



INTELLECTUAL PROPERTY LEGISLATION AMENDMENT REGULATIONS 2007 (NO. 1)¹

Select Legislative Instrument 2007 No. 40

I, PHILIP MICHAEL JEFFERY, Governor-General of the Commonwealth of Australia, acting with the advice of the Federal Executive Council, make the following Regulations under the *Designs Act 2003*, the *Olympic Insignia Protection Act 1987*, the *Patents Act 1990*, the *Plant Breeder's Rights Act 1994* and the *Trade Marks Act 1995*.

Dated 22 March 2007

P. M. JEFFERY
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 Amendment Regulations 2007 (No. 1)*.

2 Commencement

These Regulations commence as follows:

- (a) on 27 March 2007 — regulations 1 to 10 and Schedules 1, 2, 3, 5 and 6;
- (b) on 1 April 2007 — Schedules 4 and 8;
- (c) on the commencement of Part 2 of Schedule 1 to the *Trade Marks Amendment Act 2006* — Schedule 7.

3 Amendment of *Designs Regulations 2004*

Schedule 1 amends the *Designs Regulations 2004*.

4 Amendment of *Olympic Insignia Protection Regulations 1993*

Schedule 2 amends the *Olympic Insignia Protection Regulations 1993*.

5 Amendment of *Patents Regulations 1991*

Schedules 3 and 4 amend the *Patents Regulations 1991*.

6 Amendment of *Plant Breeder's Rights Regulations 1994*

Schedule 5 amends the *Plant Breeder's Rights Regulations 1994*.

7 Amendment of *Trade Marks Regulations 1995*

Schedules 6, 7 and 8 amend the *Trade Marks Regulations 1995*.

8 Transitional provisions for Schedule 4 — amendments of *Patents Regulations 1991* commencing on 1 April 2007

- (1) Subject to subregulation (2), the amendments made by Schedule 4 apply to an international application whose filing date is on or after 1 April 2007.
- (2) An amendment made by an item of Schedule 4 mentioned in an item in table 1, to a provision of the Rules mentioned in that table, does not apply to an international application in respect of which 1 or more elements referred to in Article 11 (1) (iii) were first received by the receiving Office before 1 April 2007.

Table 1

Item	Item of Schedule 4	Provision of the Rules
1	29	Rule 4.1 (c) (iv)
2	31	Rule 4.18 Rule 4.19
3	35	Rule 12.1 ^{bis}
4	38	Rule 12.3
5	39	Rule 20.1 Rule 20.2 Rule 20.3 Rule 20.4 Rule 20.5 Rule 20.6 Rule 20.7 Rule 20.8
6	40	Rule 21.2
7	41	Rule 22.1
8	42	Rule 26.1 Rule 26.2
9	43 and 44	Rule 26.3 ^{ter}
10	45	Rule 26.4 Rule 26.5
11	55	Rule 48.2 (b) (v)
12	58	Rule 51.1 Rule 51.2
13	59	Rule 51 ^{bis} .1 (e)
14	61	Rule 55.2
15	69 and 70	Rule 76.5
16	71	Rule 82 ^{ter} .1

- (3) The amendments made by Schedule 4 do not apply to an international application whose filing date is before 1 April 2007, except as mentioned in subregulation (4).
- (4) For subregulation (3), an amendment made by an item of Schedule 4 mentioned in an item in table 2, to a provision of the Rules mentioned in that table, applies to an international application whose filing date is before 1 April 2007, in the circumstance or subject to the condition mentioned in the item in table 2.

Table 2

Item	Item of Schedule 4	Provision of the Rules	Circumstance or condition
1	48 and 49	Rule 34.1	Applies in relation to any international search carried out on or after 1 April 2007
2	52	Rule 43.4	Applies in relation to an international application in respect of which an international search report is established on or after 1 April 2007
3	53 54 65 66 67	Rule 43.6 ^{bis} Rule 43 ^{bis} .1 (b) Rule 66.1 (d) Rule 66.4 ^{bis} Rule 70.2 (e)	Apply in relation to international search reports, written opinions and international preliminary examination reports established on or after 1 April 2007, as if references to rectifications of obvious mistakes authorised under Rule 91.1 were references to rectifications of obvious errors authorised under that Rule before 1 April 2007
4	56	Rule 48.3 (c)	Applies in relation to an international application that is published under Article 21 on or after 1 April 2007
5	57	Rule 49 ^{ter} .2	Applies in respect of acts mentioned in Article 22 (1) that are performed on or after 1 April 2007
6	60 61 62 62	Rule 54 ^{bis} .1 (a) Rule 55.2 (a ^{ter}) Rule 55.2 (c) Rule 55.2 (d)	Apply in relation to an international application in respect of which a demand for international preliminary examination is made on or after 1 April 2007
7	70	Rule 76.5	Applies, to the extent that it has the effect of making Rule 49 ^{ter} .2 applicable, in respect of acts mentioned in Article 39 (1) (a) that are performed on or after 1 April 2007

- (5) In relation to the amendment made by item 39 of Schedule 4, information as to incompatibility given to the International Bureau under Rule 20.4 (d) before 1 April 2007 is taken to remain effective under Rule 20.1 (d) on or after 1 April 2007.
- (6) In relation to the amendment made by item 60 of Schedule 4, information as to incompatibility given to the International Bureau under Rule 51^{bis}.1 (f) in relation to Rule 51^{bis}.1 (e) before 1 April 2007 is taken to remain effective under Rule 51^{bis}.1 (f) in relation to Rule 51^{bis}.1 (e) on or after 1 April 2007.

9 Transitional provisions for Schedule 6 — amendments of *Trade Marks Regulations 1995* commencing on 27 March 2007

- (1) The amendment made by item 3 of Schedule 6 applies in relation to a decision made on or after the commencement of the item.
- (2) The amendments made by items 4 and 5 of Schedule 6 apply in relation to an application for assignment of a certification trade mark made on or after the commencement of the items.
- (3) The amendments made by items 7 and 8 of Schedule 6 apply in relation to the acceptance of an IRDA whether the acceptance occurred before, on or after the commencement of the items.
- (4) The amendment made by item 10 of Schedule 6 applies in relation to a trade mark or protected international trade mark that became protected after the commencement of the item.
- (5) The amendments made by items 14 and 15 of Schedule 6 apply in relation to a fee that becomes payable after the commencement of the items.

10 Transitional provisions for Schedule 7 — amendments of *Trade Marks Regulations 1995* commencing on commencement of Part 2 of Schedule 1 to the *Trade Marks Amendment Act 2006*

- (1) The amendments made by items 2, 4, 6, 7 and 38 of Schedule 7 apply in relation to a divisional application made on or after the commencement of that Schedule.
- (2) The amendments made by items 5, 21 and 44 of Schedule 7 apply in relation to trade marks whose registration expires at least 12 months after the commencement of that Schedule.

Schedule 1 Amendments of *Designs Regulations 2004* commencing on 27 March 2007

(regulation 3)

[1] After regulation 11.31

insert

11.32 Period for doing certain acts — office not open for business

For subsection 136A (1) of the Act, the circumstance is that the act is done at:

- (a) the Designs Office; or
- (b) a sub-office of the Designs Office;
that was not open for business.

Note Subsection 136A (1) provides as follows:

‘(1) If the last day of a period provided by this Act (except this section) or the regulations for doing an act is a day when the Designs Office, or a sub-office of the Designs Office, is not open for business, the act may be done in prescribed circumstances on the next day when the office or sub-office is open for business.’.

11.33 Days when office not open for business

- (1) For paragraph 136A (2) (a) of the Act, the days on which the Designs Office, or a sub-office of the Designs Office, is not open for business are:
 - (a) Saturday; and
 - (b) Sunday; and
 - (c) Australia Day; and
 - (d) Anzac Day.
- (2) For paragraph 136A (2) (b) of the Act, the Director General of IP Australia is a prescribed person.
- (3) For paragraph 136A (2) (b) of the Act, the prescribed way of publishing a declaration is in the Official Journal of Designs.

11.34 Period for doing certain acts — acts to which section 136A does not apply

For subsection 136A (7) of the Act, an act done in relation to proceedings in a court or a tribunal is prescribed.

[2] Schedule 1*after*

Mongolia

insert

Montenegro

[3] Schedule 1*omit*

Serbia and Montenegro

insert

Serbia

[4] Schedule 1*after*

Viet Nam

insert

Yemen

Schedule 2 Amendment of *Olympic Insignia Protection Regulations 1993* commencing on 27 March 2007

(regulation 4)

[1] After regulation 6

insert

6A Period for doing certain acts — office not open for business

For subsection 14A (1) of the Act, the circumstance is that the act is done at the Designs Office.

Note Subsection 14A (1) provides as follows:

‘(1) If the last day of a period provided by this Chapter (except this section), or regulations made for the purposes of this Chapter, for doing an act is a day when the Designs Office is not open for business, the act may be done in prescribed circumstances on the next day when the office is open for business.’.

6B Days when office not open for business

- (1) For paragraph 14A (2) (a) of the Act, the days on which the Designs Office is not open for business are:
 - (a) Saturday; and
 - (b) Sunday; and
 - (c) Australia Day; and
 - (d) Anzac Day.
- (2) For paragraph 14A (2) (b) of the Act, the Director General of IP Australia is a prescribed person.
- (3) For paragraph 14A (2) (b) of the Act, the prescribed way of publishing a declaration is in the Official Journal of Designs.

6C Period for doing certain acts — acts to which section 14A does not apply

For subsection 14A (7) of the Act, an act done in relation to proceedings in a court or a tribunal is prescribed.

Schedule 3 **Amendments of *Patents Regulations 1991*** **commencing on 27 March 2007**

(regulation 5)

[1] **Regulation 6A.2**

substitute

6A.2 Divisional applications: innovation patents

- (1) For subsection 79C (1) of the Act, a divisional application must be made in accordance with section 29 of the Act.
- (2) For subparagraph 79C (2) (b) (iv) of the Act, the prescribed period is 1 month from the day on which the Commissioner publishes, under paragraph 101E (d) of the Act, a notice of the occurrence of the examination of the first patent mentioned in subsection 79C (1) of the Act.

[2] **Subparagraph 12.1 (2) (a) (iv)**

substitute

- (iv) if the applicant relies on the ground mentioned in paragraph 133 (2) (a) of the Act — facts supporting the assertion that the reasonable requirements of the public with respect to the patented invention have not been satisfied; and
- (iva) if the applicant relies on the ground mentioned in paragraph 133 (2) (b) of the Act — facts supporting the assertion that the patentee has contravened, or is contravening, Part IV of the *Trade Practices Act 1974* or an application law (as defined in section 150A of that Act) in connection with the patent; and

[3] **After regulation 22.10A**

insert

22.10AA Period for doing certain acts — office not open for business

For subsection 222A (1) of the Act, the circumstance is that the act is done at:

- (a) the Patent Office; or
 - (b) a sub-office of the Patent Office;
- that was not open for business.

Note Subsection 222A (1) provides as follows:

‘(1) If the last day of a period provided by this Act (except this section) for doing an act is a day when the Patent Office, or a sub-office of the Patent Office, is not open for business, the act may be done in prescribed circumstances on the next day when the office or sub-office is open for business.’

22.10AB Days when office not open for business

- (1) For paragraph 222A (2) (a) of the Act, the days on which the Patent Office, or a sub-office of the Patent Office, is not open for business are:
 - (a) Saturday; and
 - (b) Sunday; and
 - (c) Australia Day; and
 - (d) Anzac Day.
- (2) For paragraph 222A (2) (b) of the Act, the Director General of IP Australia is a prescribed person.
- (3) For paragraph 222A (2) (b) of the Act, the prescribed way of publishing a declaration is in the *Official Journal*.

22.10AC Period for doing certain acts — acts to which section 222A does not apply

For subsection 222A (7) of the Act, the following acts are prescribed:

- (a) an act done in opposition proceedings, other than the filing of a notice or request with the Patent Office, under the following provisions:
 - (i) Chapter 5, 6, 9A, 10 or 22 of the Act;
 - (ii) Chapter 5, 10 or 22 of these Regulations;
- (b) the act of lodging a return required under section 76A of the Act;
- (c) an act done in relation to proceedings in a court or a tribunal;
- (d) an act done under Chapter 20 of these Regulations.

