



**Trade Marks Amendment Regulations 2001 (No. 1)**<sup>1</sup>

**Statutory Rules 2001 No. 33**<sup>2</sup>

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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 22 February 2001

WILLIAM DEANE  
Governor-General

By His Excellency's Command

WARREN ENTSCH  
Parliamentary Secretary to the Minister for Industry,  
Science and Resources

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**1 Name of Regulations**

These Regulations are the *Trade Marks Amendment Regulations 2001 (No. 1)*.

**2 Commencement**

These Regulations commence on the commencement of the *Trade Marks Amendment (Madrid Protocol) Act 2000*.

**3 Amendment of *Trade Marks Regulations 1995***

Schedule 1 amends the *Trade Marks Regulations 1995*.

**Schedule 1                      Amendments**  
(regulation 3)

**[1] Regulation 2.1, before definition of *accredited course of study***

*insert*

*ACCC* means the Australian Competition and Consumer Commission established under the *Trade Practices Act 1974*.

**[2] Regulation 2.1, after definition of *earlier application***

*insert*

*International Register* has the meaning given by regulation 17A.2.

*international registration* has the meaning given by regulation 17A.2.

*IRDA* has the meaning given by regulation 17A.2.

*Madrid Protocol* means the Protocol Relating to the Madrid Agreement concerning the International Registration of Marks, as signed at Madrid on 28 June 1989.

*priority date*, for a trade mark that is the subject of an IRDA or a protected international trade mark, has the meaning given by regulation 17A.3.

*protected international trade mark* has the meaning given by regulation 17A.2.

*Record of International Registrations* has the meaning given by regulation 17A.2.

**[3] Paragraphs 4.13 (1) (b) and (c)***substitute*

- (b) the Registrar reasonably believes that there are grounds for rejecting the application under subsection 44 (1) or (2) of the Act, or subregulation 4.15A (1) or (2), because of another trade mark:
  - (i) that is registered by another person; or
  - (ii) that is a protected international trade mark; or
  - (iii) in respect of which an application for registration, or an IRDA, 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 the IRDA; or
  - (ii) is seeking to satisfy the Registrar as to:
    - (A) a matter mentioned in paragraph 44 (3) (a) or (b) of the Act or 4.15A (3) (a) or (b) of these Regulations; or
    - (B) the matters mentioned in subsection 44 (4) of the Act or subregulation 4.15A (5);
 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 or regulation 17A.48 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 or the Record of International Registrations 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; or
  - (vi) is awaiting renewal of the international registration of the other trade mark in the period of 6 months after the international registration has expired, or removal of the other trade mark from the International Register.

**[4] Paragraph 4.14 (2) (b)***after*

of the Act

*insert*

or subregulation 4.15A (1) or (2)

[5] **Paragraph 4.14 (3) (a)**

*after*

registration of

*insert*

, or the extension of protection to,

[6] **Paragraph 4.14 (3) (c)**

*after*

of the Act

*insert*

or regulation 17A.48

[7] **Paragraph 4.14 (3) (d)**

*after*

the Register

*insert*

or the Record of International Registrations

[8] **After paragraph 4.14 (3) (e)**

*insert*

(ea) if acceptance is deferred because of subparagraph 4.13 (1) (c) (vi) — when the international registration of the other trade mark is renewed or the other trade mark is removed from the International Register; and

[9] **Paragraph 4.15 (a)**

*after*

“By Royal Letters Patent”,

*insert*

‘Protected International Trade Mark’,

[10] **After regulation 4.15**

*insert*

**4.15A Grounds for rejection — trade mark identical etc to trade mark protected under Madrid Protocol**

- (1) Subject to subregulations (3) and (5), an application for the registration of a trade mark (*applicant's trade mark*) in respect of goods (*applicant's goods*) must be rejected if:
  - (a) the applicant's trade mark is substantially identical with, or deceptively similar to:
    - (i) a protected international trade mark; or
    - (ii) a trade mark in respect of which the Registrar has received notification of an IRDA;  
held by another person in respect of similar goods or closely related services;  
and
  - (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's goods is not earlier than the priority date for the other trade mark in respect of the similar goods or closely related services.
- (2) Subject to subregulations (3) and (5), an application for the registration of a trade mark (*applicant's trade mark*) in respect of services (*applicant's services*) must be rejected if:
  - (a) the applicant's trade mark is substantially identical with, or deceptively similar to:
    - (i) a protected international trade mark; or
    - (ii) a trade mark in respect of which the Registrar has received notification of an IRDA;  
held by another person in respect of similar services or closely related goods;  
and
  - (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's services is not earlier than the priority date for the other trade mark in respect of the similar services or closely related goods.
- (3) If the Registrar in either case is satisfied:
  - (a) that there has been honest concurrent use of the 2 trade marks; or
  - (b) that, because of other circumstances, it is proper to do so;
 the Registrar may accept the application for the registration of the applicant's trade mark subject to any conditions or limitations that the Registrar thinks fit to impose.
- (4) If the applicant's trade mark has been used only in a particular area, the limitations may include that the use of the trade mark is to be restricted to that particular area.
- (5) If the Registrar in either case is satisfied that the applicant, or the applicant and the predecessor in title of the applicant, have continuously used the applicant's trade mark for a period:

- (a) beginning before the priority date for the other trade mark in respect of:
  - (i) the similar goods or closely related services; or
  - (ii) the similar services or closely related goods; and
- (b) ending on the priority date for the registration of the applicant's trade mark; the Registrar must not reject the application because of the existence of the other trade mark.

*Note* Section 44 of the Act provides for rejection of an application on the grounds that the trade mark is substantially identical with, or deceptively similar to, a registered trade mark or a trade mark for which registration is being sought.

**[11] After regulation 17.1**

*insert*

**17.2 Defensive trade mark based on protected international trade mark**

- (1) This regulation applies if, because of the extent to which a protected international trade mark has been used in relation to all or any of the goods or services in respect of which it is protected, it is likely that the use of the trade mark in relation to other goods or services would be taken to indicate that there is a connection between those other goods or services and the holder of the protected international trade mark.
- (2) The holder of the protected international trade mark may apply for its registration as a defensive trade mark in respect of any or all of the other goods or services.
- (3) Part 17 of the Act applies for the purposes of an application under subregulation (2) as if:
  - (a) a reference in that Part to a registered trade mark were a reference to the protected international trade mark; and
  - (b) a reference in that Part to goods or services in respect of which a trade mark is registered were a reference to goods or services protected by the protected international trade mark; and
  - (c) a reference in that Part to the registered owner of a trade mark were a reference to the holder of the protected international trade mark; and
  - (d) the reference in paragraph 187 (c) of the Act to a trade mark that is not registered as a trade mark in the name of the applicant included a trade mark that is not a protected international trade mark held by the applicant; and
  - (e) the reference in section 189 of the Act to a trade mark that is not registered in the name of the registered owner included a trade mark that is not a protected international trade mark held by the registered owner.

[12] **After Part 17**

*insert*

**Part 17A Protected international trade marks under the Madrid Protocol**

**Division 1 General**

**17A.1 Purpose of Part**

This Part provides for matters that enable the performance of the obligations of Australia, or obtain for Australia an advantage or benefit, under the Madrid Protocol.

**17A.2 Definitions for Part**

*Common Regulations* means the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol relating to that Agreement, as in force on 1 January 1998.

*date of international registration* means the date recorded in the International Register as the international registration date for a trade mark in respect of which a request was made under Article 3<sup>ter</sup>(1) of the Protocol for extension of protection to Australia.

