of name to the Register

The Designated Manager may restore a person's name to the Register of Trade Marks Attorneys if, within 6 weeks after the end of the period mentioned in subregulation 20.7 (3) or a further period reasonably allowed by the Designated Manager, the person:

- (a) pays the fees referred to in regulation 20.7 and item 25 of Schedule 9; and
- (b) applies in the approved form.

20.9 Voluntary removal of name from register

- (1) On written application by a registered trade marks attorney, the Designated Manager may:
 - (a) remove the attorney's name from the Register of Trade Marks Attorneys for up to 3 years; or
 - (b) restore the attorney's name to the register on payment of:
 - (i) the annual registration fee payable for the year in which the reinstatement is made; and
 - (ii) the fee mentioned in item 25 of Schedule 9.
- (2) An application for restoration of an attorney's name to the register under paragraph (1) (b) must be made within the period determined by the Designated Manager for paragraph (1) (a).

20.10 Lien

A registered trade marks attorney has the same right of lien over documents and property of a client as a solicitor.

20.11 Discipline

Part 4 of Chapter 20 of the *Patents Regulations 1991* applies to a registered trade marks attorney as if the references in that Part to a registered patent attorney were references to a registered trade marks attorney.

[3] Paragraph 21.6 (3) (f)

substitute

- (f) a registered patent attorney; or

[4] **Regulation 21.30**

substitute

21.30 Rights of registered patent attorneys

A registered patent attorney has the same right of lien over documents and property of a client as a solicitor.

[5] **After regulation 21.34**

insert

21.35 Review of decisions

(1) In this regulation:

decision has the same meaning as in the *Administrative Appeals Tribunal Act 1975*.

(2) Application may be made to the Tribunal for review of a decision of:

- (a) the Board under subregulation 20.21 (7) of the *Patents Regulations 1991* in its application to trade marks attorneys; or
- (b) the Disciplinary Tribunal under subregulation 20.23 (2), (4) or (5) of the *Patents Regulations 1991* in its application to trade marks attorneys.

[6] **After regulation 22.6**

insert

22.7 Trade marks attorneys

For registration as a trade marks attorney, a person is taken to meet the requirements of subregulation 20.1 (1) until 27 January 2001 if the person:

- (a) was, on 28 February 1998, registered as a patent attorney under section 198 of the *Patents Act 1990*; or
- (b) met the requirements of paragraphs 198 (2) (c) and (d) of the *Patents Act 1990* as in force on 26 January 1999; or
- (c) is a legal practitioner who acted for a client in trade mark matters before 27 January 1999, and makes a statutory declaration to that effect; or
- (d) is a person to whom note 4 to subsection 156 (2) of the *Trade Marks Act 1995* applies.

22.8 Trade marks attorney examination requirements

- (1) For a person who passed an examination, or was exempted from having to pass the examination, for at least 1 subject under Schedule 5 of the *Patents Regulations 1991* as in force on 26 January 1999, the period of 5 years for paragraph 20.3A (1) (b) of the *Patents Regulations 1991* is taken to commence on 27 January 1999.

- (2) Subregulation (3) applies to a person who has passed an examination, or been exempted from having to pass the examination, for at least 1 subject mentioned in Schedule 5 as in force on 26 January 1999.
- (3) A pass in an examination for a subject mentioned in column 1 of the following table is taken to be a pass for paragraph 20.1 (1) (a) in a topic group mentioned in column 2 of the table:

Column 1 Subject	Column 2 Topic group
Legal Process	Group A — Legal process and overview of intellectual property
Patent Attorneys' Practice, Part 2	Group B — Professional conduct
Trade Marks law of Australia and the Practice of the Trade Marks Office	Group C — Trade mark law
Patent Attorneys' Practice, Part 1 and Patent Attorneys' Practice, Part 2	Group D — Trade mark practice

- (4) For registration as a trade marks attorney, a person is taken to have passed an examination for Patent Attorney's Practice 1 and Patent Attorney's Practice 2 if the person:
- before 27 January 1999, passed an examination for a subject that the Board considers is equivalent to topic groups A and C mentioned in Schedule 5 to the *Patents Regulations 1991*; and
 - applies for registration as a trade marks attorney before 27 January 2001; and
 - provides a statutory declaration by an employer or the employer's representative that the person's principal field of practice for 2 continuous years has been in trade marks matters.

[7] **Schedule 8, items 10 and 11**

omit

patent attorney, trade marks agent

insert

registered patent attorney, registered trade marks attorney

[8] Schedule 9, after item 18*insert*

19	Applying for admission to sit for an examination conducted by the Board	\$400
20	Applying for grant of a supplementary examination conducted by the Board	\$200
21	A report of reasons for failure of an examination conducted by the Board	\$200
22	Applying for registration as a trade marks attorney	\$150
23	Annual registration fee payable by a trade marks attorney	\$150
24	Annual registration fee payable for combined registration as a trade marks attorney and patent attorney	\$320
25	Applying under regulation 20.8 or 20.9	\$160

Notes

1. These regulations amend Statutory Rules 1995 No. 341, as amended by 1996 Nos. 3, 184 and 272; 1997 No. 346; 1998 Nos. 258, 265 and 343.
2. Made by the Governor-General on 17 December 1998, and notified in the *Commonwealth of Australia Gazette* on 22 December 1998. Administered by the Minister for Industry, Science and Resources.