[4] Schedule 4

after

Mongolia

insert

Montenegro

[5] Schedule 4

omit

Serbia and Montenegro

insert

Serbia

[6] Schedule 4

after

Viet Nam

insert

Yemen

Schedule 4 **Amendments of *Patents Regulations 1991*** **commencing on 1 April 2007**

(regulations 5 and 8)

[1] **Subregulation 1.4 (2)**

omit

1 April 2006

insert

1 April 2007

[2] **After sub-subparagraph 3.12 (2) (c) (ii) (A)**

insert

(AA) an application made in Australia more than 12 months before the international filing date of the PCT application, for which:

- (I) a receiving Office has restored priority under Rule 26^{bis}.3;
and
- (II) the restored priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49^{ter}.1; or

[3] **After sub-subparagraph 3.12 (2) (c) (ii) (B)**

insert

(BB) a basic application made more than 12 months before the international filing date of the PCT application, that is the first application made in a Convention country in respect of the invention, for which:

- (I) a receiving Office has restored priority under Rule 26^{bis}.3;
and
- (II) the restored priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49^{ter}.1; or

[4] Subregulations 8.3 (1BA), (1BB) and (1BC)*substitute*

(1BA) Subsection 89 (5):

substitute

(5) If:

- (a) a PCT application has been amended under Article 19 of the PCT before the applicant meets the requirements of subsection (3); or
- (b) a PCT application has been rectified under Rule 91 of the Regulations mentioned in the definition of *PCT* in Schedule 1 before the applicant meets the requirements of subsection (3);

then the description, drawings and claims contained in the application are, for the purposes of this Act, to be taken to have been amended:

- (c) on the day the amendment was made; or
- (d) unless the Commissioner disregards the rectification under Rule 91.3 (f) — on the day the rectification was effective.

[5] After subregulation 8.3 (4)*insert*(5) Schedule 1, definition of *international filing date*, including the cross-reference to section 10:*substitute**'international filing date*, in relation to an international application, means:

- (a) the date given to the international application as its international filing date under Article 11 of the PCT; or
- (b) if that date is revised under Article 14 of the PCT — that international filing date as so revised; or
- (c) if the Commissioner has treated another date as the international filing date under Rule 82^{ter} — that international filing date as so treated.

[See also section 10]'.**[6] Schedule 2A, before Table of Provisions***omit*

and on 1 April 2006.

insert

on 1 April 2006, and on 1 April 2007.

[7] Schedule 2A, Table of Provisions, after Rule 2.3*insert*

2.4 “Priority Period”

[8] Schedule 2A, Table of Provisions, after Rule 4.17*insert*

4.18 Statement of Incorporation by Reference

4.19 Additional matter

[9] Schedule 2A, Table of Provisions, Rule 12*substitute*

Rule 12 Language of the International Application and Translations for the Purposes
of International Search and International Publication

[10] Schedule 2A, Table of Provisions, after Rule 12.1*insert*12.1^{bis} Language of Elements and Parts Furnished under Rule 20.3, 20.5 or 20.612.1^{ter} Language of Indications Furnished under Rule 13^{bis}.4**[11] Schedule 2A, Table of Provisions, Rule 20, Rule 20.1, Rule 20.2, Rule 20.3, Rule 20.4, Rule 20.5, Rule 20.6, Rule 20.7, Rule 20.8 and Rule 20.9***substitute*

Rule 20 International Filing Date

20.1 Determination under Article 11 (1)

20.2 Positive Determination under Article 11 (1)

20.3 Defects under Article 11 (1)

20.4 Negative Determination under Article 11 (1)

20.5 Missing Parts

20.6 Confirmation of Incorporation by Reference of Elements and Parts

20.7 Time Limit

20.8 Incompatibility with National Laws

[12] Schedule 2A, Table of Provisions, after Rule 21.1

insert

21.2 Certified Copy for the Applicant

[13] Schedule 2A, Table of Provisions, Rule 26.1

substitute

26.1 Invitation under Article 14 (1) (b) to Correct

[14] Schedule 2A, Table of Provisions, Rule 26.6

omit

[15] Schedule 2A, Table of Provisions, Rule 26^{bis}.2

substitute

26^{bis}.2 Defects in Priority Claims

26^{bis}.3 Restoration of Right of Priority by Receiving Office

[16] Schedule 2A, Table of Provisions, after Rule 38.2

insert

38.3 Modification of Abstract

[17] Schedule 2A, Table of Provisions, after Rule 43.6

insert

43.6^{bis} Consideration of Rectifications of Obvious Mistakes

[18] Schedule 2A, Table of Provisions, Rule 43^{bis}

substitute

Rule 43^{bis} Written Opinion of the International Searching Authority

[19] Schedule 2A, Table of Provisions, Rule 48.3

substitute

48.3 Languages of Publication

[20] Schedule 2A, Table of Provisions, after Rule 49^{bis}.2*insert*

Rule 49^{ter} Effect of Restoration of Right of Priority by Receiving Office; Restoration of Right of Priority by Designated Office

49^{ter}.1 Effect of Restoration of Right of Priority by Receiving Office

49^{ter}.2 Restoration of Right of Priority by Designated Office

[21] Schedule 2A, Table of Provisions, Rule 51.2*substitute*

51.2 Copy of the Notification

[22] Schedule 2A, Table of Provisions, after Rule 51^{bis}.2*insert*

51^{bis}.3 Opportunity to Comply with National Requirements

[23] Schedule 2A, Table of Provisions, Rules 54^{bis} and 54^{bis}.1*omit***[24] Schedule 2A, Table of Provisions, after Rule 54.4***insert*

Rule 54^{bis} Time Limit for Making a Demand

54^{bis}.1 Time Limit for Making a Demand

[25] Schedule 2A, Table of Provisions, Rule 66.4^{bis}*substitute*

66.4bis Consideration of Amendments, Arguments and Rectifications of Obvious Mistakes

[26] Schedule 2A, Table of Provisions, Rule 76*substitute*

Rule 76 Translation of Priority Document; Application of Certain Rules to Procedures Before Elected Offices

[27] Schedule 2A, Table of Provisions, Rules 91 and 91.1*substitute*

- | | |
|---------|--|
| Rule 91 | Rectification of Obvious Mistakes in the International Application and Other Documents |
| 91.1 | Rectification of Obvious Mistakes |
| 91.2 | Requests for Rectification |
| 91.3 | Authorization and Effect of Rectifications |

[28] Schedule 2A, after Rule 2.3*insert***2.4 "Priority Period"**

(a) Whenever the term "priority period" is used in relation to a priority claim, it shall be construed as meaning the period of 12 months from the filing date of the earlier application whose priority is so claimed. The day of filing of the earlier application shall not be included in that period.

(b) Rule 80.5 shall apply *mutatis mutandis* to the priority period.

[29] Schedule 2A, Rule 4.1 (c) (iii)*substitute*

- (iii) declarations as provided in Rule 4.17,
- (iv) a statement as provided in Rule 4.18,
- (v) a request for restoration of the right of priority.

[30] Schedule 2A, Rule 4.10 (a)*substitute*

(a) Any declaration referred to in Article 8 (1) ("priority claim") may claim the priority of one or more earlier applications filed either in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention. Any priority claim shall be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

- (i) the date on which the earlier application was filed;
- (ii) the number of the earlier application;
- (iii) where the earlier application is a national application, the country party to the Paris Convention for the Protection of Industrial Property or the Member of the World Trade Organization that is not party to that Convention in which it was filed;
- (iv) where the earlier application is a regional application, the authority entrusted with the granting of regional patents under the applicable regional patent treaty;
- (v) where the earlier application is an international application, the receiving Office with which it was filed.

[31] Schedule 2A, Rule 4.18*substitute***4.18 Statement of Incorporation by Reference**

Where the international application, on the date on which one or more elements referred to in Article 11 (1) (iii) were first received by the receiving Office, claims the priority of an earlier application, the request may contain a statement that, where an element of the international application referred to in Article 11 (1) (iii) (d) or (e) or a part of the description, claims or drawings referred to in Rule 20.5 (a) is not otherwise contained in the international application but is completely contained in the earlier application, that element or part is, subject to confirmation under Rule 20.6, incorporated by reference in the international application for the purposes of Rule 20.6. Such a statement, if not contained in the request on that date, may be added to the request if, and only if, it was otherwise contained in, or submitted with, the international application on that date.

4.19 Additional Matter

(a) The request shall contain no matter other than that specified in Rules 4.1 to 4.18, provided that the Administrative Instructions may permit, but cannot make mandatory, the inclusion in the request of any additional matter specified in the Administrative Instructions.

(b) If the request contains matter other than that specified in Rules 4.1 to 4.18 or permitted under paragraph (a) by the Administrative Instructions, the receiving Office shall *ex officio* delete the additional matter.

[32] Schedule 2A, Rule 11.9 (d)*substitute*

(d) All text matter shall be in characters the capital letters of which are not less than 0.28 cm high, and shall be in a dark, indelible color, satisfying the requirements specified in Rule 11.2, provided that any text matter in the request may be in characters the capital letters of which are not less than 0.21 cm high.

[33] Schedule 2A, Rule 11.14*substitute***11.14 Later Documents**

Rules 10, and 11.1 to 11.13, also apply to any document—for example, replacement sheets, amended claims, translations—submitted after the filing of the international application.

[34] Schedule 2A, Rule 12, heading*substitute*

Rule 12
Language of the International Application
and Translations for the Purposes of International Search
and International Publication

[35] Schedule 2A, after Rule 12.1*insert*

12.1^{bis} *Language of Elements and Parts Furnished under Rule 20.3, 20.5 or 20.6*

An element referred to in Article 11 (1) (iii) (d) or (e) furnished by the applicant under Rule 20.3 (b) or 20.6 (a) and a part of the description, claims or drawings furnished by the applicant under Rule 20.5 (b) or 20.6 (a) shall be in the language of the international application as filed or, where a translation of the application is required under Rule 12.3 (a) or 12.4 (a), in both the language of the application as filed and the language of that translation.

12.1^{ter} *Language of Indications Furnished under Rule 13^{bis}.4*

Any indication in relation to deposited biological material furnished under Rule 13^{bis}.4 shall be in the language in which the international application is filed, provided that, where a translation of the international application is required under Rule 12.3 (a) or 12.4 (a), any such indication shall be furnished in both the language in which the application is filed and the language of that translation.

[36] Schedule 2A, Rule 12.2 (b)*substitute*

(b) Any rectification under Rule 91.1 of an obvious mistake in the international application shall be in the language in which the application is filed, provided that:

- (i) where a translation of the international application is required under Rule 12.3 (a), 12.4 (a) or 55.2 (a), rectifications referred to in Rule 91.1 (b) (ii) and (iii) shall be filed in both the language of the application and the language of that translation;
- (ii) where a translation of the request is required under Rule 26.3^{ter} (c), rectifications referred to in Rule 91.1 (b) (i) need only be filed in the language of that translation.

[37] Schedule 2A, Rule 12.2 (c)*substitute*

(c) Any correction under Rule 26 of a defect in the international application shall be in the language in which the international application is filed. Any correction under Rule 26 of a defect in a translation of the international application furnished under Rule 12.3 or 12.4, any correction under Rule 55.2 (c) of a defect in a translation furnished under Rule 55.2 (a), or any correction of a defect in a translation of the request furnished under Rule 26.3^{ter} (c), shall be in the language of the translation.

[38] Schedule 2A, Rule 12.3 (c)*omit*

Rule 20.5 (c)

insert

Rule 20.2 (c)

[39] Schedule 2A, Rule 20*substitute***Rule 20
International Filing Date****20.1 Determination under Article 11 (1)**

(a) Promptly after receipt of the papers purporting to be an international application, the receiving Office shall determine whether the papers fulfill the requirements of Article 11 (1).

(b) For the purposes of Article 11 (1) (iii) (c), it shall be sufficient to indicate the name of the applicant in a way which allows the identity of the applicant to be established even if the name is misspelled, the given names are not fully indicated, or, in the case of legal entities, the indication of the name is abbreviated or incomplete.

(c) For the purposes of Article 11 (1) (ii), it shall be sufficient that the part which appears to be a description (other than any sequence listing part thereof) and the part which appears to be a claim or claims be in a language accepted by the receiving Office under Rule 12.1 (a).

(d) If, on October 1, 1997, paragraph (c) is not compatible with the national law applied by the receiving Office, paragraph (c) shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1997. The information received shall be promptly published by the International Bureau in the Gazette.