*date of recordal* means the date recorded in the International Register as the recordal date for a request made under Article 3<sup>ter</sup>(2) of the Protocol for extension of protection to Australia.

*holder* means:

- (a) in relation to an IRDA or a protected international trade mark — the person or persons in whose name or names the international registration of the trade mark is recorded in the Record of International Registrations; and
- (b) in relation to another international registration of a trade mark — the person or persons in whose name or names the international registration of the trade mark is recorded in the International Register.

*International Bureau* means the International Bureau of the World Intellectual Property Organisation.

*International Register* means the register maintained by the International Bureau for the purposes of the Protocol.

*international registration* of a trade mark means registration of the mark in the International Register.

*international registration designating Australia*, or *IRDA*, means a request, made under Article 3<sup>ter</sup> (1) or (2) of the Protocol, for extension to Australia of the protection resulting from the international registration of a trade mark.

*Office of origin* has the meaning given by Article 2 (2) of the Protocol.

**priority date**, for a trade mark that is the subject of an IRDA or a protected international trade mark, has the meaning given by regulation 17A.3.

**protected international trade mark** means a trade mark to which protection resulting from international registration of the mark is extended in Australia in accordance with these Regulations.

**Protocol** means the Madrid Protocol.

**Record of International Registrations** means the record required to be kept by regulation 17A.66.

### 17A.3 Meaning of priority date

- (1) The priority date for a trade mark that is the subject of an IRDA in respect of particular goods or services is the date that would be the date of effect of the protection of the trade mark in respect of those goods or services if the trade mark became a protected international trade mark.
- (2) The priority date for a protected international trade mark in respect of particular goods or services is the date of effect of the protection of the trade mark in respect of those goods or services.

### 17A.4 Meaning of date of effect

- (1) Subject to subregulation (2), the date of effect of the protection of a protected international trade mark is:
  - (a) if the request for extension of protection to Australia was made under Article 3<sup>ter</sup> (1) of the Protocol — the date of international registration of the trade mark; or
  - (b) if the request for extension of protection to Australia was made under Article 3<sup>ter</sup> (2) of the Protocol — the date of recordal of the request.
- (2) If:
  - (a) the request for extension of protection to Australia was in respect of a trade mark whose registration had also been sought in 1 or more Convention countries; and
  - (b) the holder claimed a right of priority under regulation 17A.15 for protection of the trade mark in respect of particular goods or services; and
  - (c) the trade mark is a protected international trade mark;  
the protection of the trade mark is taken to have had effect:
    - (d) if an application to register the trade mark was made in only 1 Convention country — from (and including) the day on which the application was made in that country; or
    - (e) if applications to register the trade mark were made in more than 1 Convention country — from (and including) the day on which the earliest of those applications was made.



## **Division 2      Application for international registration of a trade mark**

### **17A.5 Purpose of Division**

This Division makes provision for dealing with applications for international registration of trade marks that are to be filed with the International Bureau through the intermediary of the Trade Marks Office.

### **17A.6 Eligibility to apply for international registration**

- (1) A person who is:
  - (a) the registered owner of a registered trade mark; or
  - (b) an applicant for registration of a trade mark; may apply for international registration of the trade mark.
- (2) The person must:
  - (a) be an Australian citizen; or
  - (b) be domiciled in Australia; or
  - (c) have a real and effective industrial or commercial establishment in Australia.

*Note* These requirements are stated in Article 2 (1) (ii) of the Protocol.

- (3) Two or more persons may jointly apply for international registration of a trade mark as allowed by rule 8 of the Common Regulations.

### **17A.7 Application for international registration**

- (1) Subject to subregulation (2), the application must:
  - (a) comply with the requirements of the Protocol; and
  - (b) be filed with the International Bureau through the intermediary of the Trade Marks Office.
- (2) The applicant must use the official form issued by the International Bureau or another form that requires the same information and uses the same format as the official form.

### **17A.8 Functions of Registrar**

- (1) The Registrar must perform the functions, under the Protocol, of the Office of origin in relation to:
  - (a) the application; and
  - (b) if the application results in an international registration, the international registration.
- (2) In particular, the Registrar must:
  - (a) check the application; and
  - (b) certify that the information in the application corresponds with the information held by the Registrar in respect of the application for registration of the trade mark (the *basic application*) or the registration of the trade mark (the *basic registration*), as the case requires; and

- (c) if the application results in an international registration — notify the International Bureau if the basic application or the basic registration is withdrawn, restricted or cancelled or lapses, expires or otherwise ceases to have effect in respect of some or all of the goods or services listed in the international registration:
  - (i) within 5 years after the date of the international registration; or
  - (ii) after that time, if the action that resulted in the basic application or the basic registration being so affected began before the end of that 5 year period.

*Note* The detailed functions for the Office of origin are set out in the Protocol and the Common Regulations.

### **17A.9 Time limit for Registrar to send application to International Bureau**

The Registrar must take all reasonable steps to ensure that the application is received by the International Bureau within 2 months after the date on which it is filed with the Registrar.

### **17A.10 Subsequent designations**

- (1) The holder of an international registration for which the Trade Marks Office is the Office of origin may make a request for territorial extension in accordance with Article 3<sup>ter</sup> (2) of the Protocol.
- (2) The request may be made to the International Bureau through the intermediary of the Trade Marks Office.
- (3) If a request is made through the Trade Marks Office, the Registrar must perform the functions, under the Protocol, of the Office of origin in relation to the request.

## **Division 3 International registration designating Australia**

### **Subdivision 1 General**

#### **17A.11 Purpose of Division**

This Division makes provision for dealing with a request to extend to Australia the protection resulting from international registration of a trade mark.

#### **17A.12 Registrar to examine, and report on, IRDA**

If the Registrar receives from the International Bureau a notification of an IRDA, the Registrar must examine and report on:

- (a) whether the IRDA is in accordance with this Division; and
- (b) whether there are grounds under Subdivision 2 for rejecting it.

### 17A.13 Use of trade mark

- (1) The holder of an IRDA:
  - (a) must be using, or must intend to use, the trade mark that is the subject of the IRDA in relation to the goods, services or goods and services listed in the IRDA; or
  - (b) must have authorised, or intend to authorise, another person to use the trade mark in relation to those goods, services or goods and services; or
  - (c) must intend to assign the trade mark to a body corporate that is about to be constituted with a view to the use by the body corporate of the trade mark in relation to the goods, services or goods and services.
- (2) If there is reason to suspect that the holder does not meet a requirement of subregulation (1) in relation to any of the goods or services mentioned in the IRDA, the Registrar may require the holder to make a declaration to the Registrar that those provisions apply to all of those goods and services.

### 17A.14 Specification of goods and services

The expression ‘all goods’, ‘all services’, ‘all other goods’ or ‘all other services’ must not be used in an IRDA to specify the goods or services in respect of which protection is sought.

### 17A.15 Claim for priority

- (1) If:
  - (a) a person has made an application for the registration of a trade mark in 1 or more Convention countries; and
  - (b) within 6 months after the day on which that application, or the first of those applications, was made, that person or another person (*successor in title*) of whom that person is a predecessor in title makes an IRDA in respect of some or all of the goods, services or goods and services in respect of which registration was sought in that country or those countries;
 that person or that person’s successor in title may claim a right of priority for the protection of the trade mark in respect of any or all of those goods, services or goods and services.
- (2) The right of priority must be claimed in the IRDA that is notified to the Registrar in accordance with this Division.

*Note* Rule 9 (4) (iv) of the Common Regulations contains requirements relating to claims for priority.

