



Intellectual Property Legislation (Fees) Amendment Regulations 2002 (No. 1)¹

Statutory Rules 2002 No. 173²

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 *Designs Act 1906*, the *Patents Act 1990* and the *Trade Marks Act 1995*.

Dated 4 July 2002

PETER HOLLINGWORTH
Governor-General

By His Excellency's Command

IAN MACFARLANE
Minister for Industry, Tourism and Resources

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-

1 Name of Regulations

These Regulations are the *Intellectual Property Legislation (Fees) Amendment Regulations 2002 No. 1*.

2 Commencement

These Regulations commence as follows:

- (a) on gazettal — regulations 1 to 5 and Schedules 1, 2 and 3;
- (b) on 1 September 2002 — Schedules 4, 5 and 6.

3 Amendment of *Designs Regulations 1982*

Schedules 1 and 4 amend the *Designs Regulations 1982*.

4 Amendment of *Patents Regulations 1991*

Schedules 2 and 5 amend the *Patents Regulations 1991*.

5 Amendment of *Trade Marks Regulations 1995*

Schedules 3 and 6 amend the *Trade Marks Regulations 1995*.

Schedule 1 Amendments of *Designs Regulations 1982* commencing on gazettal (regulation 3)**[1] Schedule 2A**

after

Namibia

insert

Nepal

[2] Schedule 2A

after

Togo

insert

Tonga

**Schedule 2 Amendments of *Patents Regulations 1991* commencing on gazettal
(regulation 4)**

[1] Schedule 4

after

Namibia

insert

Nepal

[2] Schedule 4

after

Togo

insert

Tonga

**Schedule 3 Amendments of *Trade Marks Regulations 1995* commencing on gazettal
(regulation 5)**

[1] Schedule 10

after

Namibia

insert

Nepal

[2] Schedule 10

after

Togo

insert

Tonga

Schedule 4 Amendments of *Designs Regulations 1982* commencing on 1 September 2002
(regulation 3)

[1] Subregulation 4 (1)

substitute

(1) The fee specified in an item of Schedule 2 is prescribed for the matter mentioned in the item.

[2] Schedule 2

substitute

Schedule 2 Fees
(regulation 4)

Item	Matter	Fee
1	Lodging an application for the registration of a design	\$90
2	Lodging a request for expedited consideration of an application for the registration of a design	\$90
3	Lodging an application under subsection 27B (2) of the Act for an extension of time on the ground specified in paragraph 27B (2) (a) of the Act	\$100 for each month or part of a month for which the extension is sought
4	Lodging an application under subsection 27B (2) of the Act for an extension of time on the ground specified in paragraph 27B (2) (b) of the Act	\$100
5	Lodging a request for an extension of the period of registration:	
	(a) under subsection 27A (2) of the Act (the first extension)	\$55
	(b) under subsection 27A (12) of the Act (the second extension)	\$90
	(c) under subsection 27A (13) of the Act (the third extension)	\$135
6	Lodging a notice of opposition under subregulation 27 (1) or 29A (1)	\$550
7	Lodging an application under subregulation 29 (2) or 29AA (2) for the grant of a licence	\$65
8	Lodging a request for the exercise of the Registrar's discretionary powers	\$500
9	Lodging a request for a hearing	\$500
10	Appearing at a hearing	\$500 for each day or part of a day, less any amount paid under item 8 or 9 in relation to the hearing
11	Supply of a certificate by the Registrar	\$25
12	Supply of a duplicate certificate of registration by the Registrar	\$250
13	Supply, by the Registrar, of a copy of:	\$25

Item	Matter	Fee
	(a) an extract from the register; or (b) another document	

Schedule 5 Amendments of *Patents Regulations 1991* commencing on 1 September 2002
(regulation 4)