20.2 Positive Determination under Article 11 (1)

(a) If the receiving Office determines that, at the time of receipt of the papers purporting to be an international application, the requirements of Article 11 (1) were fulfilled, the receiving Office shall accord as the international filing date the date of receipt of the international application.

(b) The receiving Office shall stamp the request of the international application which it has accorded an international filing date as prescribed by the Administrative Instructions. The copy whose request has been so stamped shall be the record copy of the international application.

(c) The receiving Office shall promptly notify the applicant of the international application number and the international filing date. At the same time, it shall send to the International Bureau a copy of the notification sent to the applicant, except where it has already sent, or is sending at the same time, the record copy to the International Bureau under Rule 22.1 (a).

20.3 Defects under Article 11 (1)

(a) Where, in determining whether the papers purporting to be an international application fulfill the requirements of Article 11 (1), the receiving Office finds that any of the requirements of Article 11 (1) are not, or appear not to be, fulfilled, it shall promptly invite the applicant, at the applicant's option:

- (i) to furnish the required correction under Article 11 (2); or
- (ii) where the requirements concerned are those relating to an element referred to in Article 11 (1) (iii) (d) or (e), to confirm in accordance with Rule 20.6 (a) that the element is incorporated by reference under Rule 4.18;

and to make observations, if any, within the applicable time limit under Rule 20.7. If that time limit expires after the expiration of 12 months from the filing date of any application whose priority is claimed, the receiving Office shall call that circumstance to the attention of the applicant.

(b) Where, following an invitation under paragraph (a) or otherwise:

- (i) the applicant furnishes to the receiving Office the required correction under Article 11 (2) after the date of receipt of the purported international application but on a later date falling within the applicable time limit under Rule 20.7, the receiving Office shall accord that later date as the international filing date and proceed as provided in Rule 20.2 (b) and (c);
- (ii) an element referred to in Article 11 (1) (iii) (d) or (e) is, under Rule 20.6 (b), considered to have been contained in the international application on the date on which one or more elements referred to in Article 11 (1) (iii) were first received by the receiving Office, the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11 (1) are fulfilled and proceed as provided in Rule 20.2 (b) and (c).

(c) If the receiving Office later discovers, or on the basis of the applicant's reply realizes, that it has erred in issuing an invitation under paragraph (a) since the requirements of Article 11 (1) were fulfilled when the papers were received, it shall proceed as provided in Rule 20.2.

20.4 *Negative Determination under Article 11 (1)*

If the receiving Office does not receive, within the applicable time limit under Rule 20.7, a correction or confirmation referred to in Rule 20.3 (a), or if a correction or confirmation has been received but the application still does not fulfill the requirements of Article 11 (1), the receiving Office shall:

- (i) promptly notify the applicant that the application is not and will not be treated as an international application and shall indicate the reasons therefor;
- (ii) notify the International Bureau that the number it has marked on the papers will not be used as an international application number;
- (iii) keep the papers constituting the purported international application and any correspondence relating thereto as provided in Rule 93.1; and
- (iv) send a copy of the said papers to the International Bureau where, pursuant to a request by the applicant under Article 25 (1), the International Bureau needs such a copy and specially asks for it.

20.5 *Missing Parts*

(a) Where, in determining whether the papers purporting to be an international application fulfill the requirements of Article 11 (1), the receiving Office finds that a part of the description, claims or drawings is or appears to be missing, including the case where all of the drawings are or appear to be missing but not including the case where an entire element referred to in Article 11 (1) (iii) (d) or (e) is or appears to be missing, it shall promptly invite the applicant, at the applicant's option:

- (i) to complete the purported international application by furnishing the missing part; or
- (ii) to confirm, in accordance with Rule 20.6 (a), that the part was incorporated by reference under Rule 4.18;

and to make observations, if any, within the applicable time limit under Rule 20.7. If that time limit expires after the expiration of 12 months from the filing date of any application whose priority is claimed, the receiving Office shall call that circumstance to the attention of the applicant.

(b) Where, following an invitation under paragraph (a) or otherwise, the applicant furnishes to the receiving Office, on or before the date on which all of the requirements of Article 11 (1) are fulfilled but within the applicable time limit under Rule 20.7, a missing part referred to in paragraph (a) so as to complete the international application, that part shall be included in the application and the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11 (1) are fulfilled and proceed as provided in Rule 20.2 (b) and (c).

(c) Where, following an invitation under paragraph (a) or otherwise, the applicant furnishes to the receiving Office, after the date on which all of the requirements of Article 11 (1) were fulfilled but within the applicable time limit under Rule 20.7, a missing part referred to in paragraph (a) so as to complete the international application, that part shall be included in the application, and the receiving Office shall correct the international filing date to the date on which the receiving Office received that part, notify the applicant accordingly and proceed as provided for in the Administrative Instructions.

(d) Where, following an invitation under paragraph (a) or otherwise, a part referred to in paragraph (a) is, under Rule 20.6 (b), considered to have been contained in the purported international application on the date on which one or more elements referred to in Article 11 (1) (iii) were first received by the receiving Office, the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11 (1) are fulfilled and proceed as provided in Rule 20.2 (b) and (c).

(e) Where the international filing date has been corrected under paragraph (c), the applicant may, in a notice submitted to the receiving Office within one month from the date of the notification under paragraph (c), request that the missing part concerned be disregarded, in which case the missing part shall be considered not to have been furnished and the correction of the international filing date under that paragraph shall be considered not to have been made, and the receiving Office shall proceed as provided for in the Administrative Instructions.

20.6 *Confirmation of Incorporation by Reference of Elements and Parts*

(a) The applicant may submit to the receiving Office, within the applicable time limit under Rule 20.7, a written notice confirming that an element or part is incorporated by reference in the international application under Rule 4.18, accompanied by:

- (i) a sheet or sheets embodying the entire element as contained in the earlier application or embodying the part concerned;
- (ii) where the applicant has not already complied with Rule 17.1 (a), (b) or (b^{bis}) in relation to the priority document, a copy of the earlier application as filed;
- (iii) where the earlier application is not in the language in which the international application is filed, a translation of the earlier application into that language or, where a translation of the international application is required under Rule 12.3 (a) or 12.4 (a), a translation of the earlier application into both the language in which the international application is filed and the language of that translation; and

- (iv) in the case of a part of the description, claims or drawings, an indication as to where that part is contained in the earlier application and, where applicable, in any translation referred to in item (iii).

(b) Where the receiving Office finds that the requirements of Rule 4.18 and paragraph (a) have been complied with and that the element or part referred to in paragraph (a) is completely contained in the earlier application concerned, that element or part shall be considered to have been contained in the purported international application on the date on which one or more elements referred to in Article 11 (1) (iii) were first received by the receiving Office.

(c) Where the receiving Office finds that a requirement under Rule 4.18 or paragraph (a) has not been complied with or that the element or part referred to in paragraph (a) is not completely contained in the earlier application concerned, the receiving Office shall proceed as provided for in Rule 20.3 (b) (i), 20.5 (b) or 20.5 (c), as the case may be.

20.7 Time Limit

(a) The applicable time limit referred to in Rules 20.3 (a) and (b), 20.4, 20.5 (a), (b) and (c), and 20.6 (a) shall be:

- (i) where an invitation under Rule 20.3 (a) or 20.5 (a), as applicable, was sent to the applicant, two months from the date of the invitation;
- (ii) where no such invitation was sent to the applicant, two months from the date on which one or more elements referred to in Article 11 (1) (iii) were first received by the receiving Office.

(b) Where a correction under Article 11 (2) or a notice under Rule 20.6 (a) confirming the incorporation by reference of an element referred to in Article 11 (1) (iii) (d) or (e) is received by the receiving Office after the expiration of the applicable time limit under paragraph (a) but before that Office sends a notification to the applicant under Rule 20.4 (i), that correction or notice shall be considered to have been received within that time limit.

20.8 Incompatibility with National Laws

(a) If, on October 5, 2005, any of Rules 20.3 (a) (ii) and (b) (ii), 20.5 (a) (ii) and (d), and 20.6 are not compatible with the national law applied by the receiving Office, the Rules concerned shall not apply to an international application filed with that receiving Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

(a^{bis}) Where a missing element or part cannot be incorporated by reference in the international application under Rules 4.18 and 20.6 because of the operation of paragraph (a) of this Rule, the receiving Office shall proceed as provided for in Rule 20.3 (b) (i), 20.5 (b) or 20.5 (c), as the case may be. Where the receiving Office proceeds as provided for in Rule 20.5 (c), the applicant may proceed as provided for in Rule 20.5 (e).

(b) If, on October 5, 2005, any of Rules 20.3 (a) (ii) and (b) (ii), 20.5 (a) (ii) and (d), and 20.6 are not compatible with the national law applied by the designated Office, the Rules concerned shall not apply in respect of that Office in relation to an international application in respect of which the acts referred to in Article 22 have been performed before that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

(c) Where an element or part is considered to have been incorporated by reference in the international application by virtue of a finding of the receiving Office under Rule 20.6 (b), but that incorporation by reference does not apply to the international application for the purposes of the procedure before a designated Office because of the operation of paragraph (b) of this Rule, the designated Office may treat the application as if the international filing date had been accorded under Rule 20.3 (b) (i) or 20.5 (b), or corrected under Rule 20.5 (c), as the case may be, provided that Rule 82^{ter}.1 (c) and (d) shall apply *mutatis mutandis*.

[40] Schedule 2A, after Rule 21.1

insert

21.2 Certified Copy for the Applicant

Against payment of a fee, the receiving Office shall furnish to the applicant, on request, certified copies of the international application as filed and of any corrections thereto.

[41] Schedule 2A, Rules 22.1 (b) and 22.1 (c)*substitute*

(b) If the International Bureau has received a copy of the notification under Rule 20.2 (c) but is not, by the expiration of 13 months from the priority date, in possession of the record copy, it shall remind the receiving Office that it should transmit the record copy to the International Bureau promptly.

(c) If the International Bureau has received a copy of the notification under Rule 20.2 (c) but is not, by the expiration of 14 months from the priority date, in possession of the record copy, it shall notify the applicant and the receiving Office accordingly.

[42] Schedule 2A, Rules 26.1 and 26.2*substitute*26.1 *Invitation under Article 14 (1) (b) to Correct*

The receiving Office shall issue the invitation to correct provided for in Article 14 (1) (b) as soon as possible, preferably within one month from the receipt of the international application. In the invitation, the receiving Office shall invite the applicant to furnish the required correction, and give the applicant the opportunity to make observations, within the time limit under Rule 26.2.

26.2 *Time Limit for Correction*

The time limit referred to in Rule 26.1 shall be two months from the date of the invitation to correct. It may be extended by the receiving Office at any time before a decision is taken.

[43] Schedule 2A, Rule 26.3^{ter}(a)*omit*

26.1 (a)

insert

26.1

[44] Schedule 2A, Rule 26.3^{ter}(c)*omit*

26.1 (a)

insert

26.1

[45] Schedule 2A, Rules 26.4, 26.5 and 26.6*substitute*26.4 *Procedure*

A correction of the request offered to the receiving Office may be stated in a letter addressed to that Office if the correction is of such a nature that it can be transferred from the letter to the request without adversely affecting the clarity and the direct reproducibility of the sheet on to which the correction is to be transferred; otherwise, and in the case of a correction of any element of the international application other than the request, the applicant shall be required to submit a replacement sheet embodying the correction and the letter accompanying the replacement sheet shall draw attention to the differences between the replaced sheet and the replacement sheet.

26.5 *Decision of the Receiving Office*

The receiving Office shall decide whether the applicant has submitted the correction within the applicable time limit under Rule 26.2, and, if the correction has been submitted within that time limit, whether the international application so corrected is or is not to be considered withdrawn, provided that no international application shall be

considered withdrawn for lack of compliance with the physical requirements referred to in Rule 11 if it complies with those requirements to the extent necessary for the purpose of reasonably uniform international publication.

[46] Schedule 2A, Rule 26^{bis}.1 (a)

substitute

(a) The applicant may correct a priority claim or add a priority claim to the request by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16-month period expires first, provided that such a notice may be submitted until the expiration of four months from the international filing date. The correction of a priority claim may include the addition of any indication referred to in Rule 4.10.