- (3) The priority claimed is for the protection of the trade mark in respect of the goods, services or goods and services:
  - (a) if an application to register the trade mark was made in only 1 Convention country — from (and including) the day on which the application was made in that country; or
  - (b) if applications to register the trade mark were made in more than 1 Convention country — from (and including) the day on which the earliest of those applications was made.

*Note* For *Convention country* see section 225 of the Act.

**17A.16 Examination of IRDA — report to holder**

- (1) If, in the course of an examination of an IRDA, the Registrar reasonably believes that:
  - (a) the IRDA is not in accordance with this Division; or
  - (b) there are grounds under Subdivision 2 for rejecting it in whole or in part;
 the Registrar must send a report in accordance with rule 17 of the Common Regulations to the holder through the intermediary of the International Bureau.
- (2) Such a report is a provisional refusal for the purposes of the Protocol.
- (3) The report must include:
  - (a) notice of the date by which the Registrar must notify his or her final decision on examination to the International Bureau; and
  - (b) notice that the Registrar is not required to consider any response by the holder to the report unless the holder has notified the Registrar, in writing, of the holder's address for service in Australia.

*Note* Under the Protocol, protection must be extended in Australia to a trade mark that is the subject of an IRDA at the end of 18 months after the International Bureau notifies the Trade Marks Office of the IRDA unless, before then, the International Bureau receives:

- (a) notification of a provisional or final refusal from the Trade Marks Office; or
- (b) notification of the possibility that oppositions may be filed after the 18-month period.

**17A.17 Examination — holder's response to report**

- (1) The holder of the IRDA may respond in writing to the Registrar's report under regulation 17A.16.
- (2) The response may do any of the following:
  - (a) contest a belief of the Registrar that is expressed in the report;
  - (b) contest another matter that is mentioned in the report;
  - (c) provide further documents or evidence in support of the IRDA;
  - (d) request a hearing from the Registrar.
- (3) The holder must notify the Registrar, in writing, of the holder's address for service in Australia.

**17A.18 Examination — further report to holder**

- (1) If the holder has complied with subregulation 17A.17 (3), the Registrar must:
  - (a) consider the holder's response; and
  - (b) if the holder requests a hearing, give the holder an opportunity to be heard.
- (2) If, after considering the response and (if a hearing is requested) the submissions to the hearing, the Registrar continues to believe that:
  - (a) the IRDA is not in accordance with this Division; or
  - (b) there are grounds under Subdivision 2 for rejecting it in whole or in part;

the Registrar must tell the holder, in writing, of that belief.

- (3) Unless the acceptance of an IRDA is deferred under regulation 17A.21, a report under subregulation (2) about the IRDA must specify the date by which the Registrar must notify his or her final decision on examination to the International Bureau.
- (4) Regulation 17A.17 and this regulation apply to a report under subregulation (2) as if it were a report under regulation 17A.16.

#### **17A.19 Examination — additional requirements**

- (1) In the course of an examination of an IRDA for which a right of priority is claimed, the Registrar may, by writing, require the holder to file:
  - (a) a copy of any earlier application certified in the trade marks office (however described) 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 holder is the successor in title to the person who made the earlier application, the Registrar may, by writing, require the holder to file documentary evidence that is sufficient to establish the passing of title to the holder.

#### **17A.20 Period within which final decision on examination must be notified**

- (1) For an IRDA in respect of which a report is made under regulation 17A.16, the Registrar must notify his or her decision under regulation 17A.24 (the *final decision on examination*) to the International Bureau:
  - (a) if paragraph (b) does not apply — within 15 months from the date of that report (whether or not a further report is made under regulation 17A.18); or
  - (b) if a further report raises grounds under Subdivision 2 for rejecting the IRDA that were not raised in the report made under regulation 17A.16 — within 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 IRDA, no account is to be taken of any period during which acceptance of the IRDA is deferred under regulation 17A.21.
- (3) The holder of an IRDA may, before the end of a period mentioned 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 mentioned in subregulation (1).

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

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

### **17A.21 Deferment of acceptance**

- (1) The Registrar may, at the written request of the holder, defer acceptance of an IRDA if:
- (a) the request is made within a period mentioned in subregulation 17A.20 (1); and
  - (b) the Registrar reasonably believes that there are grounds for rejecting the IRDA under subsection 44 (1) or (2) of the Act (as applied by regulation 17A.28) because of another trade mark:
    - (i) that is registered by another person; or
    - (ii) that is a protected international trade mark; or
    - (iii) in respect of which an application for registration, or an IRDA, has been made by another person; and
  - (c) the holder:
    - (i) is awaiting the finalisation of proceedings in respect of the application for registration of the other trade mark or the IRDA; or
    - (ii) is seeking to satisfy the Registrar as to:
      - (A) a matter mentioned in paragraph 44 (3) (a) or (b) of the Act (as applied by regulation 17A.28); or
      - (B) the matters mentioned in subsection 44 (4) of the Act (as applied by regulation 17A.28);
 in relation to the holder's trade mark and the other trade mark; or
    - (iii) has filed an application under section 92 of the Act or subregulation 17A.48 (1) 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 or the Record of International Registrations 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; or
    - (vi) is awaiting renewal of the international registration of the other trade mark in the period of 6 months after the international registration has expired, or removal of the other trade mark from the International Register.
- (2) The Registrar may, on his or her own initiative, defer acceptance of the IRDA within the period mentioned in subregulation 17A.20 (1), or (if such a period is extended under section 224 of the Act or subregulation 17A.20 (4)) the extended period, 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 IRDA; or
  - (c) an application has been made to the Administrative Appeals Tribunal for review of a decision of the Registrar in relation to the IRDA; or
  - (d) the Registrar is informed in writing that the holder has died.
- (3) The Registrar must defer acceptance of an IRDA in respect of a certification trade mark when a copy of the rules governing the use of the certification trade mark is sent to the ACCC in accordance with regulation 16.2 (as applied by regulation 17A.50).
- (4) The Registrar must inform the holder in writing:
- (a) if the holder requests the Registrar to defer acceptance of an IRDA — of the Registrar’s decision to defer, or not to defer, acceptance of the IRDA; and
  - (b) if the Registrar otherwise defers acceptance of an IRDA — of the provision under which acceptance of the IRDA is deferred.

#### **17A.22 Period for which acceptance is deferred**

- (1) The period for which acceptance of an IRDA is deferred (the *deferment period*) begins immediately after:
- (a) for deferral under subregulation 17A.21 (1) — the date the Trade Marks Office receives the request; or
  - (b) for deferral under subregulation 17A.21 (2) or (3) — the date of the notice of deferment issued under subregulation 17A.21 (4).
- (2) The deferment period ends:
- (a) when the IRDA 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 IRDA under subsection 44 (1) or (2) of the Act (as applied by regulation 17A.28); or
  - (c) if paragraphs (a) and (b) do not apply — in accordance with subregulation (3).
- (3) For paragraph (2) (c), the deferment period ends:
- (a) if acceptance is deferred because of subparagraph 17A.21 (1) (c) (i) — when proceedings relating to the registration of, or the extension of protection to, the other trade mark are finalised; and
  - (b) if acceptance is deferred because of subparagraph 17A.21 (1) (c) (ii) — at the end of 6 months from the date of commencement of deferment; and
  - (c) if acceptance is deferred because of subparagraph 17A.21 (1) (c) (iii) — when proceedings under Part 9 of the Act or regulation 17A.48 relating to the other trade mark are finalised; and
  - (d) if acceptance is deferred because of subparagraph 17A.21 (1) (c) (iv) — when the proceedings to have the Register or the Record of International Registrations rectified in respect of the other trade mark are determined or otherwise disposed of; and