[1] Paragraph 9A.2A (2) (c)

omit

4B of Part 2

insert

208

[2] Paragraph 13.3 (1A) (b)

omit

column 3 of item 7 of Part 2

insert

item 211

[3] Paragraph 13.3 (3) (b)

omit

column 2 of item 7 of Part 2

insert

item 211

[4] Paragraph 13.6 (2A) (a)

omit

column 3 of item 7 of Part 2

insert

item 211

[5] Paragraph 13.6 (2A) (b)

omit

column 3 of item 7A of Part 2

insert

item 212

[6] Paragraph 13.6 (6) (a)

omit

column 2 of item 7 of Part 2

insert

item 211

[7] Paragraph 13.6 (6) (b)

omit

column 2 of item 7A of Part 2

insert

item 212

[8] Paragraph 20.4 (g)

omit

4 of Part 1

insert

104

[9] Subparagraph 20.19 (a) (ii)

omit

7 of Part 1

insert

107

[10] Subparagraph 20.19A (1) (b) (ii)

omit

7 of Part 1

insert

107

[11] Subregulation 22.2 (1)

omit

column 2 of

[12] Subregulation 22.2 (1)

omit

column 3 of

[13] Paragraphs 22.2 (2) (b) and (c)

substitute

- (b) the fee for appearing at a hearing is payable:
 - (i) for the first day — immediately before the hearing; and
 - (ii) for each day or part of a day after the first day — immediately after the hearing;
- (c) the fee for making a representation mentioned in item 219 or 220 of Schedule 7 is payable when the representation is made;
- (d) the fee for acceptance of a patent request and complete specification, under section 49 of the Act, is payable when the application is accepted.

[14] Subparagraph 22.2 (4) (a) (i)

omit

fees specified in item 3 of Part 2 of Schedule 7 are

insert

fee specified in item 203 of Schedule 7 is

[15] Subparagraph 22.2 (4) (a) (ii)

omit

item 1 of Part 3,

insert

item 301,

[16] Paragraph 22.2 (4) (b)

omit

fees specified in item 3 of Part 2 of Schedule 7 are

insert

fee specified in item 203 of Schedule 7 is

[17] After subregulation 22.2 (4)

insert

(5) The fees specified in item 213 of Schedule 7 do not apply to:

- (a) an application for a standard patent filed before the commencement of this subregulation; or
- (b) a PCT application that meets the requirements of subsection 89 (3) of the Act before the commencement of this subregulation.

[18] Paragraph 22.2B (1) (a)

omit

item 1, 2 or 3 of Part 2

insert

item 201, 202 or 203

[19] Paragraph 22.2C (1) (a)

substitute

- (a) a fee mentioned in item 204, 205 or 206, paragraph (a) of item 208, or item 209, 210, 214, 215, 216, 217, 218, 219, 220, 222, 224, 225, 226, 227, 228, 236, 237 or 238 of Schedule 7 is not paid when it is payable; and

[20] Paragraph 22.2D (1) (a)

omit

item 4A of Part 2

insert

item 207

[21] Paragraph 22.2D (3) (a)

omit

item 4B of Part 2

insert

item 208

[22] Paragraph 22.2E (1) (a)

omit

item 22 of Part 2

insert

item 232

[23] Subregulation 22.2F (1)

omit

This regulation

insert

Subregulation (2)

[24] Subregulation 22.2F (3)

substitute

(3) Subregulation (4) applies if:

(a) a fee mentioned in regulation 22.2I is not paid when it is payable; and

(b) the Commissioner does not give the invitation mentioned in regulation 22.2I within the time allowed.

(4) The accepted application is to be treated as if the fee for acceptance mentioned in item 213 of Schedule 7 had been paid immediately after its acceptance.

- (5) Despite subregulations (2) and (4), the fee remains payable and can be recovered as a debt due to the Commonwealth.

[25] Paragraph 22.2G (1) (a)

omit

paragraph (b) of item 20 of Part 2

insert

item 230

[26] Subregulation 22.2G (3)

omit

paragraph (b) of item 20 of Part 2

insert

item 230

[27] Subregulation 22.2G (4)

omit

item 21 of Part 2

insert

paragraph (a) of item 231

[28] Subregulation 22.2H (1)

substitute

- (1) This regulation applies to a fee mentioned in item 221, 223, 229, 233, 234 or 235 of Schedule 7.

