



Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)

Select Legislative Instrument No. 31, 2013

I, Quentin Bryce, Governor-General of the Commonwealth of Australia, acting with the advice of the Federal Executive Council, make the following regulation under the *Patents Act 1990*, the *Trade Marks Act 1995*, the *Designs Act 2003* and the *Copyright Act 1968*.

Dated 14 March 2013

Quentin Bryce
Governor-General

By Her Excellency's Command

Greg Combet
Minister for Industry and Innovation

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1 Name of regulation

This regulation is the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

2 Commencement

This regulation commences on 15 April 2013.

3 Authority

This regulation is made under:

- (a) the *Patents Act 1990*; and
- (b) the *Trade Marks Act 1995*; and
- (c) the *Designs Act 2003*; and
- (d) the *Copyright Act 1968*.

4 Schedule(s)

Each instrument that is specified in a Schedule to this instrument is amended or repealed as set out in the applicable items in the Schedule concerned, and any other item in a Schedule to this instrument has effect according to its terms.

Schedule 1—Amendments relating to the quality of granted patents

Patents Regulations 1991

1 Before regulation 3.1

Insert:

Division 1—Applications

2 Subregulation 3.3(7)

Repeal the subregulation.

3 Regulations 3.12 and 3.13

Repeal the regulations, substitute:

Division 2—Priority date of claim

3.12 What this Division is about

- (1) This Division determines the priority date of a claim:
 - (a) for subsection 36(4) of the Act (see regulation 3.13); and
 - (b) for paragraph 43(2)(a) of the Act (see regulations 3.13A to 3.13E); and
 - (c) for section 114 of the Act (see regulation 3.14).
- (2) However, if more than one of regulations 3.13A to 3.13E applies to a single claim, the priority date of the claim, for paragraph 43(2)(a) of the Act, is the earliest of the dates that is determined by those regulations.
- (3) Despite regulations 3.13A to 3.13E, the priority date of a claim, for paragraph 43(2)(a) of the Act, is no later than the date of the filing of the specification.
- (4) In this Division, a document *clearly discloses* an invention if the document discloses the invention in a manner that is clear enough,

and complete enough, for the invention to be performed by a person skilled in the relevant art.

3.13 Priority date for application by person declared under section 36 of the Act

- (1) This regulation determines the priority date of a claim under subsection 36(4) of the Act.
- (2) If the claimed invention is clearly disclosed in the specification mentioned in paragraph 36(1)(c) of the Act:
 - (a) if the specification was filed in relation to a complete application, the priority date of the claim is the priority date that the claim would have had if the claim was included in the specification; and
 - (b) if the specification was filed in relation to a provisional application, the priority date of the claim is the date the specification was filed.
- (3) If the claimed invention is not clearly disclosed in the specification mentioned in paragraph 36(1)(c) of the Act, the priority date of the claim is the date the specification for the complete application referred to in subsection 36(4) of the Act was filed.

3.13A Priority date for PCT application

- (1) This regulation applies to a claim if:
 - (a) the circumstance mentioned in subregulation (2) applies to the invention defined in the claim; and
 - (b) either:
 - (i) a document mentioned in subregulation (4) clearly discloses the invention in the claim; or
 - (ii) more than one of the documents mentioned in paragraph (4)(a), considered together, clearly disclose the invention in the claim.

Circumstance

- (2) For paragraph (1)(a), the circumstance is that the specification containing the claim that defines the invention was filed for a PCT application, and:
-

- (a) either:
 - (i) the PCT application claims the priority of an earlier application under Article 8 of the PCT; or
 - (ii) the PCT application has been amended to include a claim to priority from an earlier application that, at the time of filing the PCT application, was a claim to priority that could have been made under Article 8 of the PCT; and
- (b) either:
 - (i) the earlier application was made in Australia no more than 12 months before the filing date of the PCT application; or
 - (ii) the earlier application was made in Australia more than 12 months before the filing date of the PCT application, and:
 - (A) a receiving Office has restored the priority under Rule 26^{bis}.3, and the restored priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49^{ter}.1; or
 - (B) the Commissioner has restored the priority under Rule 49^{ter}.2; or
 - (C) the Commissioner has granted an extension of time under section 223 of the Act that has the effect of restoring a right of priority; or
 - (iii) the earlier application is a basic application that was the first application made in a Convention country in relation to the invention, and:
 - (A) the earlier application was made no more than 12 months before the filing date of the PCT application; or
 - (B) the earlier application was made more than 12 months before the filing date of the PCT application, and a receiving Office has restored the priority under Rule 26^{bis}.3, and the restored priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49^{ter}.1; or

- (C) the earlier application was made more than 12 months before the filing date of the PCT application, and the Commissioner has restored the priority under Rule 49^{ter}.2; or
 - (D) the earlier application was made more than 12 months before the filing date of the PCT application, and the Commissioner has granted an extension of time under section 223 of the Act that has the effect of restoring a right of priority; or
 - (iv) the earlier application is a basic application that was made after a basic application mentioned in subparagraph (iii).
- (3) For the purposes of this regulation, if a provisional specification was filed for a basic application when the application was made, a complete specification later filed for the basic application is taken to be another basic application from which the PCT application claims priority, made on the day when the complete specification was filed.

Documents

- (4) For paragraph (1)(b), the documents are:
- (a) the documents filed for the earlier application at the time the application was made; and
 - (b) the complete specification for the PCT application, if:
 - (i) the invention in the claim relates to a micro-organism; and
 - (ii) the documents filed for the earlier application, at the time the application was made, included the relevant information on the characteristics of the micro-organism that was known to the applicant; and
 - (iii) the documents filed for the earlier application, at the time the application was made, clearly disclosed the invention, other than in relation to the description of the micro-organism; and
 - (iv) the requirements of paragraph 6(c) of the Act are satisfied by the complete specification; and

- (v) the micro-organism was deposited with a prescribed depository institution, in accordance with the rules of the Budapest Treaty, on or before the date the earlier application was made.

Priority date

- (5) Subject to regulation 3.12, the priority date is:
 - (a) the date when the earlier application was made; or
 - (b) if there is more than one earlier application—the date the earliest of those applications was made for which paragraph (1)(b) is satisfied.

3.13B Priority date for Convention application

- (1) This regulation applies to a claim if:
 - (a) the specification containing the claim that defines the invention was filed for:
 - (i) a Convention application; or
 - (ii) a complete application that has been amended to become a Convention application; and
 - (b) a document mentioned in subregulation (2), or more than one of the documents mentioned in paragraph (2)(a) considered together, clearly discloses the invention in the claim.
- (2) For subregulation (1)(b), the documents are:
 - (a) the documents filed for a related basic application at the time when the application was made; and
 - (b) the complete specification for the Convention application, if:
 - (i) the invention in the claim relates to a micro-organism; and
 - (ii) the documents filed for a related basic application, at the time when the application was made, included the relevant information on the characteristics of the micro-organism that was known to the applicant; and
 - (iii) the documents filed for a related basic application, at the time when the application was made, clearly disclosed the invention, other than in relation to the description of the micro-organism; and

- (iv) the requirements of paragraph 6(c) of the Act are satisfied by the complete specification; and
 - (v) the micro-organism was deposited with a prescribed depository institution, in accordance with the rules of the Budapest Treaty, on or before the date when the related basic application was made.
- (3) For this regulation, if a provisional specification was filed for a related basic application when the application was made, a complete specification later filed for the basic application is taken to be another related basic application made on the day the complete specification was filed.
- (4) Subject to regulation 3.12, the priority date is:
- (a) the date the related basic application was made; or
 - (b) if there is more than one related basic application—the date the earliest of those applications was made for which paragraph (1)(b) is satisfied.

3.13C Priority date for complete application associated with provisional application

- (1) This regulation applies to a claim if:
- (a) the specification containing the claim that defines the invention was filed for a complete application that is associated with a provisional application under section 38 of the Act; and
 - (b) a document mentioned in subregulation (2), or more than one of the documents mentioned in paragraph (2)(a) considered together, clearly discloses the invention in the claim.
- (2) For paragraph (1)(b), the documents are:
- (a) the documents filed for the provisional application at the time when the application was made; and
 - (b) the complete specification for the complete application, if:
 - (i) the invention in the claim relates to a micro-organism; and
 - (ii) the documents filed for the provisional application, at the time the application was made, included the relevant

- information on the characteristics of the micro-organism that was known to the applicant; and
- (iii) the documents filed for the provisional application, at the time the application was made, clearly disclosed the invention, other than in relation to the description of the micro-organism; and
 - (iv) the requirements of paragraph 6(c) of the Act are satisfied by the complete specification; and
 - (v) the micro-organism was deposited with a prescribed depository institution, in accordance with the rules of the Budapest Treaty, on or before the date the provisional application was made.
- (3) Subject to regulation 3.12, the priority date is:
- (a) the date the provisional application was made; or
 - (b) if there is more than one provisional application—the date the earliest of those applications was made for which paragraph (1)(b) is satisfied.

3.13D Priority date for divisional application filed prior to grant of patent

- (1) This regulation applies to a claim if:
- (a) the specification containing the claim that defines the invention was filed for:
 - (i) a divisional application under section 79B of the Act; or
 - (ii) a complete application that has been amended to become a divisional application under section 79B of the Act; and
 - (b) a document mentioned in subregulation (2) clearly discloses the invention in the claim.
- (2) For paragraph (1)(b), the documents are:
- (a) the specification mentioned in subsection 79B(1) of the Act (the *earlier specification*), unless:
 - (i) the deposit requirements must be satisfied in relation to the invention to comply with paragraph 40(2)(a) of the Act; and

- (ii) when the divisional application under section 79B of the Act is made, the period prescribed in subregulation 1.5(1) has ended in relation to the earlier specification; and
- (iii) the requirements of paragraph 6(c) of the Act are not satisfied in relation to the earlier specification; and
- (b) the complete specification for the divisional application, if:
 - (i) the invention in the claim relates to a micro-organism; and
 - (ii) the earlier specification is a prescribed document; and
 - (iii) on the date when the first application was made, the earlier specification included the relevant information on the characteristics of the micro-organism that was known to the applicant; and
 - (iv) on the date when the first application was made, the earlier specification clearly disclosed the invention, other than in relation to the description of the micro-organism; and
 - (v) the requirements of paragraph 6(c) of the Act are satisfied by the complete specification for the divisional application; and
 - (vi) the micro-organism was deposited with a prescribed depository institution, in accordance with the rules of the Budapest Treaty, on or before the date when the first application was made.
- (3) Subject to regulation 3.12, the priority date is the priority date that the claim would have had if the claim was in the earlier specification.

3.13E Priority date for divisional application after grant of innovation patent

- (1) This regulation applies to a claim if:
 - (a) both of the following apply:
 - (i) the specification containing the claim that defines the invention was filed for a divisional application under section 79C of the Act;

- (ii) examination of the divisional application is requested within 2 months from the date of the grant of the divisional application; and
 - (b) the specification referred to in subsection 79C(1) of the Act clearly discloses the invention in the claim.
- (2) Subject to regulation 3.12, the priority date is the priority date that the claim would have had if the claim had been in the specification mentioned in subsection 79C(1) of the Act.

4 After regulation 3.14

Insert:

Division 3—Examination

3.14A Request for international-type search relating to provisional application

- (1) An applicant for a provisional application may make a request under Article 15(5) of the PCT for an international-type search in relation to the application.
- (2) The applicant must make the request within 10 months from the date the provisional application was filed.
- (3) If more than one International Searching Authority is competent under Article 15(5) of the PCT to carry out the search, the Commissioner may choose the Authority that will carry out the search.

3.14B Request for preliminary search and opinion relating to complete application

- (1) This regulation applies to a complete application for a standard patent made on or after 15 April 2013.
- (2) If the applicant has not asked for an examination under section 44 of the Act, the applicant may request a preliminary search and opinion relating to the application under section 43A of the Act.
- (3) The request must be in the approved form.

Note: Section 43A of the Act does not require a request to be made before the Commissioner conducts a preliminary search and opinion.

5 Paragraph 3.18(2)(d)

Repeal the paragraph.

6 After subregulation 9.2(1)

Insert:

- (1A) A request must state:
- (a) the grounds of the request; and
 - (b) the reasons why the grounds are relevant to the complete specification.

7 Subregulations 9.2(2) and (2A)

Repeal the subregulations, substitute:

- (2) Subregulations (2A) and (3) apply if the request includes an assertion that the invention, so far as claimed in any claim and when compared with the prior art base that existed before the priority date of that claim:
- (a) is not novel; or
 - (b) for a standard patent—does not involve an inventive step; or
 - (c) for an innovation patent—does not involve an innovative step.
- (2A) For subregulation (2), the request must:
- (a) identify the documents on which the assertion is based; and
 - (b) state the relevance of each document.

8 Subregulation 9.2(4)

Repeal the subregulation, substitute:

- (4) If the request does not comply with subregulation (1A), or subregulations (2), (2A) and (3) if applicable, the Commissioner may decide not to re-examine the complete specification.

9 After regulation 10.2

Insert:

10.2A Documents considered for determining whether amendment allowed

For paragraph 102(1)(b) of the Act, the following documents are prescribed:

- (a) an abstract that was filed with the complete specification;
- (b) a missing part or element of a complete specification that was incorporated into the specification, in accordance with regulation 3.5A or Rule 20.5 or 20.6 of the PCT;
- (c) an amendment that has been made to the complete specification after filing, for the purpose of:
 - (i) correcting a clerical error or obvious mistake; or
 - (ii) complying with paragraph 6(c) of the Act.

10.2B Amendments not allowable for patent requests

- (1) This regulation is made for subsection 102(2D) of the Act.
- (2) An amendment of a patent request is not allowable if:
 - (a) the patent request has been accepted under section 49 or 52 of the Act; and
 - (b) the amendment would convert the patent application from:
 - (i) an application for a standard patent to an application for an innovation patent; or
 - (ii) an application for an innovation patent to an application for a standard patent.
- (3) If:
 - (a) a request for leave to amend a patent request for a standard patent is filed within 3 weeks before the date a notice is due to be published in the *Official Journal* under section 54 of the Act in relation to the specification; and
 - (b) the amendment would:
 - (i) convert the patent application from an application for a standard patent to an application for an innovation patent; or
 - (ii) change the priority date of the application to a date that is later than the priority date that is currently recorded for the application;

the amendment is not allowable until after the date the notice is published.

- (4) An amendment of a patent request is not allowable if:
 - (a) the patent request has been accepted under section 49 or 52 of the Act; and
 - (b) the amendment would convert the patent application into a further complete application within the meaning of section 79B or 79C of the Act.
- (5) An amendment of a patent request is not allowable if:
 - (a) the amendment would convert the patent application into a further complete application within the meaning of section 79B of the Act; and
 - (b) the period allowed under subsection 79B(3) of the Act for making a further complete application has ended.
- (6) An amendment of a patent request is not allowable if:
 - (a) the amendment would convert the patent application into a further complete application within the meaning of section 79C of the Act; and
 - (b) the period allowed under subsection 79C(2) of the Act for making a further complete application has ended.
- (7) An amendment of a patent request is not allowable after the patent has been granted.