[47] Schedule 2A, Rules 26^{bis}.2 and 26^{bis}.3

substitute

26^{bis}.2 *Defects in Priority Claims*

(a) Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds in relation to a priority claim:

- (i) that the international application has an international filing date which is later than the date on which the priority period expired and that a request for restoration of the right of priority under Rule 26^{bis}.3 has not been submitted;
- (ii) that the priority claim does not comply with the requirements of Rule 4.10; or
- (iii) that any indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document;

the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim. In the case referred to in item (i), where the international filing date is within two months from the date on which the priority period expired, the receiving Office or the International Bureau, as the case may be, shall also notify the applicant of the possibility of submitting a request for the restoration of the right of priority in accordance with Rule 26^{bis}.3, unless the receiving Office has notified the International Bureau under Rule 26^{bis}.3 (j) of the incompatibility of Rule 26^{bis}.3 (a) to (i) with the national law applied by that Office.

(b) If the applicant does not, before the expiration of the time limit under Rule 26^{bis}.1 (a), submit a notice correcting the priority claim, that priority claim shall, subject to paragraph (c), for the purposes of the procedure under the Treaty, be considered not to have been made ("considered void") and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly. Any notice correcting the priority claim which is received before the receiving Office or the International Bureau, as the case may be, so declares and not later than one month after the expiration of that time limit shall be considered to have been received before the expiration of that time limit.

(c) A priority claim shall not be considered void only because:

- (i) the indication of the number of the earlier application referred to in Rule 4.10 (a) (ii) is missing;
- (ii) an indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document; or
- (iii) the international application has an international filing date which is later than the date on which the priority period expired, provided that the international filing date is within the period of two months from that date.

(d) Where the receiving Office or the International Bureau has made a declaration under paragraph (b) or where the priority claim has not been considered void only because paragraph (c) applies, the International Bureau shall publish, together with the international application, information concerning the priority claim as prescribed by the Administrative Instructions, as well as any information submitted by the applicant concerning such priority claim which is received by the International Bureau prior to the completion of the technical preparations for international publication. Such information shall be included in the communication under Article 20 where the international application is not published by virtue of Article 64 (3).

(e) Where the applicant wishes to correct or add a priority claim but the time limit under Rule 26^{bis}.1 has expired, the applicant may, prior to the expiration of 30 months from the priority date and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, request the International Bureau to publish information concerning the matter, and the International Bureau shall promptly publish such information.

26^{bis}.3 *Restoration of Right of Priority by Receiving Office*

(a) *Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the receiving Office shall, on the request of the applicant, and subject to paragraphs (b) to (g) of this Rule, restore the right of priority if the Office finds that a criterion applied by it ("criterion for restoration") is satisfied, namely, that the failure to file the international application within the priority period:*

- (i) occurred in spite of due care required by the circumstances having been taken; or
- (ii) was unintentional.

Each receiving Office shall apply at least one of those criteria and may apply both of them.

(b) A request under paragraph (a) shall:

- (i) be filed with the receiving Office within the time limit applicable under paragraph (e);
- (ii) state the reasons for the failure to file the international application within the priority period; and
- (iii) preferably be accompanied by any declaration or other evidence required under paragraph (f).

(c) Where a priority claim in respect of the earlier application is not contained in the international application, the applicant shall submit, within the time limit applicable under paragraph (e), a notice under Rule 26^{bis}.1 (a) adding the priority claim.

(d) The submission of a request under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee for requesting restoration, payable within the time limit applicable under paragraph (e). The amount of that fee, if any, shall be fixed by the receiving Office.

(e) The time limit referred to in paragraphs (b) (i), (c) and (d) shall be two months from the date on which the priority period expired, provided that, where the applicant makes a request for early publication under Article 21 (2) (b), any request under paragraph (a) or any notice referred to in paragraph (c) submitted, or any fee referred to in paragraph (d) paid, after the technical preparations for international publication have been completed shall be considered as not having been submitted or paid in time.

(f) The receiving Office may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (b) (iii) be filed with it within a time limit which shall be reasonable under the circumstances. The applicant may furnish to the International Bureau a copy of any such declaration or other evidence filed with the receiving Office, in which case the International Bureau shall include such copy in its files.

(g) The receiving Office shall not refuse, totally or in part, a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances. Such notice of intended refusal by the receiving Office may be sent to the applicant together with any invitation to file a declaration or other evidence under paragraph (f).

(h) The receiving Office shall promptly:

- (i) notify the International Bureau of the receipt of a request under paragraph (a);
- (ii) make a decision upon the request;
- (iii) notify the applicant and the International Bureau of its decision and the criterion for restoration upon which the decision was based.

(i) Each receiving Office shall inform the International Bureau of which of the criteria for restoration it applies and of any subsequent changes in that respect. The International Bureau shall promptly publish such information in the Gazette.

(j) If, on October 5, 2005, paragraphs (a) to (i) are not compatible with the national law applied by the receiving Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

[48] Schedule 2A, Rule 34.1 (c) (ii)

substitute

- (ii) the patents issued by the Federal Republic of Germany, the Republic of Korea and the Russian Federation,

[49] Schedule 2A, Rule 34.1 (e)*substitute*

(e) Any International Searching Authority whose official language, or one of whose official languages, is not Japanese, Korean, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan, the Republic of Korea, the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than six months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

[50] Schedule 2A, Rule 36.1 (iv)*substitute*

- (iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search;
- (v) that Office or organization must hold an appointment as an International Preliminary Examining Authority.

[51] Schedule 2A, Rule 38.2*substitute***38.2 Establishment of Abstract**

If the international application does not contain an abstract and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish an abstract, or if the said Authority finds that the abstract does not comply with Rule 8, it shall itself establish an abstract. Such abstract shall be established in the language in which the international application is to be published or, if a translation into another language was transmitted under Rule 23.1 (b) and the International Searching Authority so wishes, in the language of that translation.

38.3 Modification of Abstract

The applicant may, until the expiration of one month from the date of mailing of the international search report, submit to the International Searching Authority:

- (i) proposed modifications of the abstract; or
- (ii) where the abstract has been established by the Authority, proposed modifications of, or comments on, that abstract, or both modifications and comments;

and the Authority shall decide whether to modify the abstract accordingly. Where the Authority modifies the abstract, it shall notify the modification to the International Bureau.

[52] Schedule 2A, Rule 43.4*substitute***43.4 Language**

Every international search report and any declaration made under Article 17 (2) (a) shall be in the language in which the international application to which it relates is to be published, provided that:

- (i) if a translation of the international application into another language was transmitted under Rule 23.1 (b) and the International Searching Authority so wishes, the international search report and any declaration made under Article 17 (2) (a) may be in the language of that translation;
- (ii) if the international application is to be published in the language of a translation furnished under Rule 12.4 which is not accepted by the International Searching Authority and that Authority so wishes, the international search report and any declaration made under Article 17 (2) (a) may be in a language which is both a language accepted by that Authority and a language of publication referred to in Rule 48.3 (a).

[53] Schedule 2A, after Rule 43.6*insert*43.6^{bis} *Consideration of Rectifications of Obvious Mistakes*

(a) A rectification of an obvious mistake that is authorized under Rule 91.1 shall, subject to paragraph (b), be taken into account by the International Searching Authority for the purposes of the international search and the international search report shall so indicate.

(b) A rectification of an obvious mistake need not be taken into account by the International Searching Authority for the purposes of the international search if it is authorized by or notified to that Authority, as applicable, after it has begun to draw up the international search report, in which case the report shall, if possible, so indicate, failing which the International Searching Authority shall notify the International Bureau accordingly and the International Bureau shall proceed as provided for in the Administrative Instructions.

[54] Schedule 2A, Rule 43^{bis}.1 (b)*substitute*

(b) For the purposes of establishing the written opinion, Articles 33 (2) to (6) and 35 (2) and (3) and Rules 43.4, 43.6^{bis}, 64, 65, 66.1 (e), 66.7, 67, 70.2 (b) and (d), 70.3, 70.4 (ii), 70.5 (a), 70.6 to 70.10, 70.12, 70.14 and 70.15 (a) shall apply *mutatis mutandis*.

[55] Schedule 2A, Rule 48.2*substitute*48.2 *Contents*

(a) The publication of the international application shall contain:

- (i) a standardized front page;
- (ii) the description;
- (iii) the claims;
- (iv) the drawings, if any;
- (v) subject to paragraph (g), the international search report or the declaration under Article 17 (2) (a);
- (vi) any statement filed under Article 19 (1), unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4;
- (vii) where the request for publication under Rule 91.3 (d) was received by the International Bureau before the completion of the technical preparations for international publication, any request for rectification of an obvious mistake, any reasons and any comments referred to in Rule 91.3 (d);
- (viii) the indications in relation to deposited biological material furnished under Rule 13^{bis} separately from the description, together with an indication of the date on which the International Bureau received such indications;
- (ix) any information concerning a priority claim referred to in Rule 26^{bis}.2 (d);
- (x) any declaration referred to in Rule 4.17, and any correction thereof under Rule 26^{ter}.1, which was received by the International Bureau before the expiration of the time limit under Rule 26^{ter}.1;
- (xi) any information concerning a request under Rule 26^{bis}.3 for restoration of the right of priority and the decision of the receiving Office upon such request, including information as to the criterion for restoration upon which the decision was based.

(b) Subject to paragraph (c), the front page shall include:

- (i) data taken from the request sheet and such other data as are prescribed by the Administrative Instructions;
- (ii) a figure or figures where the international application contains drawings, unless Rule 8.2 (b) applies;
- (iii) the abstract; if the abstract is both in English and in another language, the English text shall appear first;
- (iv) where applicable, an indication that the request contains a declaration referred to in Rule 4.17 which was received by the International Bureau before the expiration of the time limit under Rule 26^{ter}.1;

- (v) where the international filing date has been accorded by the receiving Office under Rule 20.3 (b) (ii) or 20.5 (d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part, an indication to that effect, together with an indication as to whether the applicant, for the purposes of Rule 20.6 (a) (ii), relied on compliance with Rule 17.1 (a), (b) or (b^{bis}) in relation to the priority document or on a separately submitted copy of the earlier application concerned;
- (vi) where applicable, an indication that the published international application contains information under Rule 26^{bis}.2 (d);
- (vii) where applicable, an indication that the published international application contains information concerning a request under Rule 26^{bis}.3 for restoration of the right of priority and the decision of the receiving Office upon such request;
- (viii) where applicable, an indication that the applicant has, under Rule 26^{bis}.3 (f), furnished copies of any declaration or other evidence to the International Bureau.

(c) Where a declaration under Article 17 (2) (i) has issued, the front page shall conspicuously refer to that fact and need include neither a drawing nor an abstract.

(d) The figure or figures referred to in paragraph (b) (ii) shall be selected as provided in Rule 8.2. Reproduction of such figure or figures on the front page may be in a reduced form.

(e) If there is not enough room on the front page for the totality of the abstract referred to in paragraph (b) (iii), the said abstract shall appear on the back of the front page. The same shall apply to the translation of the abstract when such translation is required to be published under Rule 48.3 (c).

(f) If the claims have been amended under Article 19, the publication of the international application shall contain the full text of the claims both as filed and as amended. Any statement referred to in Article 19 (1) shall be included as well, unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4. The date of receipt of the amended claims by the International Bureau shall be indicated.

(g) If, at the time of the completion of the technical preparations for international publication, the international search report is not yet available, the front page shall contain an indication to the effect that that report was not available and that the international search report (when it becomes available) will be separately published together with a revised front page.

(h) If, at the time of the completion of the technical preparations for international publication, the time limit for amending the claims under Article 19 has not expired, the front page shall refer to that fact and indicate that, should the claims be amended under Article 19, then, promptly after receipt by the International Bureau of such amendments within the time limit under Rule 46.1, the full text of the claims as amended will be published together with a revised front page. If a statement under Article 19 (1) has been filed, that statement shall be published as well, unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4.

(i) If the authorization of a rectification of an obvious mistake in the international application referred to in Rule 91.1 is received by or, where applicable, given by the International Bureau after completion of the technical preparations for international publication, a statement reflecting all the rectifications shall be published, together with the sheets containing the rectifications, or the replacement sheets and the letter furnished under Rule 91.2, as the case may be, and the front page shall be republished.

(j) If, at the time of completion of the technical preparations for international publication, a request under Rule 26^{bis}.3 for restoration of the right of priority is still pending, the published international application shall contain, in place of the decision by the receiving Office upon that request, an indication to the effect that such decision was not available and that the decision, when it becomes available, will be separately published.