[29] Subregulation 22.2H (3)

omit

paragraph (b) of item 15 of Part 2

insert

item 223

[30] After regulation 22.2H

insert

22.2I Failure to pay: acceptance fee

- (1) This regulation applies if:
 - (a) a fee for acceptance mentioned in item 213 of Schedule 7 is not paid when it is payable; and
 - (b) within 1 month after the fee is payable, the Commissioner invites the person by whom the fee is payable to pay the fee within 3 months after the date that the notice of the acceptance is published under paragraph 49 (5) (b) of the Act; and
 - (c) the fee is not paid within the 3 month period.
- (2) The application lapses.

[31] Subregulation 22.3 (1)

omit

column 2 of

[32] Subregulation 22.3 (1)

omit

column 3 of

[33] Subregulation 22.3 (2)

omit

items 1 and 2 of Part 3

insert

items 301 and 302

[34] Subregulation 22.3 (3)

omit

item 4 of Part 3

insert

item 304

[35] Schedule 7, Parts 1, 2 and 3

*substitute***Part 1 Patent Attorneys**

Item	Matter	Fee (\$)
101	Applying for admission to sit for an examination conducted by the Board	400
102	Applying for grant of a supplementary examination conducted by the Board	200
103	Applying for a report of reasons for failure of an examination conducted by the Board	200
104	Applying for registration as a patent attorney	200
105	Annual registration of a patent attorney	350
106	Annual registration fee payable for combined registration as a patent attorney and trade marks attorney	450
107	Applying under regulation 20.19 or 20.19A	160

Part 2 General fees

Item	Matter	Fee
201	Filing a request for a patent accompanied by a provisional specification	\$80
202	Filing a request for an innovation patent accompanied by a complete specification:	
	(a) by an electronic means approved by the Commissioner for this paragraph	\$150
	(b) by another means	\$180
203	Filing a request for a standard patent accompanied by a complete specification:	
	(a) by an electronic means approved by the Commissioner for this paragraph	\$290
	(b) by another means	\$320
204	Filing a request for an examination, under section 45 of the Act, of a standard patent request and complete specification for a PCT application if the Patent Office has issued an international preliminary examination report in respect of the application	\$240
205	Filing a request for an examination, under section 45 of the Act, of a standard patent request and complete specification if item 204 does not apply	\$340
206	Filing a request for a modified examination, under section 48 of the Act, of a standard patent request and complete specification	\$240
207	Filing a request under paragraph 101A (b) of the Act, by the patentee of an innovation patent, for examination of the complete specification relating to the innovation patent	\$290
208	Filing a request under paragraph 101A (b) of the Act, by a person other than the patentee of an innovation patent, for examination of the complete specification relating to the innovation patent:	
	(a) payable by the person making the request; and	\$145

Item	Matter	Fee
	(b) payable by the patentee	\$145
209	Filing a request under subsection 44 (3) of the Act requiring the Commissioner to direct an applicant to request examination	\$100
210	Filing a request under subsection 97 (2) or paragraph 101G (1) (b) of the Act for re-examination of a complete specification	\$1 300
211	Continuation fee under paragraph 142 (2) (d) of the Act, or renewal fee under paragraph 143 (a) of the Act for:	
	(a) the fifth anniversary	\$180
	(b) the sixth anniversary	\$200
	(c) the seventh anniversary	\$250
	(d) the eighth anniversary	\$300
	(e) the ninth anniversary	\$350
	(f) the tenth anniversary	\$400
	(g) the eleventh anniversary	\$450
	(h) the twelfth anniversary	\$500
	(i) the thirteenth anniversary	\$550
	(j) the fourteenth anniversary	\$600
	(k) the fifteenth anniversary	\$650
	(l) the sixteenth anniversary	\$700
	(m) the seventeenth anniversary	\$800
	(n) the eighteenth anniversary	\$900
	(o) the nineteenth anniversary	\$1 000
	(p) if an extension of the term of a standard patent is granted under section 76 of the Act:	
	(i) the twentieth anniversary	\$1 200
	(ii) each subsequent anniversary during the period of extension	\$1 200
	and, in addition, if the fee is not paid on or before the anniversary but is paid within 6 months after the anniversary	\$100 for each month, or part of a month, in the period between the anniversary and the day when the fee is paid
212	Renewal fee under paragraph 143A (d) of the Act for:	
	(a) the second anniversary	\$100
	(b) the third anniversary	\$100
	(c) the fourth anniversary	\$100
	(d) the fifth anniversary	\$165
	(e) the sixth anniversary	\$200
	(f) the seventh anniversary	\$235
	and, in addition, if the fee is not paid on or before the anniversary, but is paid within 6 months after the anniversary	\$100 for each month, or part of a month, in the period between the anniversary and the day when the fee is paid