10.2C Amendments not allowable for complete specifications

- (1) This regulation is made for subsection 102(2D) of the Act.
- (2) An amendment of a complete specification is not allowable if:
 - (a) the amendment relates to a matter mentioned in paragraph 6(c) of the Act; and
 - (b) after the amendment was made, the specification would not include each of the matters specified in that paragraph.
- (3) An amendment of a complete specification is not allowable if the Commissioner:
 - (a) has given a copy of a request for leave to amend under subregulation 10.2(8) or (9) to a person; and

- (b) has not given the person a reasonable opportunity to be heard.
- (4) An amendment of a complete specification for an innovation patent, other than an amendment proposed in response to a direction under regulation 3.2B, is not allowable until after the patent has been granted.
- (5) An amendment of a complete specification for an innovation patent is not allowable if the amendment would result in the specification claiming:
 - (a) a thing mentioned in subsection 18(2) of the Act; or
 - (b) a thing mentioned in subsection 18(3) of the Act (other than a thing also mentioned in subsection 18(4) of the Act).
- (6) An amendment of a complete specification is not allowable if making an amendment would be contrary to section 112 or 112A of the Act.

10 Regulation 10.3

Repeal the regulation, substitute:

10.3 Amendments not allowable for other documents

- (1) For a provisional specification, an amendment of the provisional specification is not allowable if, as a result of the amendment, the specification would disclose matter that extends beyond that disclosed in the following documents taken together:
 - (a) the provisional specification as filed;
 - (b) an abstract that was filed with the provisional specification;
 - (c) a missing part of a provisional specification that was incorporated into the specification in accordance with regulation 3.5A.
- (2) An amendment of an abstract is not allowable.

Note: An abstract may be substituted under regulation 3.4.

11 Paragraph 10.4(a)

Omit “10.3(4)”, substitute “10.2C(3)”.

12 Paragraph 10.5(1)(b)

Omit “the Commissioner believes on reasonable grounds”, substitute “the Commissioner is satisfied, on the balance of probabilities,”.

13 Paragraph 10.5(1)(c)

Omit “the Commissioner believes on reasonable grounds”, substitute “the Commissioner is satisfied, on the balance of probabilities,”.

14 Subregulation 19.2(2)

Repeal the subregulation.

15 At the end of subregulation 22.2(2)

Add:

; (e) if the Commissioner decides to conduct a search as part of the examination of a patent request and complete specification for a standard patent, the fee is payable when the Commissioner notifies the applicant that the fee is payable.

16 Paragraph 22.2B(1)(a)

Omit “202 or 203”, substitute “202, 203 or 206”.

17 Paragraph 22.2C(1)(a)

Omit “204, 205 or 206”, substitute “204 or 205”.

18 Part 2 of Schedule 7 (table item 206)

Repeal the item, substitute:

206	Search by the Commissioner in relation to a patent request and complete specification for a standard patent as part of an examination, if the complete application was made on or after 15 April 2013	\$1,400
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19 Part 2 of Schedule 7 (table item 236)

Omit “subregulation 19.2(2) for information that requires”, substitute “regulation 3.14A for”.

20 Part 7 of Schedule 7 (after table item 236)

Insert:

236A	Preliminary search and opinion by the Commissioner in relation to a patent request and complete specification under subsection 43A(1) of the Act	\$2,200
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Schedule 3—Amendments relating to reducing delays in resolution of patent and trade mark applications

Patents Regulations 1991

1 Subregulations 1.3(4) and (5)

Repeal the subregulations, substitute:

- (4) If the Commissioner gives a document to a person, the document is taken to have been given to the person on the day the document is dated by the Commissioner.
- (5) The Commissioner may give a document to a person by:
 - (a) making the document available to the person in an electronic form; and
 - (b) notifying the person that the document is available.

2 Chapter 5

Repeal the Chapter, substitute:

Chapter 5—Opposition

Part 5.1—Preliminary

5.1 What this Chapter is about

This Chapter sets out requirements for the following:

- (a) the filing of notices of opposition and associated documents;
- (b) the amending of filed documents;
- (c) the dismissal of an opposition;
- (d) the hearing of an opposition;
- (e) associated matters.

5.2 Definitions

General

In this Chapter:

applicant means:

- (a) for a section 101M opposition—the patentee of an innovation patent; or
- (b) for any other opposition—a person whose application or request under the Act or these Regulations is opposed by an opponent.

notice of opposition means a notice filed under regulation 5.4, 5.6 or 5.10.

opponent means:

- (a) for a section 101M opposition—a person who files a notice of opposition under regulation 5.6; or
- (b) for any other opposition—a person who files a notice of opposition under regulation 5.4 or 5.10.

party means an applicant or an opponent.

procedural opposition means an opposition begun by filing a notice of opposition under regulation 5.10.

section 101M opposition means an opposition under section 101M of the Act.

statement of grounds and particulars means a statement by an opponent that sets out:

- (a) the grounds on which the opponent intends to rely; and
- (b) the facts and circumstances forming the basis for the grounds.

substantive opposition means:

- (a) an opposition begun by filing a notice of opposition under regulation 5.4; or
- (b) a section 101M opposition.

Note: The following terms are defined in Schedule 1 to the Act:

- (a) approved form;

- (b) complete specification;
- (c) file;
- (d) patent request;
- (e) patentee;
- (f) re-examination.

5.3 Commissioner may give direction about filing document or evidence

- (1) If a document or evidence may or must be filed under this Chapter, the Commissioner may give a direction specifying:
 - (a) the number of copies of the document or evidence to be filed; and
 - (b) the form in which the document or evidence is to be filed; and
 - (c) the means by which the document or evidence is to be filed.
- (2) The Commissioner may make or revoke the direction as the Commissioner sees fit.
- (3) If a party does not comply with the direction, the Commissioner may:
 - (a) treat the document or evidence as not having been filed; or
 - (b) tell the party to comply with the direction.

Part 5.2—Filing of opposition documents

Division 5.2.1—Substantive opposition

5.4 Notice of opposition—standard patent opposition

- (1) For section 59 of the Act, a person opposes the grant of a standard patent by filing a notice of opposition, in the approved form, within 3 months from the day the notice of acceptance is published under paragraph 49(5)(b) of the Act.
- (2) For subsection 75(1) of the Act, a person opposes the grant of an extension of the term of a standard patent by filing a notice of opposition, in the approved form, within 3 months from the day the

notice of acceptance is published under paragraph 74(2)(b) of the Act.

- (3) The Commissioner must give an applicant in relation to a notice of opposition filed under subregulation (1) or (2) a copy of the notice of opposition as soon as practicable.

5.5 Statement of grounds and particulars—standard patent opposition

- (1) An opponent in a substantive opposition, other than a section 101M opposition, must file a statement of grounds and particulars within 3 months from the day the notice of opposition is filed.
- (2) The statement of grounds and particulars must be:
 - (a) in the approved form; and
 - (b) accompanied by a copy of each document mentioned in the statement, unless the document:
 - (i) is open to public inspection; and
 - (ii) relates to a provisional or complete application for a patent.
- (3) The Commissioner must give the applicant a copy of the statement and accompanying documents as soon as practicable.

5.6 Notice of opposition and statement of grounds and particulars—section 101M opposition

- (1) For section 101M of the Act, a person opposes an innovation patent that has been certified by filing the following documents:
 - (a) a notice of opposition in the approved form;
 - (b) a statement of grounds and particulars;
 - (c) a copy of each document mentioned in the statement, unless the document:
 - (i) is open to public inspection; and
 - (ii) relates to a provisional or complete application for a patent.
- (2) The documents:

- (a) may be filed at any time after the certification of the patent; and
 - (b) must be filed at the same time.
- (3) The Commissioner must give copies of the documents to the applicant as soon as practicable.

5.7 Filing of evidence

- (1) A party who intends to file evidence in a substantive opposition must:
- (a) file the evidence within the relevant evidentiary period mentioned in regulation 5.8; and
 - (b) if the party files all the evidence before the end of the period—notify the Commissioner of that fact.
- (2) The Commissioner must give a copy of any evidence filed by a party under regulation 5.8 to the other party:
- (a) before the end of the period, if the Commissioner considers it appropriate to do so; or
 - (b) as soon as practicable after the relevant evidentiary period ends.
- (3) The Commissioner must, as soon as practicable, notify:
- (a) the other party of a notification under paragraph (1)(b); or
 - (b) if no notification is given under paragraph (1)(b)—the parties that:
 - (i) all the evidence for the period has been filed; or
 - (ii) no evidence was filed.

5.8 Evidentiary periods

Evidence in support

- (1) An opponent in a substantive opposition must file any evidence in support of the opposition:
- (a) for a section 101M opposition—at the same time as the documents mentioned in subregulation 5.6(1); or

- (b) for any other substantive opposition—within 3 months from the day the opponent files the statement of grounds and particulars under regulation 5.5.

Evidence in answer

- (2) If the opponent files evidence in support of the opposition, the applicant must file any evidence in answer to the evidence in support within 3 months from the day the Commissioner:
 - (a) gives the applicant:
 - (i) all the evidence in support; or
 - (ii) if the opponent files the evidence in support in instalments—the final instalment of the evidence in support; and
 - (b) notifies the applicant that all the evidence in support has been filed.
- (3) If the opponent does not file any evidence in support of the opposition, the applicant must file any evidence in answer to the statement of grounds and particulars within 3 months from the day the Commissioner notifies the applicant that no evidence in support was filed.

Evidence in reply

- (4) If the applicant files evidence in answer under subregulation (2) or (3), the opponent must file any evidence in reply to the evidence in answer within 2 months from the day the Commissioner:
 - (a) gives the opponent:
 - (i) all the evidence in answer; or
 - (ii) if the applicant files the evidence in answer in instalments—the final instalment of the evidence in answer; and
 - (b) notifies the opponent that all the evidence in answer has been filed.

5.9 Extension of time for filing evidence

- (1) The Commissioner may extend an evidentiary period mentioned in regulation 5.8:

- (a) if requested in writing by a party; or
 - (b) on the Commissioner's own initiative.
- (2) The Commissioner may extend the period only if the Commissioner is satisfied that:
- (a) the party who intended to file evidence in the period:
 - (i) has made all reasonable efforts to comply with all relevant filing requirements under this Chapter; and
 - (ii) despite acting promptly and diligently at all times to ensure the appropriate evidence is filed within the period, is unable to do so; or
 - (b) there are exceptional circumstances that warrant the extension.
- (3) The Commissioner must determine the length of the extended period having regard to what is reasonable in the circumstances.
- (4) The Commissioner must notify the parties of the extension as soon as practicable.
- (5) In this regulation:
- exceptional circumstances* includes the following:
- (a) a circumstance beyond the control of a party that prevents the party from complying with a filing requirement under this Chapter;
 - (b) an error or omission by the Commissioner that prevents a party from complying with a filing requirement under this Chapter;
 - (c) an order of a court, or a direction by the Commissioner, that the opposition be stayed pending the completion of a related proceeding or action under the Act.

Division 5.2.2—Procedural opposition

5.10 Notice of opposition

Leave to amend filed document

- (1) For subsection 104(4) of the Act, a person opposes a request for leave to amend a filed document by filing a notice of opposition, in

the approved form, within 2 months from the day the notice of the granting of leave to amend is published under subregulation 10.5(2).

Note: For the grounds on which an amendment may be opposed, see regulation 5.21.

Extension of time to do relevant act

- (2) For subsection 223(6) of the Act, a person opposes the grant of an application for an extension of time to do a relevant act by filing a notice of opposition, in the approved form, within 2 months from the day the advertisement of the extension application is advertised under subsection 223(4) of the Act.

Application for grant of licence

- (3) For subregulation 22.21(4), a person opposes the grant of a licence by filing a notice of opposition, in the approved form, within 2 months from the day the Commissioner gives the person a copy of the application under subregulation 22.21(3).

Commissioner to give copy of notice to applicant

- (4) The Commissioner must give an applicant in relation to subregulation (1), (2) or (3) a copy of the notice of opposition as soon as practicable.

5.11 Statement of grounds and particulars

- (1) An opponent in a procedural opposition must file a statement of grounds and particulars within one month from the day the notice of opposition is filed under regulation 5.10.
- (2) The statement of grounds and particulars must be:
- (a) in the approved form; and
 - (b) accompanied by a copy of each document mentioned in the statement of grounds and particulars, unless the document:
 - (i) is open to public inspection; and
 - (ii) relates to a provisional or complete application for a patent.

- (3) The Commissioner must give the applicant a copy of the statement of grounds and particulars and accompanying documents as soon as practicable.

5.12 Practice and procedure

The Commissioner may:

- (a) decide the practice and procedure to be followed in a procedural opposition; and
- (b) direct the parties accordingly.

Part 5.3—Amendments to opposition documents

5.13 Application of regulation 22.22

Regulation 22.22 does not apply to an amendment made under this Part.

5.14 Notice of opposition—correction of errors or mistake

- (1) An opponent may request the Commissioner in writing to amend the opponent's notice of opposition to correct a clerical error or obvious mistake.
- (2) The Commissioner must give the parties an opportunity to make representations about the proposed amendment.
- (3) The Commissioner must, as soon as practicable:
 - (a) notify the parties of the Commissioner's decision; and
 - (b) if the Commissioner decides to make the amendment—give the applicant a copy of the amended notice of opposition.

5.15 Notice of opposition—change of opponent

- (1) This regulation applies if an opponent's right or interest in an opposition is transferred to another person (the *new opponent*) during an opposition.
- (2) The new opponent may:

- (a) tell the Commissioner that the right or interest in the opposition has been transferred to the new opponent; and
 - (b) request the Commissioner in writing to amend the notice of opposition to record the new opponent's name.
- (3) The Commissioner must give the applicant, the opponent and the new opponent an opportunity to make representations about the amendment.
- (4) The Commissioner must:
- (a) as soon as practicable:
 - (i) notify the parties of the Commissioner's decision; and
 - (ii) if the Commissioner decides to make the amendment—give the applicant a copy of the amended notice of opposition; and
 - (b) ensure that the opposition proceeds in the name of the new opponent.

5.16 Statement of grounds and particulars

- (1) An opponent may request the Commissioner in writing to amend the opponent's statement of grounds and particulars:
- (a) to correct an error or omission in the grounds of opposition; or
 - (b) to update the grounds of opposition to reflect an amendment to the patent request or complete specification to which the statement relates; or
 - (c) to amend the facts and circumstances forming the basis for the grounds.
- (2) The Commissioner must:
- (a) notify the applicant of the opponent's request; and
 - (b) give the parties an opportunity to make representations about the amendment.
- (3) The Commissioner must not make the amendment if:
- (a) the Commissioner is considering an application for dismissal of the opposition under Part 5.4; or
 - (b) for an opposition begun under subregulation 5.4(1):

- (i) the applicant's complete specification is being re-examined; and
 - (ii) the re-examination is not completed as required by regulation 9.5.
- (4) The Commissioner must make the amendment if:
- (a) subregulation (3) does not apply; and
 - (b) the Commissioner is satisfied that the amendment should be made.
- (5) The Commissioner must, as soon as practicable:
- (a) notify the parties of the Commissioner's decision; and
 - (b) if the Commissioner decides to make the amendment—give the applicant a copy of the amended statement.

Part 5.4—Dismissal of opposition

5.17 Dismissal on request

- (1) An applicant may request the Commissioner to dismiss an opposition:
- (a) within one month from the day the Commissioner gives the applicant a copy of the statement of grounds and particulars under subregulation 5.5(3), 5.6(3) or 5.11(3); or
 - (b) if the applicant's complete specification is re-examined under subsection 97(1) of the Act—within one month from the day the re-examination is completed as required by regulation 9.5.
- (2) The request must be in the approved form.
- (3) The Commissioner must give the opponent a copy of the request as soon as practicable.
- (4) If the Commissioner decides to dismiss the opposition, the Commissioner must, as soon as practicable, notify the parties of the decision.

Note: For the requirements the Commissioner must satisfy when exercising a discretionary power adversely to a person, see regulation 22.22.