- (e) if acceptance is deferred because of subparagraph 17A.21 (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 subparagraph 17A.21 (1) (c) (vi) — when the international registration of the other trade mark is renewed or the other trade mark is removed from the International Register; and
  - (g) if acceptance is deferred because of paragraph 17A.21 (2) (a) — at the end of 2 months after the beginning of the period in which:
    - (i) proceedings mentioned in paragraph 17A.21 (2) (b) may be begun; or
    - (ii) an application mentioned in paragraph 17A.21 (2) (c) may be made; and
  - (h) if acceptance is deferred because of paragraph 17A.21 (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; and
  - (i) if acceptance is deferred because of paragraph 17A.21 (2) (d) — at the end of a period after the death of the holder that the Registrar reasonably regards as sufficient in the circumstances; and
  - (j) if acceptance is deferred because of subregulation 17A.21 (3):
    - (i) if the ACCC gives a certificate under subsection 175 (2) of the Act (as applied by regulation 17A.50) in respect of the IRDA — when the Registrar accepts the IRDA in respect of the certification trade mark; and
    - (ii) if the ACCC does not give such a certificate — at the end of 2 months after the date of the notice to the Registrar under subsection 175 (4) of the Act (as applied by regulation 17A.50).
- (4) If acceptance of an IRDA is deferred as a result of the operation of more than 1 of the provisions of paragraph 17A.21 (1) (c) and subregulation 17A.21 (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 inform the holder in writing of:
- (a) the end of a period of deferment; and
  - (b) if acceptance is deferred under subregulation 17A.21 (1) — the last day of the relevant period mentioned in paragraph 17A.20 (1) (a) or (b).

### **17A.23 Expedited examination**

Regulations 4.18 and 4.19 apply in relation to an IRDA as if a reference in those regulations to an application for registration of a trade mark were a reference to the IRDA.

### **17A.24 Final decision on examination**



- (1) The Registrar must, after the examination, accept the IRDA unless he or she is satisfied that:
  - (a) it is not in accordance with this Division; or
  - (b) there are grounds for rejecting it.
- (2) The Registrar may accept the IRDA subject to conditions or limitations.
- (3) The Registrar must reject an IRDA, in whole or in part, if the Registrar is satisfied that:
  - (a) it is not in accordance with this Division; or
  - (b) there are grounds for rejecting it, in whole or in part.

#### **17A.25 Notice of final decision on examination**

- (1) If the Registrar decides to accept the IRDA as notified, the Registrar:
  - (a) must notify the decision in the *Official Journal*:
    - (i) specifying the particulars of the IRDA; and
    - (ii) stating that, unless a notice of opposition is filed within the period allowed under paragraph 17A.29 (2) (b), the trade mark that is the subject of the IRDA will be protected in Australia in respect of the goods, services or goods and services in respect of which protection was sought; and
  - (b) must notify the holder, in writing, of the decision; and
  - (c) may notify the International Bureau, in writing, of the decision.
- (2) If the Registrar made a report under regulation 17A.16 in respect of the IRDA, the Registrar:
  - (a) must notify the International Bureau of the final decision on examination in accordance with rule 17 of the Common Regulations; and
  - (b) must notify the holder, in writing, of the final decision on examination; and
  - (c) if the final decision on examination is to accept the IRDA in whole or in part, must notify the decision in the *Official Journal*:
    - (i) specifying the particulars of the IRDA; and
    - (ii) stating that, unless a notice of opposition is filed within the period allowed under paragraph 17A.29 (2) (b), the trade mark that is the subject of the IRDA will be protected in Australia, to the extent of the final decision, in respect of the goods, services or goods and services in respect of which protection was sought.

#### **17A.26 Appeal**

- (1) Section 35 of the Act applies in relation to the Registrar's decision under regulation 17A.24 as if:
  - (a) the reference in that section to an applicant were a reference to the holder of an IRDA; and

- (b) the reference in that section to accepting an application were a reference to accepting an IRDA; and
  - (c) the reference in that section to rejecting an application were a reference to rejecting an IRDA in whole or in part.
- (2) The Registrar:
- (a) may inform the International Bureau of an appeal against the Registrar's decision; and
  - (b) must inform the International Bureau of the decision on the appeal.

#### **17A.27 Revocation of acceptance**

- (1) If, before the trade mark that is the subject of the IRDA becomes a protected international trade mark, and before the end of 18 months after the International Bureau notified the Registrar of the IRDA, the Registrar becomes satisfied that:
- (a) the IRDA was accepted because of an error or omission in the course of the examination; or
  - (b) in the special circumstances of the case, the trade mark that is the subject of the IRDA should not be protected in Australia, or should be protected subject to conditions or limitations, or to additional or different conditions or limitations;
- the Registrar may revoke the acceptance of the IRDA.
- (2) If the Registrar revokes the acceptance of the IRDA:
- (a) the IRDA is taken never to have been accepted; and
  - (b) this Subdivision again applies in relation to the IRDA; and
  - (c) the Registrar must notify the International Bureau that the acceptance has been revoked.

### **Subdivision 2 Grounds for rejecting IRDA**

#### **17A.28 Grounds for rejecting IRDA**

- (1) The grounds for rejecting an IRDA are the grounds set out in sections 39 to 44 of the Act, as affected by subregulation (2).
- (2) Sections 39 to 44 apply in relation to an IRDA as if:
- (a) a reference in those sections:
    - (i) to an application for the registration of a trade mark were a reference to the IRDA; and
    - (ii) to an applicant were a reference to the holder of the IRDA; and
  - (b) the reference in paragraph 41 (6) (a) to the filing date in respect of an application were a reference to the date of international registration or the date of recordal, as applicable, in respect of the IRDA; and
  - (c) each reference in subparagraphs 44 (1) (a) (i) and (2) (a) (i) to a trade mark registered by another person included a protected international trade mark held by another person; and

- (d) each reference in subparagraphs 44 (1) (a) (ii) and (2) (a) (ii) to a trade mark whose registration is being sought by another person included a trade mark in respect of which the extension of protection to Australia is being sought by another person.

### **Subdivision 3 Opposition to IRDA**

#### **17A.29 Opposition**

- (1) If the Registrar has notified in the *Official Journal* the acceptance of an IRDA, a person may oppose the extension of protection in Australia to the trade mark that is the subject of the IRDA by filing a notice of opposition.
- (2) The notice of opposition must:
  - (a) be in an approved form; and
  - (b) be filed with the Registrar:
    - (i) within 3 months from the day on which the acceptance of the IRDA is notified in the *Official Journal*; or
    - (ii) if an extension of time is granted under regulation 17A.30, within the extended time allowed.
- (3) The Registrar must notify the International Bureau of the opposition in accordance with rule 16 or 17, as applicable, of the Common Regulations.

#### **17A.30 Extension of time for filing**

- (1) A person may apply to the Registrar for an extension of time in which to file a notice of opposition.
- (2) Regulations 5.2, 5.3 and 5.4 (except subregulations 5.4 (2) and (3)) apply, with the necessary modifications, to an application for extension of time under subregulation (1).