Item	Matter	Fee
213	Acceptance of a patent request and complete specification under section 49 of the Act:	
	(a) for acceptance; and	\$140
	(b) if more than 20 claims are contained in the specification at acceptance	\$20 for each claim in excess of 20
214	Filing an application or request under section 17, 32 or 36 of the Act	\$550
215	Filing a request under subregulation 3.25 (1) for the certification referred to in Rule 11.3 (a) of the Budapest Treaty	\$550
216	Filing a notice of opposition under regulation 5.3 or 5.3AA	\$550
217	Filing a request under subregulation 5.5 (1) for dismissal of opposition	\$550
218	Filing an application under subregulation 5.10 (2) for an extension of time	\$150 for each month or part of a month for which the extension is sought
219	Making a representation to the Commissioner, under regulation 5.3A or 5.3B or subregulation 5.9 (3), objecting to a proposed amendment	\$500
220	Making a representation to the Commissioner under subparagraph 5.10 (5) (c) (i) objecting to an application or proposed action	\$500
221	Filing an application under section 66 of the Act for a duplicate of a patent to be sealed	\$250
222	Filing a request for leave to amend a complete specification relating to an application for a standard patent before a request for examination is filed or after the complete specification is accepted	\$200
223	Filing a request for leave to amend a patent request for an innovation patent to make it a patent request for a standard patent	\$140
224	Filing a request for leave to amend an innovation patent:	\$200
	(a) after the patent is granted but before a request for examination is filed; or	
	(b) after the patent is certified	
225	Filing a request under subsection 150 (1) of the Act to restore a lapsed application	\$100
226	Filing an application for an extension of time under subsection 223 (2) of the Act on a ground specified in paragraph 223 (2) (a) of the Act	\$100 for each month or part of a month for which the extension is sought
227	Filing an application under subsection 223 (2) of the Act for an extension of time on the ground specified in paragraph 223 (2) (b) of the Act	\$100
228	Filing an application for an extension of time under subsection 223 (2A) of the Act	\$100 for each month or part of a month for which the extension is sought
229	Filing a request under regulation 22.22 for the exercise of discretionary power	\$500
230	Filing a request for a hearing	\$500
231	Appearing at a hearing:	

Item	Matter	Fee
	(a) for the first day	\$500 less any amount paid under item 219, 220, 229 or 230 in relation to the hearing
	(b) if the hearing runs for more than a day	\$500 for each day or part of a day after the first day
232	Filing a response to the Commissioner's report under section 45 or 48 of the Act, if filed more than 12 months, but within 21 months, after the date of the first report on the examination	\$100 for each month or part of a month, after the 12 months (other than a month in respect of which a fee was paid under this item in relation to the examination)
233	Requesting the supply of a copy of a patent specification	\$25
234	Requesting the supply of a copy of a document other than a patent specification:	
	(a) for more than 6 documents from a single source and supplied at the same time	\$150 plus 30 cents per page for each document in excess of 6 documents
	(b) otherwise	\$25 per document
235	Requesting the supply of a certificate by the Commissioner	\$25
236	Filing a request under subregulation 19.2 (2) for information that requires an international-type search	\$1 000
237	Filing a substitute page or pages in compliance with a direction under subregulation 3.2A (2), if filed more than 3 months after the day when the direction was given but before the application becomes open to public inspection	\$200
238	Filing an application under subsection 70 (1) of the Act for the grant of an extension of the term of a standard patent	\$1 000