5.18 Dismissal on initiative of Commissioner

- (1) The Commissioner may dismiss an opposition if the Commissioner considers it appropriate to do so.
- (2) The grounds on which the Commissioner may dismiss the opposition include an opponent's failure to file a statement of grounds and particulars or document mentioned in the statement in accordance with regulation 5.5, 5.6 or 5.11.
- (3) If the Commissioner decides to dismiss the opposition, the Commissioner must notify the parties of the decision as soon as practicable.

Note: For the requirements the Commissioner must satisfy when exercising a discretionary power adversely to a person, see regulation 22.22.

Part 5.5—Hearing of opposition

5.19 Hearing and decision—re-examination

- (1) This regulation applies to an opposition if:
 - (a) the applicant's complete specification is re-examined under subsection 97(1) of the Act; and
 - (b) the re-examination is completed as required by regulation 9.5.
- (2) The Commissioner may hear and decide the opposition:
 - (a) on the Commissioner's own initiative, if the Commissioner considers it appropriate to do so; or
 - (b) at the opponent's request, if the request is made:
 - (i) less than one month after the re-examination is completed as required by regulation 9.5; and
 - (ii) in the approved form.
- (3) The Commissioner must give the applicant a copy of a request under paragraph (2)(b) as soon as practicable.
- (4) The Commissioner must notify the parties of the decision as soon as practicable.

5.20 Hearing and decision—other circumstances

- (1) This regulation applies to an opposition if:
 - (a) the periods for filing evidence have ended; and
 - (b) the notice of opposition has not been withdrawn under regulation 5.26; and
 - (c) the opposition has not been dismissed under Part 5.4 or heard and decided under regulation 5.19.
- (2) The Commissioner:
 - (a) must hold a hearing of the opposition if requested by a party in writing; or
 - (b) may decide, on the Commissioner's own initiative, to hold a hearing of the opposition.
- (3) The hearing may, at the Commissioner's discretion, be:
 - (a) an oral hearing; or
 - (b) by written submissions.
- (4) If the Commissioner decides on an oral hearing:
 - (a) the Commissioner must notify the parties of the date, time and place of the hearing; and
 - (b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
 - (c) the applicant must file a summary of submissions at least 5 business days before the hearing; and
 - (d) the Commissioner must give a copy of each party's summary of submissions to the other party as soon as practicable.
- (5) The Commissioner must:
 - (a) decide the opposition; and
 - (b) notify the parties of the Commissioner's decision.
- (6) The Commissioner, in making an award of costs in relation to an opposition under subregulation 22.8(2), may consider a failure by a party to file a summary of submissions under subregulation (4).

Part 5.6—Miscellaneous

5.21 Opposition to amendment—grounds

For subsection 104(4) of the Act, an opposition to an amendment may be made only on the ground that the amendment is not allowable under:

- (a) section 102 of the Act; or
- (b) regulation 10.3.

Note: For the period for filing a notice of opposition to the allowance of an amendment, see subregulation 5.10(1).

5.22 Commissioner may give directions

- (1) The Commissioner may give a direction in relation to an opposition to which this Chapter applies:
 - (a) if requested by a party in writing; or
 - (b) on the Commissioner's own initiative.
- (2) If the Commissioner proposes to give a direction, the Commissioner must give the parties an opportunity to make representations about the direction.
- (3) A direction must not be inconsistent with the Act or these Regulations.
- (4) The Commissioner must notify the parties of the direction as soon as practicable.

5.23 Commissioner may consult documents

- (1) For the purposes of deciding an opposition, the Commissioner may consult a document that:
 - (a) is relevant to the opposition; and
 - (b) has not been filed under this Chapter; and
 - (c) is available in the Patent Office.
- (2) If the Commissioner proposes to rely on the document, the Commissioner must give the parties:
 - (a) notice of the Commissioner's intention to do so; and

- (b) a copy of, or access to, the document; and
- (c) an opportunity to give evidence or make representations about the document.

5.24 Representations to Commissioner—formal requirements

A representation mentioned in a provision of this Chapter may be made to the Commissioner by any means approved by the Commissioner.

5.25 Extension of time for filing—amendment at Commissioner’s direction

- (1) This regulation applies if:
 - (a) the Commissioner directs an applicant to file a statement of proposed amendments under subsection 107(1) of the Act; and
 - (b) a period for filing a document under this Chapter begins or ends during the amendment period.
- (2) The period for filing the document is extended by the equivalent of the amendment period.
- (3) In this regulation:

amendment period means the period that:

- (a) begins on the day the applicant is given an opportunity to be heard under subsection 107(2) of the Act; and
- (b) ends on the day the Commissioner decides whether to allow the amendment.

5.26 Withdrawal of opposition

- (1) An opponent may withdraw an opposition at any time by filing a signed notice of withdrawal in the approved form.
- (2) The Commissioner must give the applicant a copy of the notice of withdrawal as soon as practicable.

3 Chapter 6A

Repeal the Chapter, substitute:

Chapter 6A—Divisional applications

6A.1 Divisional applications before grant—standard and innovation patents

- (1) For paragraph 79B(2)(a) and subparagraph 79B(3)(b)(iv) of the Act, a further complete application must:
 - (a) be made in accordance with section 29 of the Act; and
 - (b) be filed:
 - (i) if the first application is for a standard patent—no later than 3 months from the day the notice of acceptance of the first application is published under paragraph 49(5)(b) of the Act; or
 - (ii) if the first application is for an innovation patent—before the grant of the patent under subsection 62(1) of the Act.

Note: For the definition of *first application*, see section 79B of the Act.

- (2) For paragraph 79B(2)(b) of the Act, the particulars are:
 - (a) a statement that the application is a further complete application for section 79B of the Act; and
 - (b) the number of the first application.

6A.2 Divisional applications after grant—innovation patents

- (1) For paragraph 79C(1A)(a) and subparagraph 79C(2)(b)(iv) of the Act, a further complete application must be:
 - (a) made in accordance with section 29 of the Act; and
 - (b) filed no later than one month from the day the notice of the occurrence of the examination of the first patent is published under paragraph 101E(2)(b) of the Act.

Note: For the definition of *first patent*, see section 79C of the Act.

- (2) For paragraph 79C(1A)(b) of the Act, the particulars are:
 - (a) a statement that the application is a further complete application for section 79C of the Act; and
 - (b) the number of the first patent.

4 Subregulations 13.1A(1) and 13.1B(1)

Omit “subsection 141(1)”, substitute “paragraph 141(1)(c)”.

5 Subregulation 22.10(3)

Repeal the subregulation.

6 Regulation 22.10AC

Repeal the regulation, substitute:

22.10AC Prescribed acts

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

- (a) lodging a return under section 76A of the Act;
- (b) an act done in relation to proceedings in a court or a tribunal;
- (c) an act done under Chapter 20.

7 Subregulation 22.11(4)

Repeal the subregulation, substitute:

- (4) For the definition of *relevant act* in subsection 223(11) of the Act, the following are prescribed:
 - (a) an action mentioned in Chapter 5, other than an action or step taken under regulation 5.4, 5.5, 5.10 or 5.11;
 - (b) filing, during the term of a standard patent under subsection 71(2) of the Act, an application under subsection 70(1) of the Act for an extension of the term of the patent;
 - (c) an action mentioned in Chapter 20.

8 Subregulations 22.21(3) and (4)

Repeal the subregulations, substitute:

- (3) The Commissioner must give a copy of the application to:
 - (a) a person whose application was restored under section 150 of the Act; or
 - (b) a patent applicant or patentee of the application or patent for which an extension of time was granted under section 223 of the Act; or

(c) the patent applicant or patentee of the application or patent to which subsection 41(4) of the Act applies;
and to any other person the Commissioner believes to have an interest in the application.

(4) A person mentioned in subregulation (3) may oppose the grant of the licence to which the application relates.

9 Part 2 of Schedule 7 (table items 216 to 220)

Repeal the items, substitute:

216	Filing a notice of opposition under regulation 5.4, 5.6 or 5.10	\$600
217	Filing a request under subregulation 5.17(1) for dismissal of opposition	\$600
218	Filing an application under subregulation 5.9(1) for an extension of time	\$500 for each month or part of a month for which the extension is sought
219	Making a representation to the Commissioner, under subregulation 5.14(2) or 5.15(3) or paragraph 5.16(2)(b), objecting to a proposed amendment	\$600
220	Making a representation to the Commissioner under subregulation 5.22(2) objecting to a proposed direction	\$600

Trade Marks Regulations 1995

10 After regulation 2.2

Insert:

2.3 Giving of documents by Registrar

- (1) In these Regulations, the Registrar may give a document to a person by:
- (a) making the document available to the person in an electronic form; and
 - (b) notifying the person that the document is available.

- (2) If the Registrar gives a document to a person, the document is taken to have been given to the person on the day the document is dated by the Registrar.

11 Part 5

Repeal the Part, substitute:

Part 5—Opposition to registration

Division 1—Preliminary

5.1 What Part 5 is about

This Part sets out requirements for the following:

- (a) the filing of notices of opposition and associated documents;
- (b) the amending of filed documents;
- (c) the dismissal of an opposition;
- (d) a cooling-off period for an opposition;
- (e) the hearing of an opposition;
- (f) associated matters.

5.2 Definitions

In this Part:

notice of intention to defend means a notice filed under regulation 5.13.

notice of intention to oppose means a notice filed under regulation 5.6.

notice of opposition means:

- (a) a notice of intention to oppose; and
- (b) a statement of grounds and particulars.

party means an applicant or opponent.

statement of grounds and particulars means a statement by an opponent that sets out:

- (a) the grounds on which the opponent intends to rely; and
-

- (b) the facts and circumstances forming the basis for the grounds.

trade mark application means an application for registration of a trade mark under section 27 of the Act.

Note: The following terms are defined in section 6 of the Act:

- (a) applicant;
- (b) approved form;
- (c) employee;
- (d) file;
- (e) month;
- (f) opponent;
- (g) person.

5.3 Registrar may give direction about filing document or evidence

- (1) If a document or evidence may or must be filed under this Part, the Registrar may give a direction specifying:
 - (a) how many copies of the document or evidence must be filed; and
 - (b) the form in which the document or evidence is to be filed; and
 - (c) the means by which the document or evidence is to be filed.
- (2) If a party does not comply with the direction, the Registrar may:
 - (a) treat the document or evidence as not having been filed; or
 - (b) tell the party to comply with the direction.
- (3) The Registrar may make or revoke the direction as the Registrar sees fit.
- (4) Regulation 5.4 does not apply to the Registrar's decision to make or revoke the direction.

5.4 Notification and opportunity to make representations

- (1) This regulation applies if:
 - (a) a party makes a request to the Registrar under this Part; or
 - (b) the Registrar proposes to make a decision on the Registrar's own initiative under this Part.

- (2) The Registrar must:
 - (a) for paragraph (1)(a)—notify the other party of the request, including by giving the other party a copy of the request; or
 - (b) for paragraph (1)(b)—notify the parties of the proposed decision.
- (3) If the Registrar proposes to grant the request, the Registrar must give the parties an opportunity to make representations:
 - (a) in writing; or
 - (b) at a hearing; or
 - (c) by other means that the Registrar states in the notification.
- (4) The Registrar must notify the parties of the decision.

Division 2—Filing of opposition documents

Subdivision A—Notice of opposition

5.5 Filing of notice of opposition

A notice of opposition is taken to be filed when the notice of intention to oppose and the statement of grounds and particulars have been filed under regulations 5.6 and 5.7.

5.6 Filing of notice of intention to oppose

- (1) For subsection 52(2) of the Act, the period for filing a notice of intention to oppose is 2 months from the day the acceptance of the trade mark application is advertised in the *Official Journal* under paragraph 34(b) of the Act.
- (2) The notice must be in an approved form.
- (3) The Registrar must give a copy of the notice to the applicant.

5.7 Filing of statement of grounds and particulars

- (1) A statement of grounds and particulars must be filed within one month from the day the notice of intention to oppose is filed.
- (2) The statement must be in an approved form.

5.8 Statement of grounds and particulars must be adequate

- (1) The Registrar must assess the adequacy of a statement of grounds and particulars.
- (2) If the Registrar decides that the statement is adequate, the Registrar must give a copy of the statement to the applicant.
- (3) If the Registrar decides that the statement is inadequate:
 - (a) the Registrar may direct the opponent to rectify the inadequacy by filing more information on the basis for one or more of the grounds; or
 - (b) if all the grounds are inadequately particularised, the Registrar may dismiss the opposition; or
 - (c) if only some of the grounds are inadequately particularised, the Registrar may:
 - (i) delete from the statement some or all of the material that is inadequate; and
 - (ii) treat the result as the statement for the purposes of these Regulations; and
 - (iii) give a copy of the amended statement to the opponent.
- (4) If the Registrar decides that the statement is still inadequate after the information is filed under paragraph (3)(a):
 - (a) the Registrar may dismiss the opposition; or
 - (b) the Registrar may:
 - (i) delete from the statement some or all of the material that is inadequate; and
 - (ii) treat the result as the statement for the purposes of these Regulations; and
 - (iii) give a copy of the amended statement to the opponent.
- (5) If the Registrar decides that the information filed under paragraph (3)(a) rectifies the inadequacy of the statement, the Registrar must give a copy of the statement and the information filed in relation to paragraph (3)(a) to the applicant.
- (6) The opponent may apply to the Administrative Appeals Tribunal for review of a decision under this regulation to dismiss the opposition or delete material from the statement of grounds and particulars.

(7) Regulation 5.4 does not apply to this regulation.

5.9 Extension of time for filing—application

- (1) A person who intends to oppose an application under subsection 52(1) of the Act may request the Registrar to extend:
- (a) the period for filing a notice of intention to oppose under subregulation 5.6(1); or
 - (b) the period for filing a statement of grounds and particulars under subregulation 5.7(1).

- (2) A request under paragraph (1)(a) or (b) may be made:
- (a) within the period for filing the document in question; or
 - (b) before the trade mark is entered on the Register under section 69 of the Act.

Note: See subparagraph (3)(b)(ii) and subregulation 5.10(2) in relation to the consequences of making the request after the filing period has ended.

- (3) The request must:
- (a) be in an approved form; and
 - (b) be accompanied by a declaration stating:
 - (i) the facts and circumstances forming the basis for the grounds; and
 - (ii) if the period for filing the notice or the statement of grounds and particulars has ended—the reason why the request was not made within the period.

Note: Regulations 21.6 and 21.7 deal with making and filing declarations.

- (4) The request may be made only on either or both of the following grounds:
- (a) an error or omission by the person, the person's agent, the Registrar or an employee;
 - (b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.

5.10 Extension of time for filing—grant

- (1) The Registrar may grant a request under subregulation 5.9(1) for an extension of time only if the Registrar is satisfied that the grounds set out in the request justify the extension.
- (2) However, if the request is made after the period for filing the notice or statement of grounds and particulars has ended, the Registrar must not grant the extension unless the Registrar is satisfied that there is sufficient reason for the delay in making the request.
- (3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

5.11 Amendment of notice of intention to oppose

- (1) An opponent may request the Registrar to amend a notice of intention to oppose to correct a clerical error or obvious mistake.
- (2) If an opposition is proceeding in the name of another person (the *new opponent*) under section 53 of the Act, the new opponent may request the Registrar to amend the notice of intention to oppose to record the new opponent's name.
- (3) The Registrar may grant the request on terms that the Registrar considers appropriate.
- (4) If the Registrar grants the request, the Registrar must give a copy of the amended notice of intention to oppose to the applicant.
- (5) Regulation 5.4 does not apply to a request under subregulation (1) or (2).