#### **17A.31 Grounds for opposing IRDA**

- (1) The extension of protection may be opposed on any of the grounds on which an IRDA may be rejected under Subdivision 2, except the ground that the trade mark cannot be represented graphically.
- (2) The extension of protection may also be opposed on any of the grounds set out in sections 58 to 61 of the Act, as affected by subregulation (3).
- (3) Sections 58 to 61 apply in relation to an IRDA as if:
  - (a) a reference in those sections:
    - (i) to an application for the registration of a trade mark were a reference to the IRDA; and
    - (ii) to an applicant were a reference to the holder of the IRDA; and
    - (iii) to the registration of a trade mark were a reference to the extension of protection in Australia to the trade mark that is the subject of the IRDA; and

- (b) the reference in paragraph 60 (a) to the priority date for the registration of the trade mark were a reference to the priority date for the trade mark that is the subject of the IRDA.
- (4) The extension of protection may also be opposed on the grounds that:
  - (a) a document filed in support of the IRDA was amended contrary to the Act; or
  - (b) the Registrar accepted the IRDA on the basis of evidence provided, or a representation made, by the holder that was false in a material particular.

*Note* Section 66 of the Act makes provision in relation to amendment of documents filed with the Registrar.

**17A.32 Circumstances in which opposition may proceed in name of a person other than the person who filed the notice**

Section 53 of the Act applies in respect of a notice of opposition filed under this Subdivision.

**17A.33 Opposition proceedings**

- (1) The Registrar must give to the opponent and to the holder of the IRDA an opportunity of being heard on the opposition.
- (2) Regulations 5.7 to 5.17 apply, with the necessary modifications, for the purposes of the opposition.
- (3) Despite subregulations (1) and (2), a requirement to serve a document on the holder, or to give the holder an opportunity to make written representations or to be heard, does not apply unless, within 3 months after the notice of opposition is filed, the holder has notified the Registrar, in writing, of the holder's address for service in Australia.

**17A.34 Decision on opposition**

- (1) Unless the opposition proceedings are discontinued or dismissed, the Registrar must decide:
  - (a) to refuse protection in respect of all of the goods or services listed in the IRDA; or
  - (b) to extend protection in respect of some or all of the goods or services listed in the IRDA (with or without conditions or limitations);
 having regard to the extent (if any) to which any ground on which the IRDA was opposed has been established.
- (2) Unless subregulation 17A.35 (2) applies, the Registrar must tell the International Bureau of his or her decision as soon as practicable after the end of the appeal period mentioned in subregulation 17A.36 (1).

**17A.35 Appeal**

- (1) Section 56 of the Act applies in relation to the Registrar's decision on the opposition as if a reference in that section:

- (a) to an applicant were a reference to the holder of an IRDA; and
  - (b) to a decision under section 55 of the Act were a reference to a decision under regulation 17A.34.
- (2) If an appeal is made, the Registrar must tell the International Bureau of the decision on the appeal as soon as practicable after that decision is made.

#### **Subdivision 4 Extension of protection**

##### **17A.36 When trade mark becomes a protected international trade mark**

- (1) In this regulation:

*appeal period*, in relation to an opposition decision, means the period within which an appeal from the decision can be made under regulation 17A.35, not including any extension of the period that the court may allow in a particular case.

*opposition period* means the period allowed under paragraph 17A.29 (2) (b).

- (2) If:
- (a) the Registrar accepts an IRDA; and
  - (b) no opposition to the IRDA is filed within the period allowed under paragraph 17A.29 (2) (b);
- the trade mark that is the subject of the IRDA becomes a protected international trade mark at the end of that period.
- (3) If:
- (a) the Registrar accepts an IRDA; and
  - (b) opposition to the IRDA is filed within the opposition period; and
  - (c) the result of the decision on the opposition is that the trade mark that is the subject of the IRDA should be protected in Australia; and
  - (d) no appeal from the decision on the opposition is made within the appeal period;
- then, subject to subregulation (4), the trade mark becomes a protected international trade mark, to the extent permitted by the decision on the opposition, at the end of the appeal period.
- (4) If:
- (a) the Registrar accepts an IRDA; and
  - (b) opposition to the IRDA is filed within the opposition period; and
  - (c) an appeal is made from the decision on the opposition within the appeal period, or any extension of that period; and
  - (d) the decision on the appeal is that the trade mark that is the subject of the IRDA should be protected in Australia;
- the trade mark becomes a protected international trade mark, to the extent permitted by the decision on the appeal, when that decision is made.
- (5) If, at the end of 18 months after the Registrar was notified of an IRDA, the International Bureau has not received:
- (a) a notification under subregulation 17A.16 (1), 17A.25 (2) or 17A.29 (3); or

(b) a notification of the possibility that oppositions may be filed after the 18-month period;  
 in respect of the IRDA, the trade mark that is the subject of the IRDA becomes a protected international trade mark at the end of the 18-month period.

(6) If:

- (a) within 18 months after the Registrar was notified of an IRDA, the International Bureau receives notification of the possibility that oppositions may be filed after the 18-month period; and
  - (b) opposition to the IRDA is filed within the opposition period; and
  - (c) the International Bureau does not receive notification under subregulation 17A.29 (3) within 7 months after the opposition period begins;
- the trade mark that is the subject of the IRDA becomes a protected international trade mark at the end of the 7-month period.

#### **17A.37 Notice that trade mark is a protected international trade mark**

(1) If a trade mark becomes a protected international trade mark, the Registrar must:

- (a) notify that fact in the *Official Journal*; and
- (b) record that fact in the Record of International Registrations.

(2) The notice and record must include particulars of the conditions (if any) and the limitations (if any) to which the protection is subject.

(3) As soon as practicable after receiving notice that a trade mark is a protected international trade mark, the holder must notify the Registrar, in writing, of the holder's address for service in Australia.

#### **17A.38 Disclaimer**

(1) The holder of an IRDA or a protected international trade mark may, by notice in writing given to the Registrar, disclaim any exclusive right to use, or authorise the use of, a specified part of the relevant trade mark.

(2) The disclaimer affects only the rights given under this Part to the holder when protection is extended to the trade mark.

(3) The Registrar must, on extending protection to the trade mark or on receiving notice of the disclaimer (whichever is later), record in the Record of International Registrations the particulars of the disclaimer.

(4) A disclaimer properly made cannot be revoked.

### **Division 4 Protected international trade marks — rights and protection**

#### **17A.39 Rights given to, and protection of, protected international trade marks**

(1) Subject to this Part, sections 20 to 26, Parts 12, 13 and 14 of the Act (except section 128), and regulations 3.2, 13.1, 13.2 and 13.3 apply in relation to a protected international trade mark.

(2) For that application, a reference in those sections, Parts or regulations:

- (a) to a registered trade mark or a trade mark that is registered is taken to be a reference to the protected international trade mark or a trade mark that is a protected international trade mark; and
- (b) to a registered owner of a trade mark is taken to be a reference to the holder of the protected international trade mark; and
- (c) to goods or services in respect of which a trade mark is registered is taken to be a reference to goods or services covered by the protected international trade mark; and
- (d) to the date of registration of a trade mark is taken to be a reference to the date of effect of the protection of the trade mark; and
- (e) to the Register is taken to be a reference to the Record of International Registrations.

*Note* See regulation 17A.4 for the meaning of *date of effect*.

- (3) Also for that application:
  - (a) the reference in paragraph 127 (b) to a defendant having applied under subsection 92 (3) for an order directing the Registrar to remove a trade mark from the Register is taken to be a reference to the defendant having applied under subregulation 17A.48 (2) for an order directing the Registrar to cease protection; and
  - (b) the reference in paragraph 129 (1) (b) to a trade mark alleged to be registered is taken to be a reference to a trade mark alleged to be a protected international trade mark; and
  - (c) the reference in regulation 13.1 to the particulars of registration of the registered trade mark is taken to be a reference to the particulars of the protected international trade mark recorded in the Record of International Registrations.