Part 3 General fees for international applications

Item	Matter	Fee
301	Transmittal fee under Rule 14 of the PCT	\$100
302	Search fee under Rule 16 of the PCT	\$1 000
303	Additional fee for search under Article 17 (3) (a) of the PCT	\$1 000
304	Preliminary examination fee under Rule 58 of the PCT	
	(a) if the international search report was issued by the Patent Office in respect of the international application	\$550
	(b) in other cases	\$1 000
305	Additional fee for international preliminary examination under Article 34 (3) (a) of the PCT	\$550
306	For a copy of a document in accordance with Rule 44.3 (b) or 71.2 (b)	\$25

Item	Matter	Fee
307	of the PCT Confirmation fee under Rule 15.5 (a) of the PCT	50% of the sum of the designation fees payable under item 3 of Part 4 in this Schedule for the relevant international application
308	Late payment fee under Rule 16 ^{bis} .2 of the PCT	the greater of: (a) 50% of the amount of the unpaid fees specified in the invitation; and (b) the amount of the transmittal fee; but not more than the amount of the basic fee

Schedule 6 Amendments of Trade Marks Regulations 1995 commencing on 1 September 2002 (regulation 5)

[1] Paragraph 20.3 (d)

omit

22

insert

28

[2] Subregulation 20.7 (1)

omit

23 or 24

insert

29 or 30

[3] Paragraph 20.8 (a)

omit

25

insert

31

[4] Subparagraph 20.9 (1) (b) (ii)

omit

25

insert

31

[5] Subregulation 21.21 (1)

omit

column 3 of

[6] Subregulation 21.21 (1)

omit

column 2 of

[7] Paragraph 21.21 (4) (b)

omit

item 9

insert

item 10

[8] Paragraph 21.21 (7) (b)*omit*

9A

insert

12

[9] Schedule 9*substitute***Schedule 9 Fees**
(regulation 21.21)

Item	Matter	Fee
1	Filing an application to register a trade mark under subsection 27 (5) of the Act in respect of goods or services in 1 or more of the prescribed classes:	
	(a) by an electronic means approved by the Registrar for this paragraph	\$120 for each class
	(b) by another means	\$150 for each class
2	Filing a divisional application under subsection 45 (1) of the Act:	
	(a) by an electronic means approved by the Registrar for this paragraph	\$120 for each class
	(b) by another means	\$150 for each class
3	Filing an application to register 2 or more trade marks as a series under section 51 of the Act:	
	(a) by an electronic means approved by the Registrar for this paragraph	\$170
	(b) by another means	\$200
4	Requesting an amendment under section 64 or 65 of the Act to include an additional prescribed class of goods or services in an application	\$150 for each class
5	Filing an application for an extension of:	\$100 for each month or part of a month for which the extension is sought
	(a) a period under subregulation 4.12 (3) or regulation 17A.20; or	
	(b) time under regulation 21.25	
6	Filing an application for an extension of:	\$150 for each month or part of a month for which the extension is sought
	(a) a period under regulation 5.15 (including regulation 5.15 as applied by regulation 17A.33); or	
	(b) time under regulation 5.2 or 17A.30	
7	Filing a notice of opposition under:	\$250
	(a) section 52 of the Act; or	
	(b) section 96 of the Act (including section 96 as applied by regulation 17A.48); or	