5.12 Amendment of statement of grounds and particulars

- (1) An opponent may request the Registrar to amend the statement of grounds and particulars to:
 - (a) correct an error or omission in the grounds of opposition or the facts and circumstances forming the basis for the grounds; or
 - (b) amend a ground of opposition; or

- (c) add a new ground of opposition; or
 - (d) to amend the facts and circumstances forming the basis for the grounds.
- (2) The Registrar may grant the request on terms that the Registrar considers appropriate.
- (3) However, the Registrar may grant a request to:
- (a) amend a ground of opposition; or
 - (b) add a new ground of opposition;
- only if the Registrar is satisfied that the amendment or addition relates to information of which the opponent could not reasonably have been aware at the time of filing the statement.
- (4) If the Registrar grants the request, the Registrar must give a copy of the amended statement to the applicant.

Subdivision B—Notice of intention to defend

5.13 Filing of notice of intention to defend

- (1) For subsection 52A(2) of the Act, a notice of intention to defend must be filed within one month from the day the applicant is given a copy of the statement of grounds and particulars.
- (2) The Registrar must give a copy of the notice to the opponent.

Subdivision C—Evidence

5.14 Filing of evidence

- (1) The Registrar must notify the parties that:
- (a) all the evidence for an evidentiary period mentioned in this regulation has been filed; or
 - (b) no evidence was filed for the period.
- (2) The Registrar must give a copy of any evidence filed by a party under this regulation to the other party:
- (a) before the end of the relevant evidentiary period, if the Registrar considers it appropriate to do so; or
 - (b) after the evidentiary period ends.

Evidence in support

- (3) An opponent must file any evidence in support of the opposition within 3 months from the day the opponent is given a copy of the notice of intention to defend.

Evidence in answer

- (4) If the opponent files evidence in support of the opposition, the applicant must file any evidence in answer to the evidence in support within 3 months from the day the Registrar:
- (a) gives the applicant:
 - (i) all the evidence in support; or
 - (ii) if the opponent files the evidence in support in instalments—the final instalment of the evidence in support; and
 - (b) notifies the applicant that all the evidence in support has been filed.
- (5) If the opponent does not file any evidence in support of the opposition, the applicant must file any evidence in answer to the statement of grounds and particulars within 3 months from the day the Registrar notifies the applicant that no evidence in support was filed.

Evidence in reply

- (6) If the applicant files evidence in answer under subregulation (4) or (5), the opponent must file any evidence in reply to the evidence in answer within 2 months from the day the Registrar:
- (a) gives the opponent:
 - (i) all the evidence in answer; or
 - (ii) if the applicant files the evidence in answer in instalments—the final instalment of the evidence in answer; and
 - (b) notifies the opponent that all the evidence in answer has been filed.

5.15 Extension of time for filing

- (1) A party may request the Registrar to extend a period for filing evidence mentioned in regulation 5.14.
- (2) The Registrar may extend the period only if the Registrar is satisfied that:
 - (a) the party:
 - (i) has made all reasonable efforts to comply with all relevant filing requirements of this Part; and
 - (ii) despite acting promptly and diligently at all times to ensure the filing of the evidence within the period, is unable to do so; or
 - (b) there are exceptional circumstances that justify the extension.
- (3) The Registrar:
 - (a) must decide the length of the extended period having regard to what is reasonable in the circumstances; and
 - (b) may do so on terms that the Registrar considers appropriate.
- (4) In this regulation:

exceptional circumstances includes the following:

- (a) a circumstance beyond the control of a party that prevents the party from complying with a filing requirement under this Part;
- (b) an error or omission by the Registrar or an employee that prevents a party from complying with a filing requirement under this Part;
- (c) an order of a court or a direction by the Registrar that the opposition be stayed.

Division 3—Cooling-off period for opposition

5.16 Registrar may allow cooling-off period

- (1) This regulation applies to an opposition if:
 - (a) the notice of opposition has been filed; and
 - (b) the Registrar has not made a decision on the opposition under subsection 55(1) of the Act; and

- (c) the opposition has not been dismissed under section 222 of the Act or regulation 5.8.
- (2) If the Registrar is satisfied that the parties agree to a cooling-off period, the Registrar must allow a cooling-off period of 6 months.
- (3) The Registrar must extend the cooling-off period for 6 months if, before the end of the period, the Registrar is satisfied that the parties agree to the extension.
- (4) The Registrar must not:
 - (a) further extend the cooling-off period; or
 - (b) allow more than one cooling-off period for an opposition.
- (5) If a party files a notice, in an approved form, requesting the Registrar to discontinue the cooling-off period, the Registrar must do so.
- (6) The Registrar may direct the parties on steps the parties must take:
 - (a) if the cooling-off period is discontinued; or
 - (b) otherwise—when the cooling-off period ends.
- (7) The opposition resumes:
 - (a) if the cooling-off period is discontinued; or
 - (b) otherwise—when the cooling-off period ends.
- (8) If:
 - (a) the cooling-off period begins during the period mentioned in regulation 5.13 or an evidentiary period mentioned in regulation 5.14; and
 - (b) the opposition resumes;the period mentioned in regulation 5.13 or 5.14 restarts when the opposition resumes.

Division 4—Hearing of opposition

5.17 Hearing

- (1) This regulation applies to an opposition if:
 - (a) the opposition has not:

Schedule 3 Amendments relating to reducing delays in resolution of patent and trade mark applications

- (i) been dismissed under section 222 of the Act or paragraph 5.8(3)(b) or 5.8(4)(a); or
 - (ii) been decided under subsection 55(1) of the Act; and
 - (b) the trade mark application to which the opposition relates has not lapsed under section 54A of the Act.
- (2) An applicant may request the Registrar to hold a hearing if:
- (a) the evidentiary period mentioned in subregulation 5.14(3) has ended; and
 - (b) either:
 - (i) all evidence for the opposition proceeding has been filed; or
 - (ii) no evidence has been filed in that period.
- (3) A party may request the Registrar to hold a hearing if:
- (a) an evidentiary period mentioned in any of subregulations 5.14(4) to (6) has ended; and
 - (b) either:
 - (i) all evidence for the opposition proceeding has been filed; or
 - (ii) no evidence has been filed in that period.
- (4) The Registrar:
- (a) must hold a hearing of the opposition if requested by a party; or
 - (b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.
- (5) The hearing may, at the Registrar's discretion, be:
- (a) an oral hearing; or
 - (b) by written submissions.
- (6) If the Registrar decides on an oral hearing:
- (a) the Registrar must notify the parties of the date, time and place of the hearing; and
 - (b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
 - (c) the applicant must file a summary of submissions at least 5 business days before the hearing.

- (7) The Registrar may take into account a party's failure to file a summary of submissions under subregulation (6) in making an award of costs.

Note: Regulations 21.15 and 21.16 deal with hearings.

Division 5—Miscellaneous

5.18 Copy of earlier Convention application to be available to opponent

- (1) In opposition proceedings relating to an application in respect of which the applicant claims a right of priority, an opponent may request the Registrar for a copy of an earlier application to be made available.
- (2) On receiving the request, the Registrar must require the applicant to file:
- (a) a copy of the earlier application certified in the trade marks office (or its equivalent) of the Convention country in which it was filed; and
 - (b) if the earlier application is not in English:
 - (i) a translation of the earlier application into English; and
 - (ii) a certificate of verification relating to the translation.
- (3) Subregulation (2) does not apply if the applicant has already filed the relevant documents.
- (4) The Registrar must give a copy of the documents to the opponent.
- (5) If the applicant is the successor in title to the person who made the earlier application, the Registrar may require the applicant to provide documentary evidence that is sufficient to establish the passing of title to the applicant.

5.19 Registrar may give direction

- (1) The Registrar may give a direction in relation to an opposition to which this Part applies:
- (a) if requested by a party in writing; or
 - (b) on the Registrar's own initiative.

- (2) If the Registrar proposes to give a direction, the Registrar must give the parties an opportunity to make representations about the direction.
- (3) A direction must not be inconsistent with the Act or these Regulations.
- (4) The Registrar must notify the parties of the direction as soon as practicable.

5.20 Registrar must notify parties of dismissal or discontinuance of opposition

If an opposition is dismissed under section 222 of the Act or regulation 5.8 or discontinued, the Registrar must notify the parties of the dismissal or discontinuance.

12 Before regulation 6.1

Insert:

Division 1—Amendment of application for registration of trade mark and other documents

13 Regulations 6.5 and 6.6

Repeal the regulations, substitute:

Division 2—Opposition to amendment after particulars published

6.5 Definitions

In this Division:

notice of opposition means a notice filed under subregulation 6.6(1).

party means an applicant or opponent.

Note: The following terms are defined in section 6 of the Act:

- (a) applicant;
- (b) approved form;

- (c) file;
- (d) month;
- (e) person.

6.6 Notice of opposition

- (1) For subsection 65A(4) of the Act, a person may oppose a request for amendment by filing a notice of opposition, in an approved form, within one month from the advertisement of the request for amendment in the *Official Journal* under subsection 65A(3) of the Act.
- (2) The Registrar must give a copy of the notice to the applicant.

6.7 Notification and opportunity to make representations

- (1) This regulation applies if:
 - (a) a party makes a request to the Registrar under this Division; or
 - (b) the Registrar proposes to make a decision on the Registrar's own initiative under this Division.
- (2) The Registrar must:
 - (a) for paragraph (1)(a)—notify the other party of the request, including by giving the other party a copy of the request; or
 - (b) for paragraph (1)(b)—notify the parties of the proposed decision.
- (3) If the Registrar proposes to grant the request, the Registrar must give the parties an opportunity to make representations:
 - (a) in writing; or
 - (b) at a hearing; or
 - (c) by other means that the Registrar states in the notification.
- (4) The Registrar must notify the parties of the Registrar's decision.

6.8 Practice and procedure

The Registrar may:

- (a) decide the practice and procedure to be followed in an opposition to which this Division applies; and

- (b) direct the parties accordingly.

6.9 Hearing

- (1) The Registrar:
 - (a) must hold a hearing of the opposition if requested by a party in writing; or
 - (b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.
- (2) The hearing may, at the Registrar's discretion, be:
 - (a) an oral hearing; or
 - (b) by written submissions.
- (3) If the Registrar decides on an oral hearing:
 - (a) the Registrar must notify the parties of the date, time and place of the hearing; and
 - (b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
 - (c) the applicant must file a summary of submissions at least 5 business days before the hearing.
- (4) The Registrar may take into account a party's failure to file a summary of submissions under subregulation (3) in making an award of costs.

Note: Regulations 21.15 and 21.16 deal with hearings.
- (5) The Registrar must:
 - (a) decide the opposition; and
 - (b) notify the parties of the Registrar's decision.

6.10 Registrar may give direction

- (1) The Registrar may give a direction in relation to an opposition to which this Division applies:
 - (a) if requested by a party in writing; or
 - (b) on the Registrar's own initiative.

- (2) If the Registrar proposes to give a direction, the Registrar must give the parties an opportunity to make representations about the direction.
- (3) A direction must not be inconsistent with the Act or these Regulations.
- (4) The Registrar must notify the parties of the direction as soon as practicable.

6.11 Registrar must notify parties of dismissal or discontinuance of opposition

If an opposition is dismissed or discontinued, the Registrar must notify the parties of the dismissal or discontinuance.

14 Part 9

Repeal the Part, substitute:

Part 9—Removal of trade mark from Register for non-use

Division 1—Preliminary

9.1 What Part 9 is about

This Part sets out requirements for the following:

- (a) the making and notification of an application for removal;
- (b) the filing of notices of opposition and associated documents;
- (c) the amending of filed documents;
- (d) the dismissal of an opposition;
- (e) the hearing of an opposition;
- (f) associated matters.

9.2 Definitions

In this Part:

application for removal means an application for removal of a trade mark from the Register.

notice of intention to defend means a notice filed under regulation 9.15.

notice of intention to oppose means a notice filed under regulation 9.8.

notice of opposition means:

- (a) a notice of intention to oppose; and
- (b) a statement of grounds and particulars.

opponent means a person who files:

- (a) a notice of intention to oppose; and
- (b) a statement of grounds and particulars.

party means an applicant or opponent.

statement of grounds and particulars means a statement by an opponent that sets out:

- (a) the grounds for removal that the opponent intends to rebut; and
- (b) the facts and circumstances that form the basis for the opposition to the removal.

Note: The following terms are defined in section 6 of the Act:

- (a) applicant;
- (b) approved form;
- (c) employee;
- (d) file;
- (e) month;
- (f) person.

9.3 Registrar may give direction about filing document or evidence

- (1) If a document or evidence may or must be filed under this Part, the Registrar may give a direction specifying:
 - (a) how many copies of the document or evidence must be filed; and
 - (b) the form in which the document or evidence is to be filed; and

- (c) the means by which the document or evidence is to be filed.
- (2) If a party does not comply with the direction, the Registrar may:
 - (a) treat the document or evidence as not having been filed; or
 - (b) tell the party to comply with the direction.
- (3) The Registrar may make or revoke the direction as the Registrar sees fit.
- (4) Regulation 9.4 does not apply to the Registrar's decision to make or revoke the direction.

9.4 Notification and opportunity to make representations

- (1) This regulation applies if:
 - (a) a party makes a request to the Registrar under this Part; or
 - (b) the Registrar proposes to make a decision on the Registrar's own initiative under this Part.
- (2) The Registrar must:
 - (a) for paragraph (1)(a)—notify the other party of the request, including by giving the other party a copy of the request; or
 - (b) for paragraph (1)(b)—notify the parties of the proposed decision.
- (3) If the Registrar proposes to grant the request, the Registrar must give the parties an opportunity to make representations:
 - (a) in writing; or
 - (b) at a hearing; or
 - (c) by other means that the Registrar states in the notification.
- (4) The Registrar must notify the parties of the Registrar's decision.

Division 2—Application for removal

9.5 Application for removal

For paragraph 92(2)(a) of the Act, an application for removal must be in an approved form.

9.6 Notification of application

For subsection 95(1) of the Act, the Registrar must, within one month from the filing of the application, give a copy of the application to each person who, in the Registrar's opinion, should receive one.

Division 3—Filing of opposition documents

Subdivision A—Notice of opposition

9.7 Filing of notice of opposition

A notice of opposition is taken to be filed when the notice of intention to oppose and the statement of grounds and particulars have been filed under regulations 9.8 and 9.9.

9.8 Filing of notice of intention to oppose

- (1) For subsection 96(2) of the Act, the period for filing a notice of intention to oppose is 2 months from the day the application for removal is advertised in the *Official Journal*.
- (2) The notice must be in an approved form.
- (3) The Registrar must give a copy of the notice to the applicant.

9.9 Filing of statement of grounds and particulars

- (1) A statement of grounds and particulars must be filed within one month from the day the notice of intention to oppose is filed.
- (2) The statement must be in an approved form.

9.10 Statement of grounds and particulars must be adequate

- (1) The Registrar must assess the adequacy of a statement of grounds and particulars filed under regulation 9.9.
- (2) If the Registrar decides that the statement is adequate, the Registrar must give a copy of the statement to the applicant.

- (3) If the Registrar decides that the statement is inadequate, the Registrar may:
 - (a) direct the opponent to rectify the inadequacy by filing more information on the basis for the opposition to the grounds for removal; or
 - (b) dismiss the opposition.
- (4) If the Registrar decides that the information filed under paragraph (3)(a) rectifies the inadequacy of the statement, the Registrar must give a copy of the statement and the information to the applicant.
- (5) For subsection 99A(1) of the Act, the Registrar may dismiss the opposition if:
 - (a) the Registrar decides that the statement is inadequate; or
 - (b) the Registrar has directed the opponent to file information under paragraph (3)(a) and:
 - (i) the opponent fails to file the information; or
 - (ii) the Registrar decides that the information filed does not rectify the inadequacy of the statement.
- (6) Regulation 9.4 does not apply to this regulation.