#### **17A.40 Circumstances in which action may not be brought**

If the international registration of a trade mark is renewed within 6 months after it has expired, an action may not be brought in respect of an act that:

- (a) infringed the trade mark; and
- (b) was done after the international registration had expired and before it was renewed.

*Note* Article 7 (4) of the Protocol provides for a 6-month period of grace for renewal of international registration.

### **Division 5 Protected international trade marks — amendment or cessation of protection**

#### **17A.41 Cancellation of international registration**

If the International Bureau cancels, in whole or in part, the international registration of a trade mark that is a protected international trade mark, the trade mark ceases to be a protected international trade mark, to the extent of the cancellation, when the international registration is cancelled.

#### **17A.42 Failure to renew international registration**

- (1) If the international registration of a trade mark that is a protected international trade mark is not renewed, the trade mark ceases to be a protected international trade mark when the international registration expires.
- (2) However, if:
  - (a) the international registration of a trade mark that is a protected international trade mark (*unrenewed protected international trade mark*) is not renewed; and
  - (b) within 6 months after the international registration expired, an application for the registration of a trade mark, or an IRDA, is made by a person other than the holder of the unrenewed protected international trade mark;
 the unrenewed protected international trade mark is taken to be a protected international trade mark for the purposes of the application or the IRDA.

#### **17A.43 Amendment or cessation of protection — contravention of condition**

A prescribed court may, on the application of an aggrieved person, order that:

- (a) the protection extended to a protected international trade mark cease; or
  - (b) an entry in the Record of International Registrations relating to the protected international trade mark be removed or amended;
- on the ground that a condition or limitation entered in the Record of International Registrations in relation to the protected international trade mark has been contravened.

#### **17A.44 Amendment or cessation of protection — loss of exclusive rights to use trade mark**

- (1) This regulation applies if section 24 or 25 of the Act, as applied by regulation 17A.39, (*applied section 24 or 25*) applies in relation to a particular protected international trade mark.
- (2) A prescribed court may, on the application of an aggrieved person, but subject to subregulation (3) and regulation 17A.46, order that:
  - (a) the protection extended to the protected international trade mark cease; or
  - (b) an entry in the Record of International Registrations relating to the protected international trade mark be removed or amended;
 having regard to the effect of applied section 24 or 25 (as the case requires) on the right of the holder of the protected international trade mark to use the trade mark, or any sign that is part of the trade mark, in relation to particular goods or services.
- (3) If applied section 24 or 25 applies in relation to the trade mark because the trade mark contains a sign that:
  - (a) has become generally accepted within the relevant trade as the sign that describes or is the name of an article, substance or service; or
  - (b) describes or is the name of:
    - (i) an article or substance that was formerly exploited under a patent; or
    - (ii) a service that was formerly provided as a patented process;
 the court may decide not to make an order under subregulation (2).



- (4) Instead, the court may allow the trade mark to continue to be protected in respect of:
- (a) the article or substance or other goods of the same description; or
  - (b) the service or other services of the same description;
- subject to any condition or limitation that the court imposes.

**17A.45 Amendment or cessation of protection — other specified grounds**

- (1) Subject to subregulation (2) and regulation 17A.46, a prescribed court may, on the application of an aggrieved person, order that:
- (a) the protection extended to a protected international trade mark cease; or
  - (b) an entry wrongly made or remaining in the Record of International Registrations be removed or amended; or
  - (c) a condition or limitation affecting the protection of a protected international trade mark be entered in the Record of International Registrations.
- (2) An application under this regulation may be made on any of the following grounds:
- (a) any of the grounds on which the extension of protection could have been opposed under regulation 17A.31;
  - (b) because of circumstances applying when the application under this regulation is filed, the use of the trade mark is likely to deceive or cause confusion for a reason other than one for which:
    - (i) the IRDA could have been rejected under section 43 or 44 of the Act (as applied by regulation 17A.28); or
    - (ii) the extension of protection could have been opposed under section 60 of the Act (as applied by regulation 17A.31);
  - (c) the following circumstances apply:
    - (i) the Registrar accepted the IRDA because he or she was satisfied, having regard to:
      - (A) the extent to which the trade mark was inherently adapted to distinguish the goods or services of the holder of the IRDA from the goods or services of any other person; and
      - (B) the intended use of the trade mark; that the trade mark would distinguish those goods or services as being those of the holder;
    - (ii) the application under this regulation is made at least 10 years after the IRDA was notified to the Registrar;
    - (iii) in the intervening period, the trade mark has not been used to an extent sufficient for it to distinguish the goods or services of the holder of the protected international trade mark from the goods or services of any other person;
  - (d) if the application is in respect of an entry in the Record of International Registrations, the entry was made, or has been amended, as a result of fraud, false suggestion or misrepresentation.

#### **17A.46 Amendment or cessation may not be granted if holder not at fault etc**

- (1) The court may decide not to grant an application made:
  - (a) under regulation 17A.44; or
  - (b) on the ground that the trade mark is liable to deceive or confuse (a ground referred to in paragraph 17A.45 (2) (a)); or
  - (c) on the ground referred to in paragraph 17A.45 (2) (c);
 if the holder of the protected international trade mark satisfies the court that the ground relied on by the applicant has not arisen through an act or fault of the holder.
- (2) In making a decision under subregulation (1), the court:
  - (a) must take into account the following matters, so far as they are relevant:
    - (i) the extent to which the public interest will be affected if protection of the protected international trade mark is not ceased;
    - (ii) whether any circumstances that gave rise to the application have ceased to exist;
    - (iii) the extent to which the trade mark distinguished the relevant goods and services before the circumstances giving rise to the application arose;
    - (iv) whether there is any order or other remedy, other than an order under regulation 17A.44 or 17A.45, that would be adequate in the circumstances; and
  - (b) may take into account any other matter that the court considers relevant.

#### **17A.47 Duties and powers of Registrar**

Section 90 of the Act applies, with the necessary modifications, for the purposes of an application under regulation 17A.43, 17A.44 or 17A.45.

*Note* Article 5 (6) of the Protocol requires the Registrar to notify the International Bureau of an invalidation of the effect of an international registration.

#### **17A.48 Cessation of protection for non-use**

- (1) A person aggrieved by the fact that a trade mark is, or may become, a protected international trade mark may, subject to subregulation (2), apply to the Registrar for the protection to cease.
- (2) An application may not be made under subregulation (1) if an action concerning the trade mark is pending in a prescribed court, but the person aggrieved may apply to the court for an order directing the Registrar to cease the protection.
- (3) Part 9 of the Act and Part 9 of these Regulations apply in relation to an application mentioned in subregulation (1) or (2).
- (4) For that application, a reference in those Parts:
  - (a) to a registered trade mark or a trade mark that is registered, or entered on the Register, is taken to be a reference to a protected international trade mark or a trade mark that is a protected international trade mark; and

- (b) to removing a trade mark from the Register is taken to be a reference to ceasing protection of a trade mark as a protected international trade mark; and
  - (c) to an application for registration of a trade mark is taken to be a reference to an international registration designating Australia; and
  - (d) to an applicant for registration of a trade mark is taken to be a reference to the holder of an international registration designating Australia; and
  - (e) to a registered owner of a trade mark is taken to be a reference to the holder of a protected international trade mark; and
  - (f) to an application under section 92 is taken to be a reference to an application under subregulation (1).
- (5) Also for that application, the reference in subregulation 9.4 (1) to regulations 5.7 to 5.17 is taken to be a reference to those regulations modified as necessary for the purposes of an opposition to an application under subregulation (1).
- (6) Despite subregulation (3), the Registrar is not required to take any action in response to a notice of opposition to an application under subregulation (1) unless the opponent has notified the Registrar, in writing, of the opponent's address for service in Australia.
- (7) If the result of an action mentioned in subregulation (1) or (2) is that the Registrar decides, or is directed by a court:
- (a) to cease protection of a protected international trade mark in respect of some or all of the goods or services covered by the protection; or
  - (b) that the trade mark should be protected subject to conditions or limitations;
- the Registrar must notify the International Bureau of that decision or order.