Item	Matter	Fee
	(c) subsection 224 (6) of the Act; or (d) regulation 17A.29	
8	Filing an application for permission to serve a copy of further evidence in opposition proceedings under paragraph 5.15 (1) (b) (including paragraph 5.15 (1) (b) as applied by regulation 17A.33)	\$100
9	Single registration of a trade mark under section 68 of the Act in respect of goods or services:	
	(a) in a single prescribed class	\$300
	(b) in more than 1 prescribed class	\$300 for each class
10	Renewal of a single registration of a trade mark under section 75 of the Act in respect of goods or services:	
	(a) in a single prescribed class	\$300
	(b) in more than 1 prescribed class	\$300 for each class
	and, in addition, if a request is made within 12 months after the expiry date to which section 79 of the Act refers	\$100 for each class for each month, or part of a month, after the expiry date
11	Each potential renewal period requested by a person under section 80D of the Act in respect of goods or services:	
	(a) in a single prescribed class	\$300
	(b) in more than 1 prescribed class	\$300 for each class
12	Each potential renewal period requested by a person under paragraph 80G (1) (b) of the Act in respect of goods and services:	
	(a) in a single prescribed class	\$300
	(b) in more than 1 prescribed class	\$300 for each class
	and, in addition, if the request for renewal is made within 10 months after the end of the prescribed period, regardless of the number of potential renewal periods requested	\$100 for each class for each month, or part of a month, after the end of the prescribed period
13	Filing an application for removal of a trade mark from the Register:	\$150
	(a) for non-use under section 92 of the Act; or (b) for cessation of protection for non-use under subregulation 17A.48 (1)	
14	Request for a hearing under:	\$500
	(a) regulation 5.14 (including regulation 5.14 as applied by regulation 17A.33); or (b) regulation 9.4, (including regulation 9.4 as applied by regulation 17A.48)	
15	Request for a hearing in relation to any other matter	\$300
16	Attendance at a hearing under:	\$500 for each day, or part of a day, less any amount paid under item 14 in relation to the hearing
	(a) regulation 5.14 (including regulation 5.14 as applied by regulation 17A.33); or (b) regulation 9.4 (including regulation 9.4 as applied by regulation 17A.48)	

Item	Matter	Fee
17	Attendance at a hearing in relation to any other matter	\$300 less any amount paid under item 15 in relation to the hearing
18	Handling an application for the international registration of a trade mark under regulation 17A.7	\$100
19	Transmitting a renewal fee for the international registration of a trade mark under Article 7 of the Madrid Protocol	\$100
20	Requesting a decision under subregulation 21.16 (2)	\$300
21	Supply of a certificate signed by the Registrar under section 211 of the Act	\$25
22	Supply of a copy of an extract from the Register or the Record of International Registrations or another document	\$25
23	Supply of a copy of a document for which a search is required	\$100
24	Filing an application for linked applications to be considered as a single application under subsection 243 (3) of the Act	\$100
25	Applying for admission to sit for an examination conducted by the Board	\$400
26	Applying for a grant of a supplementary examination conducted by the Board	\$200
27	A report of reasons for failure of an examination conducted by the Board	\$200
28	Applying for registration as a trade marks attorney	\$150
29	Annual registration of a trade marks attorney	\$250
30	Annual registration fee payable for combined registration as a trade marks attorney and patent attorney	\$450
31	Applying under regulation 20.8 or 20.9	\$160

Notes

- These Regulations amend (in Schedules 1 and 4) Statutory Rules 1982 No. 72, as amended by 1984 No. 256; 1986 No. 263; 1988 No. 103; 1989 Nos. 95 and 313; 1990 Nos. 29, 239 and 240; 1991 Nos. 65 and 455; 1992 Nos. 149, 445 and 452; 1993 Nos. 114 and 342; 1994 Nos. 180 and 315; 1995 Nos. 19 and 426; 1996 No. 270; 1997 No. 344; 1998 Nos. 259, 344 and 347; 1999 Nos. 187 and 348; 2001 No. 97.

These Regulations also amend (in Schedules 2 and 5) Statutory Rules 1991 No. 71, as amended by 1991 No. 456; 1992 No. 148; 1993 Nos. 113, 227, 340 and 341; 1994 Nos. 182, 317 and 387; 1995 Nos. 16, 20, 82 and 427; 1996 No. 271; 1997 Nos. 192 and 345; 1998 Nos. 45, 56, 141, 241, 257, 264, 291, 319, 342 and 345; 1999 Nos. 154, 184, 261 and 349; 2000 No. 317; 2001 Nos. 98, 184 and 345; 2002 Nos. 59 and 100.

These Regulations also amend (in Schedules 3 and 6) 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, 185 and 247.
- Notified in the *Commonwealth of Australia Gazette* on 11 July 2002.