(k) If a request for publication under Rule 91.3 (d) was received by the International Bureau after the completion of the technical preparations for international publication, the request for rectification, any reasons and any comments referred to in that Rule shall be promptly published after the receipt of such request for publication, and the front page shall be republished.

[56] Schedule 2A, Rule 48.3 (c)

substitute

(c) If the international application is published in a language other than English, the international search report to the extent that it is published under Rule 48.2 (a) (v), or the declaration referred to in Article 17 (2) (a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations, if not furnished by the applicant under Rule 12.3, shall be prepared under the responsibility of the International Bureau.

[57] Schedule 2A, after Rule 49^{bis}*insert*

Rule 49^{ter}
Effect of Restoration of Right of Priority by Receiving Office;
Restoration of Right of Priority by Designated Office

49^{ter}.1 Effect of Restoration of Right of Priority by Receiving Office

(a) Where the receiving Office has restored a right of priority under Rule 26^{bis}.3 based on a finding by it that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken, that restoration shall, subject to paragraph (c), be effective in each designated State.

(b) Where the receiving Office has restored a right of priority under Rule 26^{bis}.3 based on a finding by it that the failure to file the international application within the priority period was unintentional, that restoration shall, subject to paragraph (c), be effective in any designated State whose applicable national law provides for restoration of the right of priority based on that criterion or on a criterion which, from the viewpoint of applicants, is more favorable than that criterion.

(c) A decision by the receiving Office to restore a right of priority under Rule 26^{bis}.3 shall not be effective in a designated State where the designated Office, a court or any other competent organ of or acting for that designated State finds that a requirement under Rule 26^{bis}.3 (a), (b) (i) or (c) was not complied with, taking into account the reasons stated in the request submitted to the receiving Office under Rule 26^{bis}.3 (a) and any declaration or other evidence filed with the receiving Office under Rule 26^{bis}.3 (b) (iii).

(d) A designated Office shall not review the decision of the receiving Office unless it may reasonably doubt that a requirement referred to in paragraph (c) was complied with, in which case the designated Office shall notify the applicant accordingly, indicating the reasons for that doubt and giving the applicant an opportunity to make observations within a reasonable time limit.

(e) No designated State shall be bound by a decision of the receiving Office refusing a request under Rule 26^{bis}.3 for restoration of the right of priority.

(f) Where the receiving Office has refused a request for the restoration of the right of priority, any designated Office may consider that request to be a request for restoration submitted to that designated Office under Rule 49^{ter}.2 (a) within the time limit under that Rule.

(g) If, on October 5, 2005, paragraphs (a) to (d) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

49^{ter}.2 Restoration of Right of Priority by Designated Office

(a) Where the international application claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the designated Office shall, on the request of the applicant in accordance with paragraph (b), restore the right of priority if the Office finds that a criterion applied by it ("criterion for restoration") is satisfied, namely, that the failure to file the international application within the priority period:

- (i) occurred in spite of due care required by the circumstances having been taken; or
- (ii) was unintentional.

Each designated Office shall apply at least one of those criteria and may apply both of them.

(b) A request under paragraph (a) shall:

- (i) be filed with the designated Office within a time limit of one month from the applicable time limit under Article 22;
- (ii) state the reasons for the failure to file the international application within the priority period and preferably be accompanied by any declaration or other evidence required under paragraph (c); and
- (iii) be accompanied by any fee for requesting restoration required under paragraph (d).

(c) The designated Office may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (b) (ii) be filed with it within a time limit which shall be reasonable under the circumstances.

(d) The submission of a request under paragraph (a) may be subjected by the designated Office to the payment to it, for its own benefit, of a fee for requesting restoration.

(e) The designated Office shall not refuse, totally or in part, a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances. Such notice of intended refusal may be sent by the designated Office to the applicant together with any invitation to file a declaration or other evidence under paragraph (c).

(f) Where the national law applicable by the designated Office provides, in respect of the restoration of the right of priority, for requirements which, from the viewpoint of applicants, are more favorable than the requirements provided for under paragraphs (a) and (b), the designated Office may, when determining the right of priority, apply the requirements under the applicable national law instead of the requirements under those paragraphs.

(g) Each designated Office shall inform the International Bureau of which of the criteria for restoration it applies, of the requirements, where applicable, of the national law applicable in accordance with paragraph (f), and of any subsequent changes in that respect. The International Bureau shall promptly publish such information in the Gazette.

(h) If, on October 5, 2005, paragraphs (a) to (g) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

[58] Schedule 2A, Rules 51.1 and 51.2

substitute

51.1 *Time Limit for Presenting the Request to Send Copies*

The time limit referred to in Article 25 (1) (c) shall be two months computed from the date of the notification sent to the applicant under Rule 20.4 (i), 24.2 (c) or 29.1 (ii).

51.2 *Copy of the Notification*

Where the applicant, after having received a negative determination under Article 11 (1), requests the International Bureau, under Article 25 (1), to send copies of the file of the purported international application to any of the named Offices he has attempted to designate, he shall attach to his request a copy of the notification referred to in Rule 20.4 (i).

[59] Schedule 2A, Rule 51^{bis}.1 (e)

substitute

(e) The national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish a translation of the priority document, provided that such a translation may only be required:

- (i) where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable; or
- (ii) where the international filing date has been accorded by the receiving Office under Rule 20.3 (b) (ii) or 20.5 (d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part, for the purposes of determining under Rule 82^{ter}.1 (b) whether that element or part is completely contained in the priority document concerned, in which case the national law applicable by the designated Office may also require the applicant to furnish, in the case of a part of the description, claims or drawings, an indication as to where that part is contained in the translation of the priority document.

[60] Schedule 2A, Rule 54^{bis}.1 (a)

substitute

(a) A demand may be made at any time prior to the expiration of whichever of the following periods expires later:

- (i) three months from the date of transmittal to the applicant of the international search report or the declaration referred to in Article 17 (2) (a), and of the written opinion established under Rule 43^{bis}.1; or
- (ii) 22 months from the priority date.

[61] Schedule 2A, after Rule 55.2 (a)*insert*

(a^{bis}) A translation of the international application into a language referred to in paragraph (a) shall include any element referred to in Article 11(1)(iii)(d) or (e) furnished by the applicant under Rule 20.3(b) or 20.6(a) and any part of the description, claims or drawings furnished by the applicant under Rule 20.5(b) or 20.6(a) which is considered to have been contained in the international application under Rule 20.6(b).

(a^{ter}) The International Preliminary Examining Authority shall check any translation furnished under paragraph (a) for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purposes of the international preliminary examination.

[62] Schedule 2A, Rules 55.2 (c) and 55.2 (d)*substitute*

(c) If a requirement referred to in paragraphs (a), (a^{bis}) and (a^{ter}) is not complied with and paragraph (b) does not apply, the International Preliminary Examining Authority shall invite the applicant to furnish the required translation or the required correction, as the case may be, within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(d) If the applicant complies with the invitation within the time limit under paragraph (c), the said requirement shall be considered to have been complied with. If the applicant fails to do so, the demand shall be considered not to have been submitted and the International Preliminary Examining Authority shall so declare.

[63] Schedule 2A, Rule 63.1 (iv)*substitute*

- (iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international preliminary examination;
- (v) that Office or organization must hold an appointment as an International Searching Authority.

[64] Schedule 2A, Rule 64.1 (b)*substitute*

- (b) For the purposes of paragraph (a), the relevant date shall be:
- (i) subject to items (ii) and (iii), the international filing date of the international application under international preliminary examination;
 - (ii) where the international application under international preliminary examination claims the priority of an earlier application and has an international filing date which is within the priority period, the filing date of such earlier application, unless the International Preliminary Examining Authority considers that the priority claim is not valid;
 - (iii) where the international application under international preliminary examination claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the filing date of such earlier application, unless the International Preliminary Examining Authority considers that the priority claim is not valid for reasons other than the fact that the international application has an international filing date which is later than the date on which the priority period expired.

[65] Schedule 2A, after Rule 66.1 (d)*insert*

(d^{bis}) A rectification of an obvious mistake that is authorized under Rule 91.1 shall, subject to Rule 66.4^{bis}, be taken into account by the International Preliminary Examining Authority for the purposes of the international preliminary examination.

[66] Schedule 2A, Rules 66.4^{bis} and 66.5*substitute*66.4^{bis} *Consideration of Amendments, Arguments and Rectifications of Obvious Mistakes*

Amendments, arguments and rectifications of obvious mistakes need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if they are received by, authorized by or notified to that Authority, as applicable, after it has begun to draw up that opinion or report.

66.5 *Amendment*

Any change, other than the rectification of an obvious mistake, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings, shall be considered an amendment.

[67] Schedule 2A, after Rule 70.2 (d)*insert*

(e) If a rectification of an obvious mistake is taken into account under Rule 66.1, the report shall so indicate. If a rectification of an obvious mistake is not taken into account pursuant to Rule 66.4^{bis}, the report shall, if possible, so indicate, failing which the International Preliminary Examining Authority shall notify the International Bureau accordingly and the International Bureau shall proceed as provided for in the Administrative Instructions.

[68] Schedule 2A, Rule 70.16 (a)*substitute*

(a) Each replacement sheet under Rule 66.8 (a) or (b) and each replacement sheet containing amendments under Article 19 shall, unless superseded by later replacement sheets or amendments resulting in the cancellation of entire sheets under Rule 66.8 (b), be annexed to the report. Replacement sheets containing amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rule 66.8 shall not be annexed.

[69] Schedule 2A, Rule 76, heading*substitute*

Rule 76
Translation of Priority Document;
Application of Certain Rules to Procedures before Elected Offices

[70] Schedule 2A, Rule 76.5*omit*

Rules 13^{ter}.3, 22.1(g), 47.1, 49, 49^{bis} and 51^{bis} shall apply,

insert

Rules 13^{ter}.3, 20.8(c), 22.1(g), 47.1, 49, 49^{bis}, 49^{ter} and 51^{bis} shall apply,

[71] Schedule 2A, Rule 82^{ter}*substitute*

Rule 82^{ter}
Rectification of Errors Made
by the Receiving Office or by the International Bureau

82^{ter}.1 Errors Concerning the International Filing Date and the Priority Claim

(a) If the applicant proves to the satisfaction of any designated or elected Office that the international filing date is incorrect due to an error made by the receiving Office or that the priority claim has been erroneously considered void by the receiving Office or the International Bureau, and if the error is an error such that, had it been made by the designated or elected Office itself, that Office would rectify it under the national law or national practice, the said Office shall rectify the error and shall treat the international application as if it had been accorded the rectified international filing date or as if the priority claim had not been considered void.

(b) Where the international filing date has been accorded by the receiving Office under Rule 20.3 (b) (ii) or 20.5 (d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part but the designated or elected Office finds that:

- (i) the applicant has not complied with Rule 17.1 (a), (b) or (b^{bis}) in relation to the priority document;
- (ii) a requirement under Rule 4.18, 20.6 (a) (i) or 51^{bis}.1 (e) (ii) has not been complied with; or
- (iii) the element or part is not completely contained in the priority document concerned;

the designated or elected Office may, subject to paragraph (c), treat the international application as if the international filing date had been accorded under Rule 20.3 (b) (i) or 20.5 (b), or corrected under Rule 20.5 (c), as applicable, provided that Rule 17.1 (c) shall apply *mutatis mutandis*.

(c) The designated or elected Office shall not treat the international application under paragraph (b) as if the international filing date had been accorded under Rule 20.3 (b) (i) or 20.5 (b), or corrected under Rule 20.5 (c), without giving the applicant the opportunity to make observations on the intended treatment, or to make a request under paragraph (d), within a time limit which shall be reasonable under the circumstances.

(d) Where the designated or elected Office, in accordance with paragraph (c), has notified the applicant that it intends to treat the international application as if the international filing date had been corrected under Rule 20.5 (c), the applicant may, in a notice submitted to that Office within the time limit referred to in paragraph (c), request that the missing part concerned be disregarded for the purposes of national processing before that Office, in which case that part shall be considered not to have been furnished and that Office shall not treat the international application as if the international filing date had been corrected.

[72] Schedule 2A, Rule 91*substitute*

Rule 91
Rectification of Obvious Mistakes
in the International Application and Other Documents

91.1 Rectification of Obvious Mistakes

(a) An obvious mistake in the international application or another document submitted by the applicant may be rectified in accordance with this Rule if the applicant so requests.