## Division 6      Collective and certification trade marks

### 17A.49 Collective trade marks

- (1) The provisions of this Part, of the Act as applied by this Part, and sections 164 to 167 of the Act, apply in relation to a collective trade mark that is the subject of an IRDA or that is a protected international trade mark.

*Note* See section 162 of the Act for the meaning of *collective trade mark*.

- (2) For that application:
- (a) a reference to a trade mark is taken to include a collective trade mark; and
  - (b) a reference to an application for the registration of a collective trade mark is taken to be a reference to an IRDA in respect of the collective trade mark; and
  - (c) a reference to an association in whose name a collective trade mark is registered is taken to be a reference to the association that is the holder of the relevant protected international collective trade mark; and
  - (d) despite subparagraph 17A.28 (2) (a) (ii), a reference in section 41 of the Act to the applicant is taken to be a reference to the members of the association that is the holder of the relevant IRDA; and
  - (e) the use of a collective trade mark by a member of the association that is the holder of the relevant IRDA or protected international collective trade mark is taken to be a use of the collective trade mark by the holder.
- (3) In this regulation:

*protected international collective trade mark* means a collective trade mark that is a protected international trade mark.

### 17A.50 Certification trade marks

- (1) Part 16 of the Act and Part 16 of these Regulations (except regulation 16.1) apply in relation to a certification trade mark that is the subject of an IRDA or that is a protected international trade mark.

*Note* See section 169 of the Act for the meaning of *certification trade mark*.

- (2) For that application, a reference in those Parts:
- (a) to an application for registration of a certification trade mark is taken to be a reference to an IRDA in respect of a certification trade mark; and
  - (b) to an applicant for registration of a certification trade mark is taken to be a reference to the holder of an IRDA in respect of a certification trade mark; and
  - (c) to a registered certification trade mark, or a certification trade mark that is registered, is taken to be a reference to a certification trade mark that is a protected international trade mark; and
  - (d) to the registered owner of a registered trade mark is taken to be a reference to the holder of a protected international trade mark that is a certification trade mark; and

- (e) to goods or services in respect of which a certification trade mark is registered is taken to be a reference to goods or services in respect of which a certification trade mark is protected.
- (3) Also for that application:
- (a) a reference in section 170 of the Act to another provision of the Act is taken to be a reference to that other provision as it is applied by this Part to a trade mark that is the subject of an IRDA or that is a protected international trade mark; and
  - (b) each reference in section 170 and 171 of the Act to a certification trade mark is taken to be a reference to a certification trade mark that is the subject of an IRDA or that is a protected international trade mark.
- (4) For subsection 173 (1) of the Act, the holder of an IRDA in respect of a certification trade mark must file a copy of the rules governing the use of the certification trade mark with the Registrar as soon as practicable after the Registrar is notified of the IRDA.
- (5) When the holder files a copy of the rules in accordance with subregulation (4), the holder must notify the Registrar, in writing, of the holder's address for service in Australia.

## **Division 7 Transformation of cancelled international registrations**

### **17A.51 Application of Division**

This Division applies if:

- (a) the international registration of a trade mark is cancelled, in whole or in part, by the International Bureau at the request of the Office of origin, in accordance with Article 6 (4) of the Protocol; and
- (b) the trade mark is the subject of an IRDA or is a protected international trade mark; and
- (c) within 3 months after the date on which the international registration was cancelled, the person who held the international registration files with the Trade Marks Office an application for registration of the trade mark (a *transformation application*); and
- (d) the transformation application is in relation to any of the goods and services to which the cancellation applies that were listed in the IRDA, or covered by the protected international trade mark, immediately before the cancellation.

### **17A.52 Transformation of IRDA**

- (1) If the trade mark is the subject of an IRDA, the Act and these Regulations apply for the purposes of the transformation application as if it were an application for registration.
- (2) However:
  - (a) the filing date for the transformation application is taken to be the date of international registration or the date of recordal, as applicable; and

- (b) anything already done under this Part for the purposes of the IRDA is to be treated as having been done for the purposes of the transformation application.

### **17A.53 Transformation of protected international trade mark**

- (1) If the trade mark is a protected international trade mark, the Registrar must register the trade mark.
- (2) The date of registration of the trade mark is taken to be:
  - (a) the date of international registration or the date of recordal, as applicable; or
  - (b) if the IRDA in respect of the trade mark included a priority claim, the priority date allowed under that claim.

### **Division 8 Concurrence between registration and international registration**

*Note* The Protocol makes provision for this as 'Replacement of a National or Regional Registration by an International Registration': see Article 4<sup>bis</sup>.

### **17A.54 Effect of registration and protection of the same trade mark**

- (1) This regulation applies if:
  - (a) a trade mark that is a registered trade mark becomes a protected international trade mark; and
  - (b) the registered owner of the trade mark is the holder of the protected international trade mark; and
  - (c) all the goods and services covered by the registered trade mark are covered by the protected international trade mark.
- (2) The date of effect of protection of the protected international trade mark in respect of all the goods and services covered by the registered trade mark is taken to be the date of registration of the registered trade mark.
- (3) The protected international trade mark has the priority date of the registered trade mark in respect of all the goods and services covered by the registered trade mark.
- (4) The holder of the protected international trade mark may file an application in the approved form for particulars of the international registration of the trade mark to be entered in the Register.
- (5) If the Registrar receives an application under subregulation (4), the Registrar must:
  - (a) enter the particulars in the Register; and
  - (b) notify the International Bureau in accordance with rule 21 of the Common Regulations.
- (6) This regulation does not affect the rights and protections conferred under the Act in respect of the registered trade mark.

### **17A.55 Effect of cancellation, removal or expiry of registered trade mark**

- (1) Subregulations 17A.54 (2) and (3) cease to apply if:
  - (a) the registration of the trade mark is cancelled (otherwise than at the request of the registered owner); or
  - (b) the trade mark is removed from the Register.
- (2) However, if the registration of the trade mark expires or is cancelled at the request of the registered owner, those subregulations continue to apply.

## **Division 9      Change in ownership of international registration**

### **17A.56 Application of Division**

This Division applies if the Registrar receives notification from the International Bureau of an assignment or transmission of the international registration of a trade mark that is the subject of an IRDA or is a protected international trade mark.

*Note* *Assignment* and *transmission* are defined in section 6 of the Act.

### **17A.57 Collective trade marks**

If the trade mark is a collective trade mark, the Registrar must make a declaration in accordance with rule 27 (4) of the Common Regulations that the assignment or transmission has no effect in Australia.

### **17A.58 Certification trade marks**

- (1) If the trade mark is a certification trade mark that is a protected international trade mark, the Registrar must make a declaration to the International Bureau in accordance with rule 27 (4) of the Common Regulations that, subject to subregulation (2), the assignment or transmission has no effect in Australia.
- (2) If the Registrar receives evidence in writing of the consent of the ACCC to the assignment or transmission, the Registrar must notify the International Bureau that the assignment or transmission may be given effect in Australia.