Note: For review rights in relation to a decision by the Registrar to dismiss an opposition, see subsection 99A(2) of the Act.

9.11 Extension of time for filing—application

- (1) A person who intends to oppose an application for removal may request the Registrar to extend:
 - (a) the period for filing a notice of intention to oppose under subregulation 9.8(1); or
 - (b) the period for filing a statement of grounds and particulars under subregulation 9.9(1).
- (2) A request under paragraph (1)(a) or (b) may be made within the period for filing the document in question.

Note: See subparagraph (3)(b)(ii) and subregulation 9.12(2) in relation to the consequences of making the request after the filing period has ended.

- (3) The request must:
 - (a) be in an approved form; and
-

- (b) be accompanied by a declaration stating:
 - (i) the facts and circumstances forming the basis for the grounds; and
 - (ii) if the period for filing the notice of intention to oppose or the statement of grounds and particulars has ended—the reason why the request was not made within the period.

Note: Regulations 21.6 and 21.7 deal with making and filing declarations.

- (4) The request may be made only on either or both of the following grounds:
 - (a) an error or omission by the person, the person's agent, the Registrar or an employee;
 - (b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.

9.12 Extension of time for filing—grant

- (1) The Registrar may grant a request under subregulation 9.11(1) for an extension of time only if the Registrar is satisfied that the grounds set out in the request justify the extension.
- (2) However, if the request is made after the period for filing the notice or statement of grounds and particulars has ended, the Registrar must not grant the extension unless the Registrar is satisfied that there is sufficient reason for the delay in making the request.
- (3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

9.13 Amendment of notice of intention to oppose

- (1) An opponent may request the Registrar to amend a notice of intention to oppose to correct a clerical error or obvious mistake.
- (2) If an opposition is proceeding in the name of a person other than the opponent under section 96A of the Act, the person may request the Registrar to amend the notice of intention to oppose to record the person's name.

- (3) The Registrar may grant the request on terms that the Registrar considers appropriate.
- (4) If the Registrar grants the request, the Registrar must give a copy of the amended notice of intention to oppose to the applicant.
- (5) Regulation 9.4 does not apply to this regulation.

9.14 Amendment of statement of grounds and particulars

- (1) An opponent may request the Registrar to amend the statement of grounds and particulars to:
 - (a) correct an error or omission; or
 - (b) amend or add facts or circumstances that form the basis of the opposition to the removal.
- (2) The Registrar may grant the request on terms that the Registrar considers appropriate.
- (3) However, the Registrar may grant the request only if the Registrar is satisfied that the amendment should be made.
- (4) If the Registrar grants the request, the Registrar must give a copy of the amended statement to the applicant.

Subdivision B—Notice of intention to defend

9.15 Filing of notice of intention to defend

- (1) A notice of intention to defend must be filed within one month from the day the applicant is given a copy of the statement of grounds and particulars.
- (2) The Registrar must give the opponent a copy of the notice.
- (3) If the applicant does not file the notice of intention to defend within the period mentioned in subregulation (1), the Registrar may decide to:
 - (a) take the opposition to have succeeded; and
 - (b) refuse to remove the trade mark from the Register.
- (4) The Registrar must notify the parties of the Registrar's decision.

Subdivision C—Evidence

9.16 Filing of evidence

- (1) The Registrar must notify the parties that:
 - (a) all the evidence for an evidentiary period mentioned in this regulation has been filed; or
 - (b) no evidence was filed for the period.
- (2) The Registrar must give a copy of any evidence filed by a party under this regulation to the other party:
 - (a) before the end of the relevant evidentiary period, if the Registrar considers it appropriate to do so; or
 - (b) after the evidentiary period ends.

Evidence in support

- (3) An opponent must file any evidence in support of the opposition within 3 months from the day the opponent is given a copy of the notice of intention to defend the application for removal.

Evidence in answer

- (4) If the opponent files evidence in support of the opposition, the applicant must file any evidence in answer to the opponent's evidence within 3 months from the day the Registrar:
 - (a) gives the applicant:
 - (i) all the evidence in support; or
 - (ii) if the opponent files the evidence in support in instalments—the final instalment of the evidence in support; and
 - (b) notifies the applicant that all the evidence in support has been filed.
- (5) If the opponent does not file any evidence in support of the opposition, regulation 9.17 applies.

Evidence in reply

- (6) If the applicant files evidence in answer under subregulation (4), the opponent must file any evidence in reply to the evidence in answer within 2 months from the day the Registrar:
 - (a) gives the opponent:
 - (i) all the evidence in answer; or
 - (ii) if the applicant files the evidence in answer in instalments—the final instalment of the evidence in answer; and
 - (b) notifies the opponent that all the evidence in answer has been filed.

9.17 Request for hearing and circumstances in which opposition taken to have ended

- (1) If an opponent requests the Registrar, within the period for filing evidence in support mentioned in subregulation 9.16(3), to hear the opposition, the Registrar must do so.
- (2) The opposition is taken to have ended, but not to have been discontinued or dismissed, if the opponent does not:
 - (a) file evidence in support in accordance with subregulation 9.16(3); or
 - (b) ask for a hearing under subregulation (1).
- (3) The application for removal is taken to be unopposed if:
 - (a) the opposition is taken to have ended under subregulation (2); and
 - (b) the Registrar is satisfied that the application for removal is in order.

Note 1: See section 97 of the Act in relation to what the Registrar must do if the application for removal is unopposed.

Note 2: Regulations 21.15 and 21.16 deal with hearings.

9.18 Extension of time for filing

- (1) A party may request the Registrar to extend a period for filing evidence mentioned in regulation 9.16.

- (2) The Registrar may extend the period only if the Registrar is satisfied that:
- (a) the party:
 - (i) has made all reasonable efforts to comply with all relevant filing requirements of this Part; and
 - (ii) despite acting promptly and diligently at all times to ensure the filing of the evidence within the period, is unable to do so; or
 - (b) there are exceptional circumstances that justify the extension.
- (3) The Registrar:
- (a) must decide the length of the extended period having regard to what is reasonable in the circumstances; and
 - (b) may do so on terms that the Registrar considers appropriate.
- (4) In this regulation:
- exceptional circumstances* includes the following:
- (a) a circumstance beyond the control of a party that prevents the party from complying with a filing requirement under this Part;
 - (b) an error or omission by the Registrar or an employee that prevents a party from complying with a filing requirement under this Part;
 - (c) an order of a court or a direction by the Registrar that the opposition be stayed.

Division 4—Cooling-off period for opposition

9.19 Registrar may allow cooling-off period

- (1) This regulation applies to an opposition if:
- (a) the notice of opposition has been filed; and
 - (b) the Registrar has not decided to remove the trade mark under subsection 101(1) of the Act; and
 - (c) the opposition has not been dismissed under regulation 9.10.
- (2) If the Registrar is satisfied that the parties agree to a cooling-off period, the Registrar must allow a cooling-off period of 6 months.

- (3) The Registrar must extend the cooling-off period for 6 months if, before the end of the period, the Registrar is satisfied that the parties agree to the extension.
- (4) The Registrar must not:
 - (a) further extend the cooling-off period; or
 - (b) allow more than one cooling-off period for an opposition.
- (5) If a party files a notice, in an approved form, requesting the Registrar to discontinue the cooling-off period, the Registrar must do so.
- (6) The Registrar may direct the parties on steps the parties must take:
 - (a) if the cooling-off period is discontinued; or
 - (b) otherwise—when the cooling-off period ends.
- (7) The opposition resumes:
 - (a) if the cooling-off period is discontinued; or
 - (b) otherwise—when the cooling-off period ends.
- (8) If:
 - (a) the cooling-off period begins during the period mentioned in regulation 9.15 or an evidentiary period mentioned in regulation 9.16; and
 - (b) the opposition resumes;the period mentioned in regulation 9.15 or 9.16 restarts when the opposition resumes.

Division 5—Hearing of opposition

9.20 Hearing

- (1) This regulation applies to an opposition if the opposition has not been dismissed under regulation 9.10 or discontinued.
- (2) A party may request the Registrar to hold a hearing if an evidentiary period mentioned in regulation 9.16 has ended; and either
 - (a) all evidence for the opposition proceeding has been filed; or
 - (b) no evidence has been filed in that period.

- (3) The Registrar:
 - (a) must hold a hearing of the opposition if requested by a party in writing; or
 - (b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.
- (4) The hearing may, at the Registrar's discretion, be:
 - (a) an oral hearing; or
 - (b) by written submissions.
- (5) If the Registrar decides on an oral hearing:
 - (a) the Registrar must notify the parties of the date, time and place of the hearing; and
 - (b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
 - (c) the applicant must file a summary of submissions at least 5 business days before the hearing.
- (6) The Registrar may take into account a party's failure to file a summary of submissions under subregulation (5) in making an award of costs.

Note: Regulations 21.15 and 21.16 deal with hearings.

Division 6—Miscellaneous

9.21 Registrar may give direction

- (1) The Registrar may give a direction in relation to an opposition to which this Division applies:
 - (a) if requested by a party in writing; or
 - (b) on the Registrar's own initiative.
 - (2) If the Registrar proposes to give a direction, the Registrar must give the parties an opportunity to make representations about the direction.
 - (3) A direction must not be inconsistent with the Act or these Regulations.
 - (4) The Registrar must notify the parties of the direction as soon as practicable.
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9.22 Registrar must notify parties of dismissal or discontinuance of opposition

If an opposition is dismissed under regulation 9.10 or discontinued, the Registrar must notify the parties of the dismissal or discontinuance.

9.23 Removal of trade mark from register

If the Registrar dismisses the opposition under regulation 9.10, the Registrar must remove the trade mark from the Register in respect of the goods, services, or both, specified in the application for removal.

15 At the end of regulation 17A.28

Add:

- (3) The ground set out in section 177 of the Act is a ground for rejecting an IRDA that is for a certification trade mark.

16 Subdivision 3 of Division 3 of Part 17A

Repeal the Subdivision, substitute:

Subdivision C—Opposition to IRDA

17A.29 Definitions

In this Subdivision:

extension of protection means the extension of protection in Australia to the trade mark that is the subject of the IRDA.

notice of intention to defend means a notice filed under regulation 17A.34H.

notice of intention to oppose means a notice filed under regulation 17A.33.

notice of opposition means:

- (a) a notice of intention to oppose; and
- (b) a statement of grounds and particulars.

opponent means a person who files:

- (a) a notice of intention to oppose; and
- (b) a statement of grounds and particulars.

party means an IRDA holder or opponent.

statement of grounds and particulars means a statement by an opponent that sets out:

- (a) the grounds on which the opponent intends to rely; and
- (b) the facts and circumstances forming the basis for the grounds.

Note: The following terms are defined in section 6 of the Act:

- (a) applicant;
- (b) approved form;
- (c) employee;
- (d) file;
- (e) month;
- (f) person.

17A.30 Registrar may give direction about filing document or evidence

- (1) If a document or evidence may or must be filed under this Subdivision, the Registrar may give a direction specifying:
 - (a) how many copies of the document or evidence must be filed; and
 - (b) the form in which the document or evidence is to be filed; and
 - (c) the means by which the document or evidence is to be filed.
- (2) If a party does not comply with the direction, the Registrar may:
 - (a) treat the document or evidence as not having been filed; or
 - (b) tell the party to comply with the direction.
- (3) The Registrar may make or revoke the direction as the Registrar sees fit.
- (4) Regulation 17A.31 does not apply to this regulation.

17A.31 Notification and opportunity to make representations

- (1) This regulation applies if:
 - (a) a party makes a request to the Registrar under this Subdivision; or
 - (b) the Registrar proposes to make a decision on the Registrar's own initiative under this Subdivision.
- (2) The Registrar must:
 - (a) for paragraph (1)(a)—notify the other party of the request, including by giving the other party a copy of the request; or
 - (b) for paragraph (1)(b)—notify the parties of the proposed decision.
- (3) If the Registrar proposes to grant the request, the Registrar must give the parties an opportunity to make representations:
 - (a) in writing; or
 - (b) at a hearing; or
 - (c) by other means that the Registrar states in the notification.
- (4) The Registrar must notify the parties of the Registrar's decision.

17A.32 Filing of notice of opposition

- (1) A notice of opposition is taken to be filed when the notice of intention to oppose and the statement of grounds and particulars have been filed under regulations 17A.33 and 17A.34A.
- (2) The Registrar must notify the International Bureau of the filing of the notice of opposition in accordance with rule 17, as applicable, of the Common Regulations.

17A.33 Filing of notice of intention to oppose

- (1) If the Registrar advertises the acceptance of an IRDA in the *Official Journal*, a person may oppose the extension of protection by filing a notice of intention to oppose within 2 months from the advertisement of the acceptance.
 - (2) The notice must be in an approved form.
 - (3) The Registrar must give a copy of the notice to the applicant.
-

17A.34 Grounds for opposing IRDA

- (1) The extension of protection may be opposed on any of the grounds on which an IRDA may be rejected under Subdivision 2, except the ground that the trade mark cannot be represented graphically.
- (2) The extension of protection may also be opposed on any of the grounds set out in sections 58 to 61 and 62A of the Act, as affected by subregulation (3).
- (3) Sections 58 to 61 and 62A of the Act apply in relation to an IRDA as if:
 - (a) a reference in those sections:
 - (i) to an application for the registration of a trade mark were a reference to the IRDA; and
 - (ii) to an applicant were a reference to the holder of the IRDA; and
 - (iii) to the registration of a trade mark were a reference to the extension of protection in Australia to the trade mark that is the subject of the IRDA; and
 - (b) the reference in paragraph 60(a) of the Act to the priority date for the registration of the trade mark were a reference to the priority date for the trade mark that is the subject of the IRDA.
- (4) The extension of protection may also be opposed on the grounds that:
 - (a) a document filed in support of the IRDA was amended contrary to the Act; or
 - (b) the Registrar accepted the IRDA on the basis of evidence provided, or a representation made, by the holder that was false in a material particular.

Note: Section 66 of the Act provides for the amendment of documents filed with the Registrar.

17A.34A Filing of statement of grounds and particulars

- (1) A statement of grounds and particulars must be filed within one month from the day the notice of intention to oppose is filed.
 - (2) The statement must be in an approved form.
-

17A.34B Statement of grounds and particulars must be adequate

- (1) The Registrar must assess the adequacy of a statement of grounds and particulars.
- (2) If the Registrar decides that the statement is adequate, the Registrar must give a copy of the statement to the applicant.
- (3) If the Registrar decides that the statement is inadequate:
 - (a) the Registrar may direct the opponent to rectify the inadequacy by filing more information on the basis for one or more of the grounds; or
 - (b) if all the grounds are inadequately particularised, the Registrar may dismiss the opposition; or
 - (c) if only some of the grounds are inadequately particularised, the Registrar may:
 - (i) delete from the statement some or all of the material that is inadequate; and
 - (ii) treat the result as the statement for the purposes of these Regulations; and
 - (iii) give a copy of the amended statement to the opponent.
- (4) If the Registrar decides that the statement is still inadequate after the information is filed under paragraph (3)(a):
 - (a) the Registrar may dismiss the opposition; or
 - (b) the Registrar may:
 - (i) delete from the statement some or all of the material that is inadequate; and
 - (ii) treat the result as the statement for the purposes of these Regulations; and
 - (iii) give a copy of the amended statement to the opponent.
- (5) If the Registrar decides that the information filed under paragraph (3)(a) rectifies the inadequacy of the statement, the Registrar must give a copy of the statement and the information filed in relation to paragraph (3)(a) to the applicant.
- (6) The opponent may apply to the Administrative Appeals Tribunal for review of a decision under this regulation to dismiss the opposition or delete material from the statement of grounds and particulars.