(b) The rectification of a mistake shall be subject to authorization by the “competent authority”, that is to say:

- (i) in the case of a mistake in the request part of the international application or in a correction thereof—by the receiving Office;
- (ii) in the case of a mistake in the description, claims or drawings or in a correction thereof, unless the International Preliminary Examining Authority is competent under item (iii)—by the International Searching Authority;
- (iii) in the case of a mistake in the description, claims or drawings or in a correction thereof, or in an amendment under Article 19 or 34, where a demand for international preliminary examination has been made and has not been withdrawn and the date on which international preliminary examination shall start in accordance with Rule 69.1 has passed—by the International Preliminary Examining Authority;
- (iv) in the case of a mistake in a document not referred to in items (i) to (iii) submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or

the International Bureau, other than a mistake in the abstract or in an amendment under Article 19—by that Office, Authority or Bureau, as the case may be.

(c) The competent authority shall authorize the rectification under this Rule of a mistake if, and only if, it is obvious to the competent authority that, as at the applicable date under paragraph (f), something else was intended than what appears in the document concerned and that nothing else could have been intended than the proposed rectification.

(d) In the case of a mistake in the description, claims or drawings or in a correction or amendment thereof, the competent authority shall, for the purposes of paragraph (c), only take into account the contents of the description, claims and drawings and, where applicable, the correction or amendment concerned.

(e) In the case of a mistake in the request part of the international application or a correction thereof, or in a document referred to in paragraph (b) (iv), the competent authority shall, for the purposes of paragraph (c), only take into account the contents of the international application itself and, where applicable, the correction concerned, or the document referred to in paragraph (b) (iv), together with any other document submitted with the request, correction or document, as the case may be, any priority document in respect of the international application that is available to the authority in accordance with the Administrative Instructions, and any other document contained in the authority's international application file at the applicable date under paragraph (f).

(f) The applicable date for the purposes of paragraphs (c) and (e) shall be:

- (i) in the case of a mistake in a part of the international application as filed—the international filing date;
- (ii) in the case of a mistake in a document other than the international application as filed, including a mistake in a correction or an amendment of the international application—the date on which the document was submitted.

(g) A mistake shall not be rectifiable under this Rule if:

- (i) the mistake lies in the omission of one or more entire elements of the international application referred to in Article 3 (2) or one or more entire sheets of the international application;
- (ii) the mistake is in the abstract;
- (iii) the mistake is in an amendment under Article 19, unless the International Preliminary Examining Authority is competent to authorize the rectification of such mistake under paragraph (b) (iii); or
- (iv) the mistake is in a priority claim or in a notice correcting or adding a priority claim under Rule 26^{bis}.1 (a), where the rectification of the mistake would cause a change in the priority date;

provided that this paragraph shall not affect the operation of Rules 20.4, 20.5, 26^{bis} and 38.3.

(h) Where the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau discovers what appears to be a rectifiable obvious mistake in the international application or another document, it may invite the applicant to request rectification under this Rule.

91.2 Requests for Rectification

A request for rectification under Rule 91.1 shall be submitted to the competent authority within 26 months from the priority date. It shall specify the mistake to be rectified and the proposed rectification, and may, at the option of the applicant, contain a brief explanation. Rule 26.4 shall apply *mutatis mutandis* as to the manner in which the proposed rectification shall be indicated.

91.3 Authorization and Effect of Rectifications

(a) The competent authority shall promptly decide whether to authorize or refuse to authorize a rectification under Rule 91.1 and shall promptly notify the applicant and the International Bureau of the authorization or refusal and, in the case of refusal, of the reasons therefor. The International Bureau shall proceed as provided for in the Administrative Instructions, including, as required, notifying the receiving Office, the International Searching Authority, the International Preliminary Examining Authority and the designated and elected Offices of the authorization or refusal.

(b) Where the rectification of an obvious mistake has been authorized under Rule 91.1, the document concerned shall be rectified in accordance with the Administrative Instructions.

(c) Where the rectification of an obvious mistake has been authorized, it shall be effective:

- (i) in the case of a mistake in the international application as filed, from the international filing date;
- (ii) in the case of a mistake in a document other than the international application as filed, including a mistake in a correction or an amendment of the international application, from the date on which that document was submitted.

(d) Where the competent authority refuses to authorize a rectification under Rule 91.1, the International Bureau shall, upon request submitted to it by the applicant within two months from the date of the refusal, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification, the reasons for refusal by the authority and any further brief comments that may be submitted by the applicant, if possible together with the international application. A copy of the request, reasons

and comments (if any) shall if possible be included in the communication under Article 20 where the international application is not published by virtue of Article 64 (3).

(e) The rectification of an obvious mistake need not be taken into account by any designated Office in which the processing or examination of the international application has already started prior to the date on which that Office is notified under Rule 91.3 (a) of the authorization of the rectification by the competent authority.

(f) A designated Office may disregard a rectification that was authorized under Rule 91.1 only if it finds that it would not have authorized the rectification under Rule 91.1 if it had been the competent authority, provided that no designated Office shall disregard any rectification that was authorized under Rule 91.1 without giving the applicant the opportunity to make observations, within a time limit which shall be reasonable under the circumstances, on the Office's intention to disregard the rectification.

[73] Schedule 7, Part 3, after item 307

insert

308 For processing a request for restoration of priority under Rule 26^{bis} of the PCT. \$200

[74] Schedule 7, Part 4, items 403 and 404

substitute

- 403 The international filing fee is reduced by the following amount if the international application is, as provided for in the Administrative instructions, filed:
- | | |
|---|------------------|
| (a) on paper together with a copy in electronic form, in character coded format, of the request and the abstract: | 100 Swiss francs |
| (b) in electronic form, the request not being in character coded format: | 100 Swiss francs |
| (c) in electronic form, the request being in character coded format: | 200 Swiss francs |
| (d) in electronic form, the request, description claims and abstract being in character coded format: | 300 Swiss francs |
- 404 The international filing fee (where applicable, as reduced under item 403) and the handling fee are reduced by 75% if the international application is filed by:
- (a) an applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3 000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); or
 - (b) an applicant, whether a natural person or not, who is a national of and resides in a State that is classed as a least developed country by the United Nations.

If there are several applicants, each must satisfy the criteria mentioned in paragraph (a) or (b).

Schedule 5 Amendment of *Plant Breeder's Rights Regulations 1994* commencing on 27 March 2007

(regulation 6)

[1] After regulation 3A

insert

3B Employees to whom Registrar may delegate (Act s59 (3))

For subsection 59 (3) of the Act, the Registrar may delegate all or any of the Registrar's powers or functions under the Act or these Regulations, to an employee of the PBR office:

- (a) holding, or performing the duties of, the position of Examiner of Plant Breeder's Rights; or
- (b) employed at any of the following levels:
 - (i) Executive level 1 or 2;
 - (ii) APS level 2, 3, 4, 5 or 6.

3C Employees to whom Minister's powers may be subdelegated (Act s59 (4))

For subsection 59 (4) of the Act, the class of employee to whom the Minister's powers or functions may be delegated is an employee employed at Executive level 2.

3D Employees to whom Secretary's powers may be subdelegated (Act s59 (4))

For subsection 59 (4) of the Act, the class of employee to whom the Secretary's powers or functions may be delegated is an employee:

- (a) holding, or performing the duties of, the position of Examiner of Plant Breeder's Rights; or
- (b) employed at any of the following levels:
 - (i) Executive level 1 or 2;
 - (ii) APS level 2, 3, 4, 5 or 6.

3E Period for doing certain acts — office not open for business

For subsection 76A (1) of the Act, the circumstance is that the act is done at:

- (a) the PBR office; or

- (b) the PBR sub-office;
that was not open for business.

Note Subsection 76A (1) provides as follows:

‘(1) If the last day of a period provided by this Act (except this section) or the regulations for doing an act is a day when the PBR office or a PBR sub-office is not open for business, the act may be done in prescribed circumstances on the next day when the office or sub-office is open for business.’.

3F Days when office not open for business

- (1) For paragraph 76A (2) (a) of the Act, the days on which the PBR office or PBR sub-office is not open for business are:
 - (a) Saturday; and
 - (b) Sunday; and
 - (c) Australia Day; and
 - (d) Anzac Day.
- (2) For paragraph 76A (2) (b) of the Act, the Director General of IP Australia is a prescribed person.
- (3) For paragraph 76A (2) (b) of the Act, the prescribed way of publishing a declaration is in the Plant Varieties Journal.

3G Period for doing certain acts — acts to which section 76A does not apply

For subsection 76A (7) of the Act, an act done in relation to proceedings in a court or a tribunal is prescribed.

Schedule 6 **Amendments of *Trade Marks Regulations 1995* commencing on 27 March 2007**

(regulations 7 and 9)

[1] **After regulation 8.1**

insert

8.1A Notice of revocation

For subsection 84A (4) of the Act, a notice by the Registrar must be:

- (a) in writing; and
- (b) sent, as the case requires, to the address for service of each of the following:
 - (i) the registered owner;
 - (ii) the person recorded under Part 11 of the Act.

[2] **Regulation 16.2**

substitute

16.2 Documents to be sent to Commission

- (1) If, after examining an application, the Registrar is satisfied that:
 - (a) the application has been made in accordance with this Act; and
 - (b) there are no grounds for rejecting it;
 the Registrar must send to the Commission copies of the documents mentioned in subregulation (2).
- (2) For subregulation (1), the documents are:
 - (a) the application for registration; and
 - (b) a notification of any amendment made to the application for registration of a certification trade mark; and
 - (c) a copy of the rules governing the use of the certification trade mark; and
 - (d) any other document that is relevant to the application.

[3] **Regulation 16.10**

substitute

16.10 Decision on variation of rules

- (1) The Commission may approve a variation of the rules if the Commission is satisfied that the rules, as varied:
 - (a) would not be to the detriment of the public; and
 - (b) are satisfactory having regard to the criteria prescribed in regulation 16.6; and

- (c) provide that the attributes a person must have to become an approved certifier are sufficient to enable the person to assess competently whether goods or services meet the certification requirements.
- (2) If the Commission approves a variation of the rules, the Commission must:
 - (a) notify the registered owner, in writing, of its decision to approve a variation of the rules; and
 - (b) certify in writing that it is satisfied of the matters mentioned in subsection 178 (3) of the Act and in subregulation (1); and
 - (c) send a copy of the certificate to the Registrar; and
 - (d) send a certified copy of the rules as varied to the Registrar.
 - (3) If the Commission decides not to approve a variation of the rules, the Commission must notify the Registrar and the registered owner, in writing, of its decision not to approve a variation of the rules.
 - (4) The Registrar must publish in the *Official Journal* notice of the Commission's decision to approve or not approve a variation of the rules.
 - (5) The notice to be published in the *Official Journal* must include a statement to the effect that, subject to the *Administrative Appeals Tribunal Act 1975*, application may be made to the Administrative Appeals Tribunal for review of the decision to which the notice relates.

Note **registered owner** is defined in section 6 of the Act.

[4] Subregulation 16.10A (2)

substitute

- (2) 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, the Commission must have regard to the following matters in considering an application:
 - (a) whether under the proposed rules the attributes a person must have to become an approved certifier are sufficient, in the opinion of the Commission, to enable a person to competently assess whether or not goods or services meet the certification requirements;
 - (b) whether the proposed rules would not be to the detriment of the public;
 - (c) whether the proposed rules are satisfactory, having regard to the criteria prescribed in regulation 16.6.

[5] Subregulation 16.11 (2)

substitute

- (2) If the prospective assignee does not propose after the assignment to continue to apply the same rules governing use of the registered certification trade mark as the registered owner of the trade mark applies, the Commission must have regard to the following matters in considering an application:
 - (a) whether under the proposed rules the attributes a person must have to become an approved certifier are sufficient, in the opinion of the Commission, to

enable a person to competently assess whether or not goods or services meet the certification requirements;

- (b) whether the proposed rules would not be to the detriment of the public;
- (c) whether the proposed rules are satisfactory, having regard to the criteria prescribed in regulation 16.6.

[6] After regulation 16.11

insert in Part 16

16.12 Publication of rules

- (1) The Registrar must publish the rules governing the use of the certification trade mark as soon as practicable after a copy of the rules is filed in accordance with subsection 173 (1) of the Act.
- (2) The Registrar must publish the certified copy of the rules, provided to the Registrar by the Commission in accordance with subsection 175 (2) of the Act, as soon as practicable after the Registrar advertises acceptance of the application in the *Official Journal* in accordance with paragraph 176 (3) (b) of the Act.
- (3) The Registrar may publish the rules, or the certified copy of the rules, in any manner the Registrar thinks fit, including (but not limited to):
 - (a) a listing in a computer database that is publicly available; or
 - (b) making the rules or certified copy of the rules available for public inspection.