### **17A.59 Trade marks affected by claimed interests and rights**

- (1) If a person is recorded under regulation 17A.62 as claiming an interest in, or a right in respect of, the trade mark, the Registrar must:
  - (a) make a declaration to the International Bureau in accordance with rule 27 (4) of the Common Regulations that, subject to subregulation (2), the assignment or transmission has no effect in Australia; and
  - (b) give notice in writing to the person stating that the assignment or transmission will have effect at the end of 2 months from the date of the notice unless the person serves on the Registrar an order of a prescribed court directing the Registrar not to withdraw the declaration.
- (2) At the end of the 2-month period, if a court order has not been served on the Registrar as mentioned in paragraph (1) (b), the Registrar must notify the International Bureau that the assignment or transmission may be given effect in Australia.

### **17A.60 Recording assignment or transmission**

If the assignment or transmission has effect in Australia, the Registrar must record it in the Record of International Registrations.

*Note* If regulation 17A.57, 17A.58 or 17A.59 does not apply to the trade mark, the assignment or transmission of the international registration has effect in Australia in accordance with the Protocol.

## **Division 10 Recording of claimed interests and rights**

### **17A.61 Application to have claims recorded**

- (1) A person who claims an interest in, or a right in respect of, a trade mark that is the subject of an IRDA or is a protected international trade mark may apply to the Registrar to have particulars of the claim recorded by the Registrar.
- (2) The application must:
  - (a) be made jointly with the holder of the IRDA or protected international trade mark; and
  - (b) be made in an approved form; and
  - (c) be filed with the Trade Marks Office.

### **17A.62 Recording of claims**

If the application is made in accordance with regulation 17A.61, the Registrar must record in the Record of International Registrations particulars of the claim.

### **17A.63 Notification of matters affecting trade mark**

The Registrar must notify each person who has a claim recorded in respect of a trade mark of any matter affecting the trade mark that is notified to the Registrar by the International Bureau.

### **17A.64 Record not proof etc of existence of right etc**

The fact that a record has been made by the Registrar under this Division that a person claims an interest in, or a right in respect of, a trade mark is not proof or evidence that the person has the right or interest claimed.

### **17A.65 Amendment or cancellation of record**

- (1) Particulars recorded under this Division may be:
  - (a) amended in accordance with subregulations 11.1 (2) and (3); or
  - (b) cancelled in accordance with subregulations 11.3 (2), (3), (4) and (5).
- (2) Those subregulations apply for the purposes of this regulation as if a reference to the owner of the trade mark were a reference to the holder of the relevant IRDA or protected international trade mark.

## **Division 11 Miscellaneous**



**17A.66 Record of International Registrations**

- (1) The Registrar must maintain a Record of International Registrations for the purposes of this Part.
- (2) The Record of International Registrations must include the following particulars in respect of each IRDA notified to the Registrar by the International Bureau:
  - (a) the name of the holder;
  - (b) the address of the holder;
  - (c) the goods, services or goods and services in respect of which protection is sought;
  - (d) the claims of interest (if any) affecting the trade mark that is the subject of the IRDA;
  - (e) any other particulars that are required by the Act, these Regulations, the Protocol or the Common Regulations to be recorded in respect of the IRDA;
  - (f) any other particulars relating to the IRDA that the Registrar reasonably believes to be appropriate.
- (3) The Record of International Registrations must include the following particulars in respect of each protected international trade mark:
  - (a) the name of the holder;
  - (b) the address of the holder;
  - (c) the goods, services or goods and services in respect of which the trade mark is protected;
  - (d) the conditions (if any) and limitations (if any) subject to which the trade mark is protected;
  - (e) the claims of interest (if any) and disclaimers (if any) affecting the protected international trade mark;
  - (f) any other particulars that are required by the Act, these Regulations, the Protocol or the Common Regulations to be recorded in respect of the protected international trade mark;
  - (g) any other particulars relating to the protected international trade mark that the Registrar reasonably believes to be appropriate.

**17A.67 Inspection**

- (1) The Record of International Registrations must be available at the Trade Marks Office for inspection by any person during the hours when the Office is open for business.
- (2) Subregulation (1) is satisfied if a person who wants to inspect the Record of International Registrations is given access to a computer terminal from which he or she can read on a screen, or obtain a printed copy of, the particulars or other matters recorded in it.

**17A.68 Evidence — the Record of International Registrations**

- (1) The Record of International Registrations is evidence of any particular or other matter entered in it.
- (2) A copy of, or extract from, the Record of International Registrations that is certified by the Registrar to be a true record or extract is admissible in any proceedings as if it were the original.

*Note* Section 211 of the Act makes provision in relation to certificates given by the Registrar and certified copies of documents held in the Trade Marks Office.

**17A.69 Evidence — international instruments**

- (1) In any proceedings relating to a trade mark that is the subject of an IRDA or is a protected international trade mark, a copy of any of the following documents is admissible in evidence:
  - (a) the WIPO Gazette of International Marks published by the International Bureau;
  - (b) an entry in or extract from the International Register, issued by the International Bureau;
  - (c) any other instrument, or an entry in or extract from any other instrument, issued by the International Bureau.
- (2) In any such proceedings:
  - (a) an instrument that purports to have been issued by the International Bureau is taken to have been issued by the International Bureau unless the contrary is proved; and
  - (b) an instrument that purports to be the WIPO Gazette of International Marks published by the International Bureau is taken to be that Gazette unless the contrary is proved.
- (3) Also in any such proceedings, evidence of the Protocol or the Common Regulations may be adduced by producing a book or pamphlet containing the Protocol or the Common Regulations that purports to have been printed by authority of:
  - (a) the World Intellectual Property Organization; or
  - (b) another person or body that the court considers to be a reliable source of information.

**17A.70 Correction of errors or omissions in Record of International Registrations**

- (1) The Registrar may, on his or her own initiative, correct any error or omission in the Record of International Registrations.
- (2) A prescribed court may, on the application of an aggrieved person, order that the Registrar rectify the Record of International Registrations by:
  - (a) entering anything wrongly omitted from it; or
  - (b) correcting any error in it.

- (3) Section 90 of the Act applies, with the necessary modifications, for the purposes of an application under subregulation (2).

**17A.71 Passing off actions**

Subsection 230 (2) of the Act applies for the purposes of an action for passing off arising out of the use of a protected international trade mark in the same way as it applies for the purposes of an action for passing off arising out of the use of a registered trade mark.

**[13] Schedule 9, item 5**

*omit*

5.15 or 21.25:

*insert*

5.15, 17A.20, 17A.30 or 21.25 or regulation 5.15 as applied by regulation 17A.33:

**[14] Schedule 9, item 6**

*after*

of the Act

*insert*

or regulation 17A.29, or section 96 of the Act as applied by regulation 17A.48

**[15] Schedule 9, item 7**

*after*

paragraph 5.15 (1) (b)

*insert*

, or under that paragraph as applied by regulation 17A.33

**[16] Schedule 9, item 10**

*after*

of the Act

*insert*

, or for cessation of protection for non-use under subregulation 17A.48 (1)

**[17] Schedule 9, items 11 and 12***after*

or 9.4

*insert*

, or regulation 5.14 as applied by regulation 17A.33 or regulation 9.4 as applied by regulation 17A.48,

**[18] Schedule 9, after item 12***insert*

12A	Handling an application for the international registration of a trade mark under regulation 17A.7	\$100
12B	Transmitting renewal fee for the international registration of a trade mark under Article 7 of the Madrid Protocol	\$65

**[19] Schedule 9, item 16***after*

the Register

*insert*

or the Record of International Registrations

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**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, 343 and 346; 1999 Nos. 153, 186, 196 and 350.
  2. Notified in the *Commonwealth of Australia Gazette* on 1 March 2001.
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