(7) Regulation 17A.31 does not apply to this regulation.

17A.34C Extension of time for filing—application

- (1) A person who intends to oppose the extension of protection may request the Registrar to extend:
 - (a) the period for filing a notice of intention to oppose under subregulation 17A.33(1); or
 - (b) the period for filing a statement of grounds and particulars under subregulation 17A.34A(1).
- (2) A request under paragraph (1)(a) or (b) may be made:
 - (a) within the period for filing the document in question; or
 - (b) before the extension of protection of the IRDA is entered on the Record of International Registrations under paragraph 17A.37(1)(b).

Note: See subparagraph (3)(b)(ii) and subregulation 17A.34D(2) in relation to the consequences of making the request after the filing period has ended.

- (3) The request must:
 - (a) be in an approved form; and
 - (b) be accompanied by a declaration stating:
 - (i) the facts and circumstances forming the basis for the grounds; and
 - (ii) if the period for filing the notice or the statement of grounds and particulars has ended—the reason why the request was not made within the period.

Note: Regulations 21.6 and 21.7 deal with making and filing declarations.

- (4) The request must be made only on either or both of the following grounds:
 - (a) an error or omission by the person, the person's agent, the Registrar or an employee;
 - (b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.
- (5) Subsection 52(5) of the Act applies to the request.

- (6) Regulation 17A.31 does not apply to this regulation.

17A.34D Extension of time for filing—grant

- (1) The Registrar may grant a request under subregulation 17A.34C(1) for an extension of time if the Registrar is satisfied that the grounds set out in the request justify the extension.
- (2) However, if the request is made after the period for filing the notice or statement of grounds and particulars has ended, the Registrar must not grant the extension unless the Registrar is satisfied that there is sufficient reason for the delay in making the request.
- (3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

17A.34E Opposition may proceed in name of other person

Section 53 of the Act applies to a notice of intention to oppose filed under this Subdivision.

17A.34F Amendment of notice of intention to oppose

- (1) An opponent may request the Registrar to amend a notice of intention to oppose to correct a clerical error or obvious mistake.
- (2) If an opposition proceeds in the name of another person under section 53 of the Act, the person may request the Registrar to amend the notice of intention to oppose to record the person's name.
- (3) The Registrar may grant a request under subregulation (1) or (2) on terms that the Registrar considers appropriate.
- (4) If the Registrar grants the request, the Registrar must give a copy of the notice of the amended intention to oppose to the IRDA holder.
- (5) Regulation 17A.31 does not apply to this regulation.

17A.34G Amendment of statement of grounds and particulars

- (1) An opponent may request the Registrar to amend the statement of grounds and particulars to:
 - (a) correct an error or omission in the grounds of opposition or the facts and circumstances forming the basis for the grounds; or
 - (b) amend a ground of opposition; or
 - (c) add a new ground of opposition; or
 - (d) to amend the facts and circumstances forming the basis for the grounds.
- (2) The Registrar may grant the request on terms that the Registrar considers appropriate.
- (3) However, the Registrar may grant a request to:
 - (a) amend a ground of opposition; or
 - (b) add a new ground of opposition;only if the Registrar is satisfied that the amendment or addition relates to information of which the opponent could not reasonably have been aware at the time of filing the statement.
- (4) If the Registrar grants the request, the Registrar must give a copy of the amended statement to the IRDA holder.

17A.34H Filing of notice of intention to defend

- (1) The IRDA holder must file a notice of intention to defend within one month from the day the Registrar notifies the International Bureau under subregulation 17A.32(2).
- (2) The holder must file an Australian address for service with the notice.
- (3) The Registrar must give a copy of the notice to the opponent.
- (4) If the holder does not file the notice within the period mentioned in subregulation (1), the Registrar may decide to:
 - (a) take the opposition to have succeeded; and
 - (b) refuse protection to the holder.

- (5) The Registrar is not required to take any action in response to a notice of intention to defend filed under subregulation (1) unless the opponent has notified the Registrar, in writing, of the opponent's address for service in Australia.
- (6) A requirement to:
- (a) give a document to a person; or
 - (b) give a person an opportunity to make written representations or to be heard;
- does not apply if no address for service of the person is recorded in the Record of International Registrations.
- (7) The Registrar must notify the parties of the Registrar's decision.

17A.34J Filing of evidence

- (1) The Registrar must notify the parties that:
- (a) all the evidence for an evidentiary period mentioned in this regulation has been filed; or
 - (b) no evidence was filed for the period.
- (2) The Registrar must give a copy of any evidence filed by a party under this regulation to the other party:
- (a) before the end of the relevant evidentiary period, if the Registrar considers it appropriate to do so; or
 - (b) after the evidentiary period ends.

Evidence in support

- (3) An opponent must file any evidence in support of the opposition within 3 months from the day the opponent is given a copy of the notice of intention to defend.

Evidence in answer

- (4) If the opponent files evidence in support of the opposition, the IRDA holder must file any evidence in answer to the evidence in support within 3 months from the day the Registrar:
- (a) gives the IRDA holder:
 - (i) all the evidence in support; or

- (ii) if the opponent files the evidence in support in instalments—the final instalment of the evidence in support; and
 - (b) notifies the IRDA holder that all the evidence in support has been filed.
- (5) If the opponent does not file any evidence in support of the opposition, the IRDA holder must file any evidence in answer to the statement of grounds and particulars within 3 months from the day the Registrar notifies the IRDA holder that no evidence in support was filed.

Evidence in reply

- (6) If the IRDA holder files evidence in answer under subregulation (4) or (5), the opponent must file any evidence in reply to the evidence in answer within 2 months from the day the Registrar:
 - (a) gives the opponent:
 - (i) all the evidence in answer; or
 - (ii) if the IRDA holder files the evidence in answer in instalments—the final instalment of the evidence in answer; and
 - (b) notifies the opponent that all the evidence in answer has been filed.

17A.34K Extension of time for filing

- (1) A party may request the Registrar to extend a period for filing evidence mentioned in regulation 17A.34J.
- (2) The Registrar may extend the period only if the Registrar is satisfied that:
 - (a) the party:
 - (i) has made all reasonable efforts to comply with all relevant filing requirements of this Subdivision; and
 - (ii) despite acting promptly and diligently at all times to ensure the filing of the evidence within the period, is unable to do so; or
 - (b) there are exceptional circumstances that justify the extension.

- (3) The Registrar:
 - (a) must decide the length of the extended period having regard to what is reasonable in the circumstances; and
 - (b) may do so on terms that the Registrar considers appropriate.
- (4) In this regulation:

exceptional circumstances includes the following:

 - (a) a circumstance beyond the control of a party that prevents the party from complying with a filing requirement under this Subdivision;
 - (b) an error or omission by the Registrar or an employee that prevents a party from complying with a filing requirement under this Subdivision;
 - (c) an order of a court or a direction by the Registrar that the opposition be stayed.

17A.34L Registrar may allow cooling-off period

- (1) This regulation applies to an opposition if:
 - (a) the notice of opposition has been filed; and
 - (b) the Registrar has not made a decision on the opposition under regulation 17A.34N; and
 - (c) the opposition has not been dismissed under regulation 17A.34B.
- (2) If the Registrar is satisfied that the parties agree to a cooling-off period, the Registrar must allow a cooling-off period of 6 months.
- (3) The Registrar must extend the cooling-off period for 6 months if, before the end of the period, the Registrar is satisfied that the parties agree to the extension.
- (4) The Registrar must not:
 - (a) further extend the cooling-off period; or
 - (b) allow more than one cooling-off period for an opposition.
- (5) If a party files a notice in an approved form requesting the Registrar to discontinue the cooling-off period, the Registrar must do so.

- (6) The Registrar may direct the parties on steps they must take:
 - (a) if the cooling-off period is discontinued; or
 - (b) otherwise—when the cooling-off period ends.
- (7) The opposition resumes:
 - (a) if the cooling-off period is discontinued; or
 - (b) otherwise—when the cooling-off period ends.
- (8) If:
 - (a) the cooling-off period begins during the period mentioned in regulation 17A.34H or an evidentiary period mentioned in regulation 17A.34J; and
 - (b) the opposition resumes;the period mentioned in regulation 17A.34H or 17A.34J restarts when the opposition resumes.

17A.34M Hearing

- (1) This regulation applies to an opposition if:
 - (a) the opposition has not been dismissed under regulation 17A.34B; or
 - (b) the opposition has not been decided under regulation 17A.34N; or
 - (c) the opposition is not taken to have succeeded under regulation 17A.34H.
- (2) An applicant may request the Registrar to hold a hearing if:
 - (a) the evidentiary period mentioned in subregulation 17A.34J(3) has ended; and
 - (b) either:
 - (i) all evidence for the opposition proceeding has been filed; or
 - (ii) no evidence has been filed in that period.
- (3) A party may request the Registrar to hold a hearing if:
 - (a) an evidentiary period mentioned in any of subregulations 17A.34J(4) to (6) has ended; and
 - (b) either:

- (i) all evidence for the opposition proceeding has been filed; or
 - (ii) no evidence has been filed in that period.
- (4) The Registrar:
- (a) must hold a hearing of the opposition if requested by a party in writing; or
 - (b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.
- (5) The hearing may, at the Registrar's discretion, be:
- (a) an oral hearing; or
 - (b) by written submissions.
- (6) If the Registrar decides on an oral hearing:
- (a) the Registrar must notify the parties of the date, time and place of the hearing; and
 - (b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
 - (c) the applicant must file a summary of submissions at least 5 business days before the hearing.
- (7) The Registrar may take into account a party's failure to file a summary of submissions under subregulation (6) in making an award of costs.

Note: Regulations 21.15 and 21.16 deal with hearings.

17A.34N Decision on opposition

- (1) Unless the opposition proceedings are discontinued or dismissed, the Registrar must decide:
- (a) to refuse protection in respect of all of the goods or services listed in the IRDA; or
 - (b) to extend protection in respect of some or all of the goods or services listed in the IRDA (with or without conditions or limitations);
- having regard to the extent (if any) to which the grounds on which the IRDA was opposed have been established.

- (2) The Registrar must notify the International Bureau of the Registrar's decision.

17A.34P Appeal

- (1) Section 56 of the Act applies in relation to the Registrar's decision on the opposition as if a reference in that section:
 - (a) to an applicant were a reference to the holder of an IRDA;
and
 - (b) to a decision under section 55 of the Act were a reference to a decision under regulation 17A.34N.
- (2) If an appeal is made, the Registrar must tell the International Bureau of the decision on the appeal.

17A.34Q Registrar may give direction

- (1) The Registrar may give a direction in relation to an opposition to which this Division applies:
 - (a) if requested by a party in writing; or
 - (b) on the Registrar's own initiative.
- (2) If the Registrar proposes to give a direction, the Registrar must give the parties an opportunity to make representations about the direction.
- (3) A direction must not be inconsistent with the Act or these Regulations.
- (4) The Registrar must notify the parties of the direction as soon as practicable.

17A.35 Registrar must notify parties of dismissal or discontinuance of opposition

If an opposition is dismissed under regulation 17A.34B or discontinued, the Registrar must notify the parties of the dismissal or discontinuance.

17 Subdivision 4 of Division 5 of Part 17A

Repeal the Subdivision, substitute:

Subdivision D—Cessation of protection for non-use

17A.48 Definitions

In this Subdivision:

application for cessation of protection means an application to the Registrar for cessation of protection of a trade mark that is, or may become, a protected international trade mark.

cessation of protection means the cessation of protection of a trade mark that is a protected international trade mark.

notice of intention to defend means a notice filed under regulation 17A.48Q.

notice of intention to oppose means a notice filed under regulation 17A.48G.

notice of opposition means:

- (a) a notice of intention to oppose; and
- (b) a statement of grounds and particulars.

opponent means a person who files:

- (a) a notice of intention to oppose; and
- (b) a statement of grounds and particulars.

party means an applicant or opponent.

statement of grounds and particulars means a statement by an opponent that sets out:

- (a) the grounds for cessation of protection that the opponent intends to rebut; and
- (b) the facts and circumstances that form the basis for the opposition to the cessation of protection.

Note: The definitions of the following terms are in section 6 of the Act:

- (a) applicant;
- (b) approved form;
- (c) employee;
- (d) file;
- (e) month;
- (f) person.

17A.48A Registrar may give direction about filing document or evidence

- (1) If a document or evidence may or must be filed under this Subdivision, the Registrar may give a direction specifying:
 - (a) the number of copies of the document or evidence to be filed; and
 - (b) the form in which the document or evidence is to be filed; and
 - (c) the means by which the document or evidence is to be filed.
- (2) If a party does not comply with the direction, the Registrar may:
 - (a) treat the document or evidence as not having been filed; or
 - (b) tell the party to comply with the direction.
- (3) The Registrar may make or revoke the direction as the Registrar sees fit.
- (4) Regulation 17A.48B does not apply to the Registrar's decision to make or revoke the direction.

17A.48B Notification and opportunity to make representations

- (1) This regulation applies if:
 - (a) a party makes a request to the Registrar under this Subdivision; or
 - (b) the Registrar proposes to make a decision on the Registrar's own initiative under this Subdivision.
- (2) The Registrar must:
 - (a) for paragraph (1)(a)—notify the other party of the request, including by giving the other party a copy of the request; or
 - (b) for paragraph (1)(b)—notify the parties of the proposed decision.
- (3) If the Registrar proposes to grant the request, the Registrar must give the parties an opportunity to make representations:
 - (a) in writing; or
 - (b) at a hearing; or
 - (c) by other means that the Registrar states in the notification.

- (4) The Registrar must notify the parties of the Registrar's decision.

17A.48C Application for cessation of protection

- (1) A person may make an application for cessation of protection.
- (2) However, an application may not be made under subregulation (1) if an action concerning the protected international trade mark is pending in a prescribed court.
- (3) If subregulation (2) applies, a person may apply to the court for an order directing the Registrar to cease protecting the protected international trade mark.

17A.48D Cessation of protection

- (1) Part 9 of the Act and Part 9 of these Regulations apply in relation to an application for cessation of protection.
- (2) For that application, a reference in those Parts:
- (a) to a registered trade mark or a trade mark that is registered, or entered on the Register, is taken to be a reference to a trade mark that is, or may become, a protected international trade mark; and
 - (b) to removing a trade mark from the Register is taken to be a reference to the cessation of protection of the trade mark; and
 - (c) to an application for registration of a trade mark is taken to be a reference to an international registration designating Australia; and
 - (d) to an applicant for registration of a trade mark is taken to be a reference to the holder of an international registration designating Australia; and
 - (e) to a registered owner of a trade mark is taken to be a reference to the holder of a protected international trade mark; and
 - (f) to an application under section 92 is taken to be a reference to an application for cessation of protection; and
 - (g) to the date the application for registration of the trade mark was filed, or the filing date in respect of the 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(2) of the Protocol—the date of recording of the request.

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

- (3) Sections 96 to 101 of the Act apply in relation to the cessation of protection for non-use.

17A.48E Notification of application

For subsection 95(1) of the Act, the Registrar must, within one month from the filing of the application, give a copy of the application to each person who, in the Registrar's opinion, should receive one.

17A.48F Filing of notice of opposition

A notice of opposition is taken to be filed when the notice of intention to oppose and the statement of grounds and particulars have been filed under regulations 17A.48G and 17A.48J.