[7] Paragraphs 17A.27 (1) (a) and (b)

substitute

- (a) the IRDA should not have been accepted, taking account of all the circumstances that existed when the IRDA was accepted (whether or not the Registrar knew then of their existence); and
- (b) it is reasonable to revoke the acceptance, taking account of all the circumstances;

[8] Paragraphs 17A.27 (2) (b) and (c)

substitute

- (b) this Subdivision again applies in relation to the IRDA.

[9] Part 17A, Division 5, after the heading

insert

Subdivision 1 Amendment or cessation of protection because of cancellation, limitation or non-renewal of international registration

[10] After regulation 17A.42

insert

Subdivision 2 Amendment or cessation of protection by Registrar

17A.42A Registrar's powers to amend or cease protection

- (1) If all the conditions in subregulation (2) are met, the Registrar may do any of the following:
 - (a) declare that the protection extended to a protected international trade mark is ceased;
 - (b) impose a condition or limitation on the protection extended to a protected international trade mark;
 - (c) if a protected international trade mark is already subject to a condition or limitation — impose or substitute an additional or different condition or limitation on the protection extended to the protected international trade mark;
 - (d) remove or amend an entry in the Record of International Registrations relating to a protected international trade mark.
- (2) For subregulation (1) the conditions are as follows:
 - (a) within 12 months after the trade mark became a protected international trade mark the Registrar gave notice in writing of the Registrar's intention to exercise a power or powers mentioned in subregulation (1), to:
 - (i) the holder of the protected international trade mark; and
 - (ii) any person recorded under regulation 17A.62 as claiming an interest or right in respect of the protected international trade mark;
 - (b) the Registrar gave the opportunity to be heard to each person mentioned in subparagraph (a) (i) or (ii), in relation to the Registrar's intention to exercise a power mentioned in subregulation (1);
 - (c) the Registrar is satisfied, having regard to all the circumstances that existed when the trade mark became a protected international trade mark (whether or not the Registrar knew then of their existence), and the grounds for refusing protection mentioned in regulations 17A.31, that:
 - (i) the trade mark should not have become protected for some or all of the goods or services in respect of which it is protected; or
 - (ii) the protection of the trade mark should have been subject to a condition or limitation, or an additional or different condition or limitation;

- (d) the Registrar is satisfied that it is reasonable to exercise the power or powers mentioned in subregulation (1).
- (3) For paragraph (2) (c), the circumstances to which the Registrar must have regard include the following:
- (a) any error or omission (including an error or omission of judgment) that led directly or indirectly to the trade mark becoming protected for some or all of the goods or services in respect of which it is protected;
 - (b) any relevant obligation of Australia under an international agreement;
 - (c) any special circumstances making it appropriate, in the opinion of the Registrar, that:
 - (i) the trade mark not be protected for some or all of the goods or services in respect of which it is protected; or
 - (ii) the protection of the trade mark be subject to a condition or limitation, or an additional or different condition or limitation.
- (4) For paragraph (2) (d), in deciding whether or not it is reasonable to exercise a power or powers, the matters to which the Registrar must have regard include the following:
- (a) any use that has been made of the trade mark;
 - (b) any past, current or proposed legal proceedings relating to the trade mark as a protected international trade mark or seeking amendment or cessation of its protection;
 - (c) any other action taken in relation to the trade mark as a protected international trade mark;
 - (d) any special circumstances making it appropriate for the Registrar to exercise or not to exercise a power or powers mentioned in subregulation (1).
- (5) The Registrar does not have a duty to consider whether or not to exercise a power under this Subdivision, whether or not the Registrar has been requested to do so.

17A.42B Notice to be given

- (1) For paragraph 17A.42A (2) (a), the Registrar may give a written notice to the holder by sending it to:
- (a) the address for service in Australia recorded for the holder in the Record of International Registrations; or
 - (b) if there is no address for service recorded for the holder in the Record of International Registrations — the address for the holder.
- (2) The Registrar may notify any person if the Registrar is satisfied that it would be reasonable to do so in all the circumstances.

17A.42C Hearings and procedure

- (1) The Registrar may conduct the following hearings under this Subdivision:
 - (a) a hearing at which the Registrar may determine whether or not to exercise a power or powers mentioned in subregulation 17A.42A (1);
 - (b) a preliminary hearing at which the Registrar may give directions as to the procedure to be adopted in a hearing mentioned in paragraph (a).
- (2) The Registrar may determine the procedure to be adopted in a hearing under this subdivision as the Registrar sees fit, according to the circumstances in the particular case.
- (3) Regulation 21.14 does not apply to a hearing under this subdivision.

Note Regulation 21.14 provides for the conduct of proceedings generally under these Regulations.

- (4) The Registrar may hear any person if the Registrar is satisfied that it would be reasonable to do so in all the circumstances.

17A.42D Effect of amendment or cessation of protection by Registrar

- (1) This regulation applies if the Registrar exercises any of the powers mentioned in subregulation 17A.42A (1).
- (2) Subject to subregulation (3), the exercise by the Registrar of a power mentioned in subregulation 17A.42A (1) is taken to have had effect from the date of effect of the protection of the protected international trade mark, and in particular:
 - (a) any reduction in scope of the protection is taken to apply from that date; and
 - (b) any condition or limitation imposed by the Registrar is taken to have had effect from that date; and
 - (c) any removal or amendment of an entry in the Record of International Registrations is taken to have had effect from that date.

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

- (3) For subregulation (2), the exercise of a power mentioned in subregulation 17A.42A (1) has effect as follows:
 - (a) for the application of a provision in Part 12, 13 or 14 of the Act as applied by regulation 17A.39, or a provision in Part 13 of these regulations — from the date the power is exercised;
 - (b) for the application of subsection 230 (2) of the Act as applied by regulation 17A.71:
 - (i) in relation to a defendant who was the holder of the protected international trade mark before the exercise of the power — from the date the power is exercised; or
 - (ii) in relation to a defendant who was an authorised user of the protected international trade mark before the exercise of the power — from the date the defendant becomes aware of the exercise of the power.

17A.42E Registrar to notify Customs CEO

- (1) If the Registrar exercises a power mentioned in subregulation 17A.42A (1) the Registrar must notify the Customs CEO in writing.
- (2) Despite paragraph 17A.42D (3) (a), if the Customs CEO seizes under Part 13 goods in respect of which the protected international trade mark was protected before the exercise of a power mentioned in subregulation 17A.42A (1), the Commonwealth is not liable for any loss or damage suffered because of the seizure unless:
 - (a) the Registrar gives the Customs CEO written notice in accordance with subregulation (1); and
 - (b) the seizure occurs after the notice is given to the Customs CEO.
- (3) To avoid doubt, subregulation (2) does not, by itself, make the Commonwealth liable if the circumstances described in paragraphs (2) (a) and (b) exist.

17A.42F Appeal to Federal Court

A person who made submissions to the Registrar, or was heard by the Registrar, during the course of proceedings mentioned in paragraph 17A.42C (1) (a), may appeal to the Federal Court from a decision of the Registrar to exercise, or not exercise, a power mentioned in subregulation 17A.42A (1).

Subdivision 3 Amendment or cessation of protection by prescribed court**[11] After regulation 17A.47**

insert

Subdivision 4 Cessation of protection for non-use**[12] After regulation 17A.71**

insert

17A.72 Documents to be made available for public inspection

Section 217A of the Act and regulation 21.11A apply in relation to:

- (a) a trade mark that is the subject of an IRDA; or
- (b) a protected international trade mark;

as if the reference in subsection 217A (1) to the time particulars of the application for registration of the trade mark are published under section 30 were a reference to the time of inclusion of the particulars of the IRDA in the Record of International Registrations under subregulation 17A.66 (2).

[13] After regulation 21.11*insert***21.11A Documents to be made available for public inspection**

- (1) For subsection 217A (1) of the Act each document held by the Registrar that relates to a trade mark is prescribed, other than a document mentioned in subregulation (2).
- (2) For subregulation (1), the documents are:
 - (a) a document that would be privileged from production in legal proceedings on the ground of legal professional privilege; and
 - (b) a document that is subject to an order of a court or tribunal that prohibits disclosure of the document or information in the document; and
 - (c) a document:
 - (i) whose production the Registrar has required under paragraph 202 (c) of the Act; and
 - (ii) that the Registrar is satisfied should not be made available for public inspection; and
 - (d) a document that solely contains evidence of the use or proposed use of a trade mark; and
 - (e) a declaration stating the reasons for a request for expedited examination under regulation 4.18; and
 - (f) a document filed by an applicant for an extension of time under subsection 224 (2) or (3) of the Act in relation to an application under those provisions, other than the application for an extension of time; and
 - (g) a document filed in the course of opposition proceedings under the Act and Regulations, other than the notice of opposition; and
 - (h) a document containing any information that the Registrar requires to be held confidentially under paragraph 226A (1) (a) of the Act; and
 - (i) a document prepared by the Registrar, a Deputy Registrar or an employee in the Trade Marks Office that contains information obtained from a document to which any of paragraphs (a) to (h) applies, being information that is the reason, or contributes to the reason, why that paragraph applies to the document.

[14] After regulation 21.21*insert***21.21A No action permitted until fee paid**

- (1) If a fee is payable in respect of the doing of an act by the Registrar or the Customs CEO, the Registrar or Customs CEO must not do the act until the fee has been paid.
- (2) Subject to subregulation (3), if:
 - (a) a fee is payable in respect of the doing of an act by a person other than the Registrar or the Customs CEO; or

- (b) a fee is payable in respect of the filing of a document; the act is taken to have been done, or the document is taken to have been filed, despite of the failure to pay the fee.

Note *File* has the meaning given by section 6 of the Act.

- (3) If the Registrar or the Customs CEO notifies under regulation 21.23 the person concerned or his or her agent, that the fee has not been paid, the act is not taken to have been done, or the document is not taken to have been filed, before the day on which the fee is paid.

[15] Regulation 21.23

omit

For subsection 223 (5) of the Act (which deals with non-payment of fees),

insert

For subregulation 21.21A (3),

[16] After regulation 21.24

insert

21.24A Period for doing certain acts — office not open for business

For subsection 223A (1) of the Act, the circumstance is that the act is done at:

- (a) the Trade Marks Office; or
 (b) a sub-office of the Trade Marks Office;
 that was not open for business.

Note Subsection 223A (1) provides as follows:

‘(1) If the last day of a period provided by this Act (except this section) for doing an act is a day when the Trade Marks Office, or a sub-office of the Trade Marks Office, is not open for business, the act may be done in prescribed circumstances on the next day when the office or sub-office is open for business.’

21.24B Days when office not open for business

- (1) For paragraph 223A (2) (a) of the Act, the days on which the Trade Marks Office, or a sub-office of the Trade Marks Office, is not open for business are:
- (a) Saturday; and
 (b) Sunday; and
 (c) Australia Day; and
 (d) Anzac Day.
- (2) For paragraph 223A (2) (b) of the Act, the Director General of IP Australia is a prescribed person.
- (3) For paragraph 223A (2) (b) of the Act, the prescribed way of publishing a declaration is in the Official Journal of Trade Marks.

21.24C Period for doing certain acts — acts to which section 223A does not apply

For subsection 223A (7) of the Act, the following acts are prescribed:

- (a) an act done in opposition proceedings, other than the filing of a notice or request with the Trade Marks Office, under the following provisions:
 - (i) Part 5, 9 or 21 of the Act;
 - (ii) Part 5, 9, 17A or 21 of these Regulations;
- (b) an act done in relation to proceedings in a court or a tribunal;
- (c) the filing of a notice of opposition with a court under section 96 of the Act;
- (d) an act done under Part 13 or 16 of the Act;
- (e) an act done under Part 13, 16 or 20 of these Regulations.

