



**Trade Marks Amendment Regulations 2001 (No. 3)**<sup>1</sup>

**Statutory Rules 2001 No. 247**<sup>2</sup>

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I, PETER JOHN HOLLINGWORTH, 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 13 September 2001

PETER HOLLINGWORTH  
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. 3)*.

**2 Commencement**

These Regulations commence as follows:

- (a) on the commencement of the *Trade Marks and Other Legislation Act 2001* — regulations 1 to 3 and Schedule 1;
- (b) on 1 January 2002 — Schedule 2.

*Note* The *Trade Marks and Other Legislation Act 2001* is to commence on 19 September 2001: see subsection 2 (1).

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

Schedules 1 and 2 amend the *Trade Marks Regulations 1995*.

**Schedule 1**      **Amendments commencing on commencement of the  
Trade Marks and Other Legislation Act 2001**  
(regulation 3)

[1]      **Regulation 2.1, after definition of *Madrid Protocol***

*insert*

*month*, for a period with a length expressed in months, has the meaning given by regulation 2.2.

[2]      **Regulation 2.1, definition of *working day***

*omit*

[3]      **After regulation 2.1**

*insert*

**2.2      Period expressed in months**

In these Regulations, a period expressed in months and dating from an event, ends:

- (a)      on the day, in the relevant subsequent month, which has the same number as the day of the event; or
- (b)      if the relevant subsequent month has no day with the same number — on the last day of the month.

*Note*      This provision displaces section 36 of the *Acts Interpretation Act 1901*, and is in accordance with the Madrid Protocol. The difference between the two occurs when the initiating event is on the last day of a calendar month, which has fewer days than the month in which the period ends. For example, a period of 3 months from an event on 30 September ends on 30 December under this rule; it would end on 31 December under the *Acts Interpretation Act 1901* provision.

[4]      **Paragraph 5.10 (2) (a)**

*omit*

beginning on

*insert*

from

[5]      **Part 7, after the Part heading**

*insert*

**Division 1      Initial registration**

**[6] After regulation 7.2***insert***Division 2 Renewal of registration (general)****[7] After regulation 7.5***insert***Division 3 Renewal of registration (registration delayed for 10 or more years after filing date)****7.6 Prescribed period (Act s 80A (3))**

For subsection 80A (3) of the Act, the prescribed period is 2 months.

*Note* Paragraph 80A (3) (b) of the Act provides that the prescribed period commences on the Register entry day.

**7.7 Notice about renewal (Act s 80C)**

For section 80C of the Act (which deals with renewal of registration, where registration has been delayed for 10 or more years after the filing date of the application for registration) the Registrar's notice to the registered owner of the trade mark must state:

- (a) the date on which the prescribed period expires; and
- (b) the fee payable by the registered owner.

**7.8 Notice of renewal (Act s 80E)**

For section 80E of the Act (which deals with renewal within the prescribed period), a notice of the renewal of the registration of a trade mark must:

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

**[8] Paragraph 10.1 (b)***omit*

or transmission of a registered

*insert*

of a

[9] **Regulation 13.1**

*substitute*

**13.1 Notice of objection to importation ( accompanying documents**

For the purposes of subsection 132 (2) 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 document setting out the particulars of registration of the registered trade mark.

[10] **After regulation 16.10**

*insert*

**16.10A Assignment of unregistered certification trade marks**

(1) An application to the Commission for its consent to the assignment of an unregistered certification trade mark must:

- (a) be made by the applicant for registration 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, after assignment, to apply the same rules governing use of the certification trade mark that the applicant for registration applies, or proposes to apply; and
- (d) if the prospective assignee does not propose 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 or services specified in the application for registration of the certification trade mark;
- (b) if the prospective assignee does not propose, after the assignment, to apply the same rules governing use of the certification trade mark as the applicant for registration of the trade mark applies, or proposes to apply — 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.

[11] **Regulation 17A.2, before definition of *Common Regulations***

*insert*

*change of ownership* includes assignment or transmission.

[12] **After subregulation 17A.30 (2)**

insert

- (3) Subsection 52 (5) of the Act applies to an application for extension of time under subregulation (1).

**[13] Subregulation 17A.42 (2)**

*substitute*

- (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) an application for the registration of the trade mark, or an IRDA, is made, or has already been 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, at any time when the registration of the unrenewed protected international trade mark could have been renewed under Article 7 of the Protocol.