17A.48G Filing of notice of intention to oppose

- (1) For subsection 96(2) of the Act, the period for filing a notice of intention to oppose the application for cessation of protection must be filed within 2 months from the day the application for cessation of protection is advertised in the *Official Journal*.
- (2) The notice must be in an approved form.
- (3) The Registrar must give a copy of the notice to the applicant.

17A.48H Opponent must have address for service

- (1) This regulation applies despite any other regulation in this Subdivision.

- (2) The Registrar is not required to take any action in response to a notice of opposition filed under regulation 17A.48F unless the opponent has notified the Registrar, in writing, of the opponent's address for service in Australia.
- (3) A requirement to give a document to an opponent, or to give the opponent an opportunity to make written representations or to be heard, does not apply if no address for service of the opponent is recorded in the Record of International Registrations.

17A.48J Filing of statement of grounds and particulars

- (1) A statement of grounds and particulars must be filed within one month from the day the notice of intention to oppose is filed.
- (2) The statement must be in an approved form.

17A.48K Statement of grounds and particulars must be adequate

- (1) The Registrar must assess the adequacy of a statement of grounds and particulars filed under regulation 17A.48J.
- (2) If the Registrar decides that the statement is adequate, the Registrar must give a copy of the statement to the applicant.
- (3) If the Registrar decides that the statement is inadequate, the Registrar may:
 - (a) direct the opponent to rectify the inadequacy by filing more information on the basis for the opposition to the cessation of protection; or
 - (b) dismiss the opposition.
- (4) If the Registrar decides that the information filed under paragraph (3)(a) rectifies the inadequacy of the statement, the Registrar must give a copy of the statement and the information to the applicant.
- (5) For subsection 99A(1) of the Act, the Registrar may dismiss the opposition if:
 - (a) the Registrar decides that the statement is inadequate; or
 - (b) the Registrar has directed the opponent to file information under paragraph (3)(a) and:

- (i) the opponent fails to file the information; or
- (ii) the Registrar decides that the information filed does not rectify the inadequacy of the statement.

(6) Regulation 17A.48B does not apply to this regulation.

Note: For review rights in relation to a decision by the Registrar to dismiss an opposition, see subsection 99A(2) of the Act.

17A.48L Extension of time for filing—application

(1) A person who intends to oppose an application for cessation of protection may request the Registrar to extend:

- (a) the period for filing a notice of intention to oppose under subregulation 17A.48G(1); or
- (b) the period for filing a statement of grounds and particulars under subregulation 17A.48J(1).

(2) A request under paragraph (1)(a) or (b) may be made within the period for filing the document in question.

Note: See subparagraph (3)(b)(ii) and subregulation 17A.48M(2) in relation to the consequences of making the request after the filing period has ended.

(3) The request must:

- (a) be in an approved form; and
- (b) be accompanied by a declaration stating:
 - (i) the facts and circumstances forming the basis for the grounds; and
 - (ii) if the period for filing the notice of intention to oppose or the statement of grounds and particulars has ended—the reason why the request was not made within the period.

Note: Regulations 21.6 and 21.7 deal with making and filing declarations.

(4) The request may be made only on either or both of the following grounds:

- (a) an error or omission by the person, the person's agent, the Registrar or an employee;

- (b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.

17A.48M Extension of time for filing—grant

- (1) The Registrar may grant a request under subregulation 17A.48L(1) for an extension of time only if the Registrar is satisfied that the grounds set out in the request justify the extension.
- (2) However, if the request is made after the period for filing the notice or statement of grounds and particulars has ended, the Registrar must not grant the extension unless the Registrar is satisfied that there is sufficient reason for the delay in making the request.
- (3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

17A.48N Amendment of notice of intention to oppose

- (1) An opponent may request the Registrar to amend a notice of intention to oppose to correct a clerical error or obvious mistake.
- (2) If an opposition is proceeding in the name of a person other than the opponent under section 96A of the Act, the person may request the Registrar to amend the notice of intention to oppose to record the person's name.
- (3) The Registrar may grant the request on terms that the Registrar considers appropriate.
- (4) If the Registrar grants the request, the Registrar must give a copy of the amended notice of intention to oppose to the applicant.
- (5) Regulation 17A.48B does not apply to a request under subregulation (1) or (2).
- (6) Section 96A of the Act applies in relation to the opposition.

17A.48P Amendment of statement of grounds and particulars

- (1) An opponent may request the Registrar to amend the statement of grounds and particulars to:
 - (a) correct an error or omission; or
 - (b) amend or add facts or circumstances that form the basis of the opposition to the cessation of protection.
- (2) The Registrar may grant the request on terms that the Registrar considers appropriate.
- (3) However, the Registrar may grant the request only if the Registrar is satisfied that the amendment should be made.
- (4) If the Registrar grants the request, the Registrar must give a copy of the amended statement to the applicant.

17A.48Q Filing of notice of intention to defend

- (1) A notice of intention to defend must be filed within one month from the day the applicant is given a copy of the statement of grounds and particulars.
- (2) The Registrar must give the opponent a copy of the notice.
- (3) If the applicant does not file the notice of intention to defend within the period mentioned in subregulation (1), the Registrar may decide to:
 - (a) take the opposition to have succeeded; and
 - (b) refuse to cease protection of the protected international trade mark.
- (4) The Registrar must notify the parties of the Registrar's decision.

17A.48R Filing of evidence

- (1) The Registrar must notify the parties that:
 - (a) all the evidence for an evidentiary period mentioned in this regulation has been filed; or
 - (b) no evidence was filed for the period.

- (2) The Registrar must give a copy of any evidence filed by a party under this regulation to the other party:
- (a) before the end of the relevant evidentiary period, if the Registrar considers it appropriate to do so; or
 - (b) after the evidentiary period ends.

Evidence in support

- (3) An opponent must file any evidence in support of the opposition within 3 months from the day the opponent is given a copy of the notice of intention to defend the application for cessation of protection.

Evidence in answer

- (4) If the opponent files evidence in support of the opposition, the applicant must file any evidence in answer to the opponent's evidence within 3 months from the day the Registrar:
- (a) gives the applicant:
 - (i) all the evidence in support; or
 - (ii) if the opponent files the evidence in support in instalments—the final instalment of the evidence in support; and
 - (b) notifies the applicant that all the evidence in support has been filed.
- (5) If the opponent does not file any evidence in support of the opposition, regulation 17A.48S applies.

Evidence in reply

- (6) If the applicant files evidence in answer under subregulation (4), the opponent must file any evidence in reply to the evidence in answer within 2 months from the day the Registrar:
- (a) gives the opponent:
 - (i) all the evidence in answer; or
 - (ii) if the applicant files the evidence in answer in instalments—the final instalment of the evidence in answer; and

- (b) notifies the opponent that all the evidence in answer has been filed.

17A.48S Request for hearing and circumstances in which opposition taken to have ended

- (1) If an opponent requests the Registrar, within the period for filing evidence in support mentioned in subregulation 17A.48R(3), to hear the opposition, the Registrar must do so.
- (2) The opposition is taken to have ended, but not to have been discontinued or dismissed, if the opponent does not:
 - (a) file evidence in support in accordance with subregulation 17A.48R(3); or
 - (b) ask for a hearing under subregulation (1).
- (3) The application for cessation of protection is taken to be unopposed if:
 - (a) the opposition is taken to have ended under subregulation (2); and
 - (b) the Registrar is satisfied that the application for cessation of protection is in order.

Note 1: See section 97 of the Act in relation to what the Registrar must do if the application for cessation of protection is unopposed.

Note 2: Regulations 21.15 and 21.16 deal with hearings.

17A.48T Extension of time for filing

- (1) A party may request the Registrar to extend a period for filing evidence mentioned in regulation 17A.48R.
- (2) The Registrar may extend the period only if the Registrar is satisfied that:
 - (a) the party:
 - (i) has made all reasonable efforts to comply with all relevant filing requirements of this Subdivision; and
 - (ii) despite acting promptly and diligently at all times to ensure the filing of the evidence within the period, is unable to do so; or
 - (b) there are exceptional circumstances that justify the extension.

- (3) The Registrar:
- (a) must decide the length of the extended period having regard to what is reasonable in the circumstances; and
 - (b) may do so on terms that the Registrar considers appropriate.
- (4) In this regulation:
- exceptional circumstances* includes the following:
- (a) a circumstance beyond the control of a party that prevents the party from complying with a filing requirement under this Subdivision;
 - (b) an error or omission by the Registrar or an employee that prevents a party from complying with a filing requirement under this Subdivision;
 - (c) an order of a court or a direction by the Registrar that the opposition be stayed.

17A.48U Registrar may allow cooling-off period

- (1) This regulation applies to an opposition if:
- (a) the notice of opposition has been filed; and
 - (b) the Registrar has not decided to remove the trade mark under subsection 101(1) of the Act; and
 - (c) the opposition has not been dismissed under regulation 17A.48K.
- (2) If the Registrar is satisfied that the parties agree to a cooling-off period, the Registrar must allow a cooling-off period of 6 months.
- (3) The Registrar must extend the cooling-off period for 6 months if, before the end of the period, the Registrar is satisfied that the parties agree to the extension.
- (4) The Registrar must not:
- (a) further extend the cooling-off period; or
 - (b) allow more than one cooling-off period for an opposition.
- (5) If a party files a notice, in an approved form, requesting the Registrar to discontinue the cooling-off period, the Registrar must do so.

- (6) The Registrar may direct the parties on steps the parties must take:
 - (a) if the cooling-off period is discontinued; or
 - (b) otherwise—when the cooling-off period ends.
- (7) The opposition resumes:
 - (a) if the cooling-off period is discontinued; or
 - (b) otherwise—when the cooling-off period ends.
- (8) If:
 - (a) the cooling-off period begins during the period mentioned in regulation 17A.48Q or an evidentiary period mentioned in regulation 17A.48R; and
 - (b) the opposition resumes;the period mentioned in regulation 17A.48Q or 17A.48R restarts when the opposition resumes.

17A.48V Hearing

- (1) This regulation applies to an opposition if the opposition has not been dismissed under regulation 17A.48K or discontinued.
- (2) A party may request the Registrar to hold a hearing if an evidentiary period mentioned in regulation 17A.48R has ended; and either:
 - (a) all evidence for the opposition proceeding has been filed; or
 - (b) no evidence has been filed in that period.
- (3) The Registrar:
 - (a) must hold a hearing of the opposition if requested by a party in writing; or
 - (b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.
- (4) The hearing may, at the Registrar's discretion, be:
 - (a) an oral hearing; or
 - (b) by written submissions.
- (5) If the Registrar decides on an oral hearing:
 - (a) the Registrar must notify the parties of the date, time and place of the hearing; and

- (b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
 - (c) the applicant must file a summary of submissions at least 5 business days before the hearing.
- (6) The Registrar may take into account a party's failure to file a summary of submissions under subregulation (5) in making an award of costs.

Note: Regulations 21.15 and 21.16 deal with hearings.

17A.48W Registrar may give direction

- (1) The Registrar may give a direction in relation to an opposition to which this Division applies:
 - (a) if requested by a party in writing; or
 - (b) on the Registrar's own initiative.
- (2) If the Registrar proposes to give a direction, the Registrar must give the parties an opportunity to make representations about the direction.
- (3) A direction must not be inconsistent with the Act or these Regulations.
- (4) The Registrar must notify the parties of the direction as soon as practicable.

17A.48X Registrar must notify International Bureau

If the result of an action under this Subdivision is that the Registrar decides, or is directed by a court:

- (a) to cease protection of a protected international trade mark in respect of some or all of the goods or services covered by the protection; or
- (b) that the trade mark should be protected subject to conditions or limitations;

the Registrar must, if no appeal has been made at the end of any relevant appeal period, notify the International Bureau of that decision or order.

17A.48Y Registrar must notify parties of dismissal or discontinuance of opposition

If an opposition is dismissed under regulation 17A.48K or discontinued, the Registrar must notify the parties of the dismissal or discontinuance.

17A.48Z Cessation of protection of protected international trade mark

If the Registrar dismisses the opposition under regulation 17A.48K, the Registrar must cease protection in respect of the goods, services, or both, specified in the application for cessation of protection.

18 Regulation 21.13

Repeal the regulation, substitute:

21.13 Award of costs

- (1) For section 221 of the Act, if a matter is mentioned in these Regulations as a matter attracting the award of costs, costs may be awarded:
 - (a) in accordance with Schedule 8; or
 - (b) if the Registrar has a discretionary power in relation to the award of costs—as the Registrar considers appropriate.
- (2) The costs must be taxed, allowed and certified by an employee appointed by the Registrar.
- (3) The Registrar may review the taxation of costs by the employee.
- (4) In this regulation:

costs does not include the costs mentioned in paragraph 105(2)(b) of the Act.

19 After Division 2 of Part 21

Insert:

Division 2A—Extensions of time

21.20A Definitions

In this Division:

notice of opposition means a notice filed under subregulation 21.20B(1).

party means an applicant or opponent.

Note: The definitions of the following terms are in section 6 of the Act:

- (a) applicant;
- (b) approved form;
- (c) file;
- (d) month;
- (e) person.

21.20B Notice of opposition

- (1) For subsection 224(6) of the Act, a person may oppose a request for an extension of time by filing a notice of opposition in an approved form within one month from the advertisement of the request for the extensions in the *Official Journal* under subsection 224(5) of the Act.
- (2) The Registrar must give a copy of the notice to the applicant.

21.20C Notification and opportunity to make representations

- (1) This regulation applies if:
 - (a) a party makes a request to the Registrar under this Division;
or
 - (b) the Registrar proposes to make a decision on the Registrar's own initiative under this Division.
- (2) The Registrar must:
 - (a) for paragraph (1)(a)—notify the other party of the request, including by giving the other party a copy of the request; or
 - (b) for paragraph (1)(b)—notify the parties of the proposed decision.

- (3) If the Registrar proposes to grant the request, the Registrar must give the parties an opportunity to make representations:
 - (a) in writing; or
 - (b) at a hearing; or
 - (c) by other means that the Registrar states in the notification.
- (4) The Registrar must notify the parties of the Registrar's decision.

21.20D Practice and procedure

The Registrar may:

- (a) decide the practice and procedure to be followed in an opposition to which this Division applies; and
- (b) direct the parties accordingly.

21.20E Hearing

- (1) The Registrar:
 - (a) must hold a hearing of the opposition if requested by a party in writing; or
 - (b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.
- (2) The hearing may, at the Registrar's discretion, be:
 - (a) an oral hearing; or
 - (b) by written submissions.
- (3) If the Registrar decides on an oral hearing:
 - (a) the Registrar must notify the parties of the date, time and place of the hearing; and
 - (b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
 - (c) the applicant must file a summary of submissions at least 5 business days before the hearing.
- (4) The Registrar may take into account a party's failure to file a summary of submissions under subregulation (3) in making an award of costs.

Note: Regulations 21.15 and 21.16 deal with hearings.

- (5) The Registrar must:
- (a) decide the opposition; and
 - (b) notify the parties of the Registrar's decision.

21.20F Registrar may give direction

- (1) The Registrar may give a direction in relation to an opposition to which this Division applies:
- (a) if requested by a party in writing; or
 - (b) on the Registrar's own initiative.
- (2) If the Registrar proposes to give a direction, the Registrar must give the parties an opportunity to make representations about the direction.
- (3) A direction must not be inconsistent with the Act or these Regulations.
- (4) The Registrar must notify the parties of the direction as soon as practicable.