[17] Schedule 9, item 22, second column

omit

or another document

[18] Schedule 9, after item 34

insert

- | | | |
|----|--|---|
| 35 | (a) request for a copy of a file or part of a file under regulation 21.11A | \$30 for each file that is the subject of a request |
| | (b) for each request of 20 pages or less | no additional charge |
| | (c) for each request involving more than 20 pages from a single file | \$1 for each additional page over 20 from the file |

[19] Schedule 10

after

Mongolia

insert

Montenegro

[20] Schedule 10

omit

Serbia and Montenegro

insert

Serbia

[21] Schedule 10*after*

Viet Nam

insert

Yemen

Schedule 7 Amendments of *Trade Marks Regulations 1995* commencing on the commencement of Part 2 of Schedule 1 to the Trade Marks Amendment Act 2006

(regulations 7 and 10)

[1] Paragraph 4.2 (1) (d)

substitute

- (d) include sufficient information to enable the Registrar to establish the identity of the applicant; and

[2] After regulation 4.2

insert

4.2AA Divisional application — additional requirement for filing

A divisional application must contain the following information:

- (a) a statement that the application is a divisional application;
 (b) a statement identifying the parent application.

[3] Subregulation 4.3 (5)

omit

into English.

insert

into English, if required to do so by the Registrar at the time of application or later.

[4] Paragraph 4.7 (1) (d)

omit

initial

insert

parent

[5] Subparagraph 4.13 (1) (c) (v)*omit*

12 months

insert

6 months

[6] Regulations 4.16 and 4.17*omit***[7] After regulation 6.4***insert***6.5 Amendment after particulars published — notice of opposition**

- (1) For subsection 65A (4) of the Act (which deals with opposition to granting a request for amendment after particulars of the application have been published), a person may oppose a request for amendment by filing a notice of opposition with the Registrar.
- (2) A notice of opposition must be:
 - (a) in an approved form; and
 - (b) filed within 1 month after the request for amendment is advertised in the *Official Journal*.
- (3) The opponent must serve a copy of the notice on the applicant.

6.6 Amendment after particulars published — opposition proceedings

For subsection 65A (4) of the Act (which deals with opposition to granting a request for amendment after particulars of the application have been published), regulations 5.7 to 5.17 (inclusive) apply to an opposition to a request for amendment.

[8] Paragraph 7.2 (e)*omit*

initial

insert

parent

[9] Paragraph 7.2 (f)*omit*

initial

insert

parent

[10] Regulation 9.1, including the note

substitute

9.1 Applications for removal etc

For paragraph 92 (2) (a) of the Act (which deals with applications), an application for the removal of a trade mark from the Register must be in an approved form.

[11] Subregulation 9.2 (2)

omit

, and the accompanying declaration,

[12] Subregulation 9.4 (4)

substitute

- (4) For section 97 of the Act, there is taken to be no opposition to the application if:
- (a) under subregulation (3), opposition proceedings are taken to have ended but are not taken to have been discontinued or dismissed; and
 - (b) the Registrar is satisfied that the application for removal is in order.

Note Section 97 provides for the removal of a trade mark from the Register if an application for removal is unopposed.

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

omit

1 January 1998.

insert

3 October 2006.

[14] Regulation 17A.2, after definition of *Common Regulations*

insert

Contracting Party of the holder has the meaning given by Rule 1 (xxvibis) of the Common Regulations.

[15] Regulation 17A.2, definition of *date of recordal*

substitute

date of recording means the date recorded in the International Register as the recordal date for a request made under Article 3^{ter}(2) of the Protocol for extension of protection to Australia.

[16] Regulation 17A.9

omit

filed with the Registrar.

insert

filed.

[17] Subregulations 17A.10 (1) and (3)

omit

Office of origin

insert

Office of the Contracting Party of the holder

[18] Regulation 17A.14

omit

The expression

insert

- (1) The expression

[19] Regulation 17A.14

insert

- (2) If a term has been identified by the International Bureau as being:
- (a) too vague for the purposes of classification; or
 - (b) incomprehensible; or
 - (c) linguistically incorrect;

the term must not be used in an IRDA to specify the goods or services in respect of which protection is sought, unless the Registrar is satisfied that the term is sufficiently clear in the circumstances.

[20] After regulation 17A.14*insert***17A.14A Representation of trade marks**

If the representation of a trade mark in an IRDA includes words of a language other than English, the holder of the IRDA must file a translation of the words into English, if required to do so by the Registrar.

Note Rule 9 (4) (a) (xii) of the Common Regulations provides that a transliteration is required if the trade mark consists of or contains matter in characters other than Latin characters or numbers expressed in numerals other than Arabic or Roman numerals.

[21] Subparagraph 17A.21 (1) (c) (v)*omit*

12 months

insert

6 months

[22] Subregulation 17A.33 (3)*omit*

unless, within 3 months after the notice of opposition is filed,

insert

until

[23] Subregulation 17A.34 (2)*substitute*

- (2) The Registrar must tell the International Bureau of his or her decision.

[24] After Subdivision 3*insert***Subdivision 3A Cancellation or limitation of an international registration****17A.35A Cancellation**

If the International Bureau cancels an international registration in whole or in part the IRDA ceases, to the extent of the cancellation, when the international registration is cancelled.

17A.35B Duties and powers of Registrar — notification of limitation by International Bureau

- (1) This regulation applies if the International Bureau notifies the Registrar that a holder of an international registration in respect of a trade mark that is the subject of an IRDA but has not become protected, has placed a limitation on the registration.
- (2) Subject to this regulation, a limitation mentioned in subregulation (1) has effect from the date the limitation was recorded in the International Register in accordance with Rule 27 (1) of the Common Regulations.
- (3) The Registrar may, within the declaration period declare, under Rule 27 (5) of the Common Regulations, that the limitation has:
 - (a) no effect on the IRDA; or
 - (b) partial effect on the IRDA.
- (4) A declaration under subregulation (3):
 - (a) has effect from the date the limitation was recorded in the International Register; and
 - (b) is not effective unless the Registrar sends a copy of the declaration to the International Bureau during the declaration period.
- (5) On appeal from a declaration of the Registrar under subregulation (4), a prescribed court may:
 - (a) allow a limitation according to its terms; or
 - (b) declare, under Rule 27 (5) of the Common Regulations, that the limitation has:
 - (i) no effect in Australia; or
 - (ii) partial effect in Australia.
- (6) A decision of a prescribed court under subregulation (5) has effect from the date the limitation was recorded in the International Register.
- (7) The Registrar must, after the expiration of the relevant appeal period, make any amendment to the Record of International Registrations that is necessary to give effect to a limitation allowed, or a declaration made, under this regulation.
- (8) In this regulation:

declaration period means the period of 18 months after the International Bureau notifies the Registrar that a holder has imposed a limitation on the IRDA.

limitation means a limitation, in respect of Australia, in relation to the goods or services mentioned in an international registration recorded in the International Register under Article 9^{bis} (iii) of the Protocol.

[25] After subregulation 17A.36 (2)*insert*

- (2A) If:
- (a) the Registrar accepts an IRDA; and
 - (b) opposition to the IRDA is filed within the period allowed under paragraph 17A.29 (2) (b); and
 - (c) the opposition has been dismissed or withdrawn;
- the trade mark that is the subject of the IRDA becomes a protected international trade mark after the opposition has been dismissed or withdrawn.

[26] After subregulation 17A.36 (3)*insert*

- (3A) 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 appeal has been dismissed or withdrawn;
- the trade mark becomes a protected international trade mark, to the extent permitted by the decision on the opposition, after the appeal has been dismissed or withdrawn.

[27] After subregulation 17A.38 (1)*insert*

- (1A) A notice mentioned in subregulation (1) may be:
- (a) given to the Registrar by the holder of the IRDA; or
 - (b) passed on to the Registrar by the International Bureau as part of an international application.

[28] Subregulation 17A.39 (1)*omit*

and 13.3

insert

, 13.3 and 21.32

[29] Paragraph 17A.39 (2) (e)*substitute*

- (e) to the Register is taken to be a reference to the Record of International Registrations; and
- (f) to a trade mark the registration of which has ceased is taken to be a reference to a protected international trade mark in relation to which the extension of protection in Australia has ceased.

[30] After regulation 17A.41*insert***17A.41A Duties and powers of Registrar — notification of limitation by International Bureau**

- (1) This regulation applies if the International Bureau notifies the Registrar that a holder of an international registration in respect of a protected international trade mark has placed a limitation on the registration.
- (2) Subject to this regulation, a limitation mentioned in subregulation (1) has effect from the date the limitation was recorded in the International Register in accordance with Rule 27 (1) of the Common Regulations.
- (3) The Registrar may, within the declaration period declare, under Rule 27 (5) of the Common Regulations, that the limitation has:
 - (a) no effect on the protected international trade mark; or
 - (b) partial effect on the protected international trade mark.
- (4) A declaration under subregulation (3):
 - (a) has effect from the date the limitation was recorded in the International Register; and
 - (b) is not effective unless the Registrar sends a copy of the declaration to the International Bureau during the declaration period.
- (5) On appeal from a declaration of the Registrar under subregulation (4), a prescribed court may:
 - (a) allow a limitation according to its terms; or
 - (b) declare, under Rule 27 (5) of the Common Regulations, that the limitation has:
 - (i) no effect in Australia; or
 - (ii) partial effect in Australia.
- (6) A decision of a prescribed court under subregulation (5) has effect from the date the limitation was recorded in the International Register.
- (7) The Registrar must, after the expiration of the relevant appeal period, make any amendment to the Record of International Registrations that is necessary to give effect to a limitation allowed, or a declaration made, under this regulation.

(8) In this regulation:

declaration period means the period of 18 months after the International Bureau notifies the Registrar that a holder of an international registration has imposed a limitation on the registration.

limitation means a limitation, in respect of Australia, in relation to the goods or services mentioned in an international registration recorded in the International Register under Article 9^{bis} (iii) of the Protocol.

[31] Regulation 17A.43

before

an aggrieved person,

insert

the Registrar or

[32] Subregulation 17A.44 (2)

before

an aggrieved person,

insert

the Registrar or

[33] Subregulation 17A.45 (1)

before

an aggrieved person,

insert

the Registrar or

[34] After paragraph 17A.45 (2) (d)

insert

(e) because the Registrar wrongfully made a declaration under subregulation 17A.35B (3) or 17A.41A (3).

[35] Paragraph 17A.48 (4) (g)

substitute

(g) to the date 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:

(i) if the request for extension of protection to Australia was made under Article 3^{ter} (1) of the Protocol — the date of international registration of the trade mark; or

(ii) if the request for extension of protection to Australia was made under Article 3^{ter} (2) of the Protocol — the date of recording of the request.

[36] Subregulation 17A.48 (7)*omit*

must

insert

must, if no appeal has been made at the end of any relevant appeal period,

[37] After section 17A.71*insert***17A.73 Security for costs**

If a person who neither resides nor carries on business in Australia:

- (a) gives notice of opposition to an IRDA under regulation 17A.29; or
- (b) applies to the Registrar under regulation 17A.48 for the cessation of the protection extended to a protected international trade mark;

the Registrar may require the person to give security for the costs of the proceeding and may, if security is not given, dismiss the proceeding.

[38] Paragraphs 21.28 (1) (c), (d) and (e)*substitute*

- (c) making a divisional application for the registration of a trade mark under subsection 45 (1) of the Act;

[39] Paragraphs 21.28 (1) (ea), (i), (l) and (m)*omit***[40] Schedule 9, item 3, column 3***omit*

\$270

insert

\$270 for each class

[41] Schedule 9, item 3, column 3*omit*

\$40

insert

\$40 for each class

[42] Schedule 9, item 3, column 3*omit*

\$330

insert

\$330 for each class

[43] Schedule 9, item 4*substitute*

- 4 Requesting an amendment under section 64, 65 or 65A of the Act to include an additional prescribed class of goods or services in an application:

- | | |
|--|----------------------|
| (a) application under section 51 for a series of trade marks | \$330 for each class |
| (b) any other case | \$180 for each class |

[44] Schedule 9, item 10, column 2*omit*

12 months

insert

6 months

[45] Further amendments — date of recording

The following provisions are amended by omitting ‘date of recordal’ and inserting ‘date of recording’:

- paragraph 17A.4 (1) (b)
- paragraph 17A.28 (2) (b)
- subregulation 17A.48 (4), note
- paragraph 17A.52 (2) (a)
- paragraph 17A.53 (2) (a).

Schedule 8 **Amendment of *Trade Marks Regulations* 1995 commencing on 1 April 2007**

(regulation 7)

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

omit

3 October 2006.

insert

1 April 2007.

Note

1. All legislative instruments and compilations are registered on the Federal Register of Legislative Instruments kept under the *Legislative Instruments Act 2003*. See www.frli.gov.au.
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