**[14] Paragraph 17A.45 (2) (c)**

*omit*

**[15] Paragraph 17A.48 (4) (f)**

*omit*

subregulation (1).

*insert*

subregulation (1); and

**[16] After paragraph 17A.48 (4) (f)**

insert

- (g) to the day on which the application for registration of the trade mark was filed, or the filing date in respect of the application for registration of the trade mark, is taken to be a reference to:
- (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.

*Note* The expressions *date of international registration* and *date of recordal* are defined in regulation 17A.2.

**[17] Paragraph 17A.50 (2) (e)***omit*

protected.

*insert*

protected; and

**[18] After paragraph 17A.50 (2) (e)***insert*

(f) to assignment of a certification trade mark is taken to be a reference to change of ownership of a certification trade mark.

**[19] Paragraph 17A.50 (3) (b)***omit*

mark.

*insert*

mark; and

**[20] After paragraph 17A.50 (3) (b)***insert*

(c) each reference in Part 16 of these Regulations to the prospective assignee is taken to be a reference to the new holder of the international registration in respect of Australia who is identified in the notification to the Registrar under Rule 27 (1) of the Common Regulations.

**[21] Regulation 17A.56***omit*

an assignment or transmission

*insert*

a change of ownership

[22] **Regulation 17A.56, note**

*substitute*

*Note* **Change of ownership** is defined in regulation 17A.2 to include assignment or transmission.

[23] **Regulation 17A.58, heading**

*substitute*

**17A.58 Protected certification trade marks**

[24] **After regulation 17A.58**

insert

**17A.58A Unprotected certification trade marks**

- (1) If the trade mark is a certification trade mark that is the subject of an IRDA, and:
  - (a) a copy of the IRDA and the rules governing the use of the certification trade mark has been received by the ACCC; and
  - (b) the trade mark has not become 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 change of ownership has no effect in Australia.
- (2) If the Registrar receives evidence in writing of the consent of the ACCC to the change of ownership, the Registrar must notify the International Bureau that the change of ownership may be given effect in Australia.

[25] **Paragraph 21.13 (3) (b)**

*after*

case

*insert*

of

[26] **After subregulation 21.21 (4)**

insert

- (5) If a person asks the Registrar, under section 80D of the Act, to renew the registration of a trade mark for one or more potential renewal periods, the fee payable is the sum of the fees payable for the potential renewal period or periods requested by the person, as those fees were at the Register entry day.
- (6) Subregulation (7) applies if a person asks the Registrar, under paragraph 80G (1) (b) of the Act (which deals with renewal within 10 months after the end of the prescribed period) to renew the registration of a trade mark for one or more potential renewal periods.



- (7) The fee payable for the renewal is:
- (a) the sum of the fees payable for the potential renewal period or periods requested by the person, as those fees were at the Register entry day; and
  - (b) the additional fee stated in item 9A of Schedule 9 for the period:
    - (i) beginning on the day after the day when the prescribed period expires; and
    - (ii) ending on the day when the request for renewal is filed.

**[27] Paragraph 21.28 (1) (k)**

*omit*

section 79

*insert*

sections 79, 80D or 80G

**[28] Schedule 9, after item 9**

*insert*

- 9A Each potential renewal period requested by a person under section 80D 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) where the request for renewal is made within 10 months after the end of the prescribed period, under paragraph 80G (1) (b) of the Act in addition to any fee in relation to paragraph (a) or (b), but regardless of the number of potential renewal periods requested — \$65 for each class and for each month, or part of a month, after the end of the prescribed period

**[29] Further amendments — change of ownership**

The following provisions are amended by omitting each mention of ‘assignment or transmission’ and inserting ‘change of ownership’:

- regulation 17A.57
- subregulations 17A.58 (1) and (2)
- paragraphs 17A.59 (1) (a) and (b)
- subregulation 17A.59 (2)
- regulation 17A.60, heading and note.

**Schedule 2**            **Amendment commencing on 1 January 2002**  
(regulation 3)

**[1] Schedule 1, Part 2, item 42**

*substitute*

- 42        Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services
- 43        Services for providing food and drink; temporary accommodation
- 44        Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services
- 45        Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals

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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; 2001 Nos. 33 and 185.
  - 2.        Notified in the *Commonwealth of Australia Gazette* on 14 September 2001.
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