21.20G Registrar must notify parties of dismissal or discontinuance of opposition

If an opposition is dismissed or discontinued, the Registrar must notify the parties of the dismissal or discontinuance.

20 Regulations 21.26 and 21.27

Repeal the regulations.

21 Paragraphs 21.28(1)(f) to (ha)

Repeal the paragraphs, substitute:

- (f) filing evidence under regulation 5.14, 9.16, 17A.34J or 17A.48P;

22 Paragraph 21.28(2)(b)

Omit "subregulation 21.26 (1)", substitute "section 96 of the Act or subregulation 17A.32(1), regulation 17.48F or subregulation 21.20B(1)".

Schedule 3 Amendments relating to reducing delays in resolution of patent and trade mark applications

23 Part 1 of Schedule 8

Repeal the Part, substitute:

Part 1—Costs

Item	Column 1 Matter	Column 2 Amount
1	Notice of intention to oppose	\$200
2	Statement of grounds and particulars	\$200
3	Receiving and perusing statement of grounds and particulars	\$130
4	Notice of intention to defend	\$200
5	Notice of opposition filed under subregulation 6.6(1) or 21.20B(1)	\$200
6	Receiving and perusing a notice of opposition filed under subregulation 6.6(1) or 21.20B(1)	\$130
7	Evidence in support	\$700
8	Receiving and perusing evidence in support	\$300
9	Evidence in answer	\$700
10	Receiving and perusing evidence in answer	\$210
11	Evidence in reply	\$350
12	Receiving and perusing evidence in reply	\$130
13	Preparation of cases for hearing	\$525
14	Attendance at hearing by registered patent attorney, registered trade marks attorney or solicitor without counsel	\$260 an hour, but not more than \$1,170 a day
15	Attendance at hearing by registered patent attorney, registered trade marks attorney or solicitor instructing counsel	\$200 an hour, but not more than \$900 a day
16	Counsel fees for attendance at a hearing	\$300 an hour, but not more than \$1,350 a day

24 Schedule 9 (table item 6)

Repeal the item, substitute:

6	Filing an application for an extension under	\$150 for each
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regulation 5.9, 5.15, 9.11, 9.18, 17A.34C, 17A.34K, 17A.48L or 17A.48T	month or part of a month for which the extension is sought
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25 Schedule 9 (table items 7 and 8)

Repeal the items, substitute:

- | | | |
|---|--|-------|
| 7 | Filing a notice of intention to oppose under: | |
| | (a) section 52 of the Act or regulation 17A.33; or | \$250 |
| | (b) section 96 of the Act or regulation 17A.48G | \$150 |
| 8 | Filing a notice of opposition under: | |
| | (a) subsection 224(6) of the Act; or | \$250 |
| | (b) section 65A of the Act | \$250 |

26 Schedule 9 (table item 13)

Repeal the item, substitute:

- | | | |
|----|---|-------|
| 13 | Filing an application for removal of a trade mark from the Register: | |
| | (a) for non-use under section 92 of the Act; or | \$250 |
| | (b) for cessation of protection for non-use under Subdivision D of Division 5 of Part 17A | \$150 |

27 Schedule 9 (table item 14)

Repeal the item, substitute:

- | | | |
|----|---|-------|
| 14 | Request for a hearing under regulation 5.17, 6.9, 9.17, 9.20, 17A.34M, 17A.48S, 17A.48V or 21.20E | \$600 |
|----|---|-------|

28 Schedule 9 (table item 16)

Repeal the item, substitute:

- | | | |
|----|---|---|
| 16 | Attendance at an oral hearing under regulation 5.17, 6.9, 9.17, 9.20, 17A.34M, 17A.48S, 17A.48V or 21.20E | \$600 for each day, or part of a day, less any amount paid under item 14 in relation to the hearing |
|----|---|---|

29 Schedule 9 (table item 17)

Schedule 3 Amendments relating to reducing delays in resolution of patent and trade mark applications

Repeal the item, substitute:

17	Attendance at an oral hearing to which item 16 does not apply	\$400 less any amount paid under item 15 in relation to the hearing
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30 Schedule 9 (table item 20)

Repeal the item, substitute:

20	Requesting a decision under regulation 21.15	\$300
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Designs Regulations 2004

31 Subregulation 9.05(5)

Repeal the subregulation, substitute:

- (5) A person may oppose the amendment by filing a notice of opposition, in an approved form, within one month from the publication of the notice under subregulation (4).

Note: For the circumstances in which an extension of time can be sought, see section 137 of the Act.

- (6) The Registrar must give a copy of the notice of opposition to the person who requested the amendment as soon as practicable.
- (7) If the amendment is not opposed, the Registrar must amend the entry as requested.
- (8) If the amendment is opposed, the Registrar must amend the entry if the Registrar decides to do so, subject to a decision of a tribunal or prescribed court in relation to the opposition.

32 Subregulation 11.13(3)

Repeal the subregulation, substitute:

- (3) For subsection 137(5) of the Act, the person must file a notice of opposition, in an approved form, within one month from the advertisement of the application.
- (3A) The Registrar must give a copy of the notice of opposition to the person who applied for the extension as soon as practicable.

Schedule 4—Amendments relating to IP professionals

Patents Regulations 1991

1 Subregulation 1.3(1)

Insert:

AAT means the Administrative Appeals Tribunal.

2 Subregulation 1.3(1)

Insert:

Code of Conduct means the standard of practice titled “Code of Conduct for Patent and Trade Marks Attorneys” that is established by the Board from time to time.

3 Subregulation 1.3(1) (definition of *Disciplinary Tribunal*)

Omit “under regulation 20.41”, substitute “by regulation 20.61”.

4 Subregulation 1.3(1)

Insert:

Register of Patent Attorneys means the register mentioned in section 198 of the Act.

5 Subregulation 1.3(1) (definition of *the Tribunal*)

Repeal the definition.

6 Chapter 20 (heading)

Repeal the heading, substitute:

Chapter 20—Individual Patent Attorneys

7 Before regulation 20.1

Insert:

20.1A Application of this Chapter

This Chapter applies to:

- (a) a patent attorney who is not an incorporated patent attorney;
and
- (b) an individual applying for registration as a patent attorney.

8 Subregulation 20.1(1) (definition of *Disciplinary Tribunal*)

Repeal the definition.

9 Subregulation 20.1(1) (definition of *Register or Register of Patent Attorneys*)

Repeal the definition.

10 Subregulation 20.1(1)

Insert:

serious offence means an offence that:

- (a) involves obtaining property or a financial advantage by deception or fraudulent conduct; and
- (b) is either:
 - (i) an indictable offence against a law of the Commonwealth, a State or a Territory (whether or not the offence may be dealt with summarily); or
 - (ii) an offence against a law of a foreign country that would be an indictable offence against a law of the Commonwealth, a State or a Territory if committed in Australia (whether or not the offence could be dealt with summarily if committed in Australia).

11 Regulation 20.22 (heading)

Repeal the heading, substitute:

20.22 Requirements for remaining on Register of Patent Attorneys

12 Part 6 of Chapter 20 (heading)

Repeal the heading, substitute:

Part 6—Removal of attorney’s name from Register of Patent Attorneys

13 Regulation 20.26 (heading)

Repeal the heading, substitute:

20.26 Voluntary removal of name from Register of Patent Attorneys

14 After Part 6 of Chapter 20

Insert:

Part 6A—Suspension of registration

20.28A Requirement to notify of serious offence

- (1) A registered patent attorney who has been charged with a serious offence must, within 14 days after being charged, notify the Designated Manager, in writing, of the charge.
- (2) If the registered patent attorney:
 - (a) fails to comply with subregulation (1); and
 - (b) does not have a reasonable excuse for failing to comply;the failure to comply constitutes unsatisfactory professional conduct.

20.28B Suspension of registration—serious offence

- (1) The Designated Manager may, by written notice to a registered patent attorney, suspend the registered patent attorney’s registration if the Designated Manager:
 - (a) is notified under subregulation 20.28A(1); or
 - (b) becomes aware that the registered patent attorney has been charged with a serious offence.
- (2) If the Designated Manager suspends the registered patent attorney’s registration:
 - (a) the suspension takes effect when the notice is given to the registered patent attorney; and

- (b) the Designated Manager must:
 - (i) give written notice to the Board of the suspension; and
 - (ii) by written notice, give the registered patent attorney 28 days after the date of the notice (a *show cause notice*) within which to show cause why the suspension should be lifted.
- (3) The Designated Manager must consider any information provided by the registered patent attorney in response to the show cause notice.
- (4) The Designated Manager must immediately end the suspension if:
 - (a) the Designated Manager becomes aware that the charge is not proceeded with or the prosecution of the charge is abandoned; or
 - (b) the Designated Manager becomes aware that the proceedings have been completed without a conviction being recorded; or
 - (c) the proceedings have been completed with a conviction being recorded and the Disciplinary Tribunal decides not to continue the suspension or cancel the registered patent attorney's registration; or
 - (d) the Designated Manager considers that the suspension is no longer necessary.
- (5) If the Designated Manager ends the suspension, the Designated Manager must notify, in writing, each of the following that the suspension has ended:
 - (a) the registered patent attorney;
 - (b) the Board;
 - (c) the Disciplinary Tribunal.

15 Part 7 of Chapter 20 (heading)

Repeal the heading, substitute:

Part 7—Restoring attorney's name to Register of Patent Attorneys

16 Regulation 20.29 (heading)

Repeal the heading, substitute:

20.29 Restoring attorney’s name to Register of Patent Attorneys

17 Regulation 20.30 (heading)

Repeal the heading, substitute:

20.30 Restoring attorney’s name to Register of Patent Attorneys following payment of unpaid fee

18 Regulation 20.31 (heading)

Repeal the heading, substitute:

20.31 Restoring attorney’s name to Register of Patent Attorneys in other circumstances

19 Regulation 20.32 (definition of *Code of Conduct*)

Repeal the definition.

20 Subregulation 20.44(2)

Omit “register”, substitute “Register of Patent Attorneys”.

21 After Chapter 20

Insert:

Chapter 20A—Incorporated Patent Attorney

Part 1—Introduction

20A.1 Application of Chapter 20A

This Chapter applies to:

- (a) an incorporated patent attorney; and
- (b) a company applying for registration as an incorporated patent attorney.

20A.2 Definitions

In this Chapter:

annual registration fee means the fee set out in item 109 or 110 of Schedule 7.

professional indemnity insurance means insurance for claims that may be made against the company in relation to its business, practices or acts as an incorporated patent attorney.

Part 2—Obtaining registration for first time

20A.3 Form of application

An application for registration as an incorporated patent attorney must:

- (a) be in writing, in a form approved by the Designated Manager; and
- (b) be accompanied by the following evidence and material:
 - (i) the name of each patent attorney director of the company;
 - (ii) evidence that the company is a registered company under the *Corporations Act 2001*;
 - (iii) evidence that the company has adequate and appropriate professional indemnity insurance; and
- (c) be accompanied by the fee set out in item 108 of Schedule 7.

20A.4 Certificate of registration

If the Designated Manager registers a company as an incorporated patent attorney, the Designated Manager must give the company a certificate of registration as soon as practicable.

Part 3—Maintaining registration

20A.5 Requirements for remaining on Register of Patent Attorneys

- (1) To remain on the Register of Patent Attorneys, a registered incorporated patent attorney must, for every year of registration, pay the annual registration fee.
- (2) The Designated Manager must, not later than 1 June in each year, give to each registered incorporated patent attorney notice of the fee that is payable.
- (3) The annual registration fee is payable on 1 July each year by a registered incorporated patent attorney:
 - (a) whose name is on the Register of Patent Attorneys on that day; and
 - (b) that has not asked the Designated Manager, under regulation 20A.6, to remove its name from the Register of Patent Attorneys.

Part 4—Removal from Register of Patent Attorneys

20A.6 Voluntary removal of name from Register of Patent Attorneys

If a patent attorney director of a registered incorporated patent attorney asks the Designated Manager, in writing, to remove the name of the registered incorporated patent attorney from the Register of Patent Attorneys, the Designated Manager must comply with the request.

20A.7 Failure to pay annual registration fee

If a registered incorporated patent attorney does not pay the annual registration fee by 31 July in the year the fee is payable, the Designated Manager must:

- (a) remove the name of the incorporated patent attorney from the Register of Patent Attorneys; and
- (b) notify, in writing, the attorney of the removal.

20A.8 Failure to maintain professional indemnity insurance

- (1) If an incorporated patent attorney does not maintain adequate and appropriate professional indemnity insurance, the Designated Manager may remove the name of the attorney from the Register of Patent Attorneys.
- (2) If the Designated Manager removes the name of the incorporated patent attorney from the Register of Patent Attorneys, the Designated Manager must notify, in writing, the attorney of the removal.

Part 5—Discipline

Division 1—General

20A.9 Definitions

In this Part:

former attorney means a person whose registration as an incorporated patent attorney has been suspended or cancelled under this Part.

20A.10 Board may apply for cancellation or suspension of incorporated patent attorney's registration

- (1) The Board may apply to the Disciplinary Tribunal to cancel or suspend an incorporated patent attorney's registration if:
 - (a) a registered patent attorney who is, or was, an employee or officer of the incorporated patent attorney is found guilty of professional misconduct under subregulation 20.43(1); and
 - (b) the professional misconduct occurred when the registered patent attorney was an employee or officer of the incorporated patent attorney; and
 - (c) The Disciplinary Tribunal has cancelled or suspended the patent attorney's registration under subregulation 20.44(1).
 - (2) Before applying to the Disciplinary Tribunal, the Board may request an incorporated patent attorney to provide the Board with information relating to the professional misconduct.
-

- (3) In deciding whether to apply to the Disciplinary Tribunal, the Board may consider the following:
 - (a) the professional misconduct engaged in by the registered patent attorney;
 - (b) the behaviour of the incorporated patent attorney's officers and employees;
 - (c) whether officers and employees of the incorporated patent attorney have complied with the Code of Conduct;
 - (d) any information provided under subregulation (2).
- (4) An application by the Board to the Disciplinary Tribunal must:
 - (a) be in writing; and
 - (b) set out the reasons why the Board considers the incorporated patent attorney's registration should be cancelled or suspended.
- (5) The Board must give the incorporated patent attorney, as soon as practicable after the application is made to the Disciplinary Tribunal, a copy of the application.

Division 2—Proceedings in Disciplinary Tribunal

20A.11 Procedure of Disciplinary Tribunal

- (1) The Disciplinary Tribunal may determine procedure that is not set out in this Division.
- (2) Proceedings before the Tribunal are to be conducted quickly and informally, while allowing for proper consideration of the matter before the Tribunal.
- (3) The Tribunal is not bound by the rules of evidence but may be informed on any matter in the manner it chooses.
- (4) The Tribunal may take evidence on oath or on affirmation and, for that purpose, may administer an oath or affirmation.

20A.12 Notification of hearing

- (1) The Disciplinary Tribunal must, as soon as practicable after receiving an application under regulation 20A.10, fix a day, time and place to hear the application.
- (2) The Disciplinary Tribunal must, as soon as practicable, notify the incorporated patent attorney and the Board of that day, time and place.
- (3) The day of hearing must not be less than 21 days after the day the incorporated patent attorney is notified of the day, time and place for the hearing.

20A.13 Hearings to be public except in special circumstances

- (1) A hearing before the Disciplinary Tribunal must be in public.
- (2) However, if the Disciplinary Tribunal is reasonably satisfied that it is desirable to do so, in the public interest or because of the confidential nature of any evidence or matter, the Tribunal may:
 - (a) direct that a hearing, or a part of a hearing, is to take place in private and give directions as to the persons who may be present; and
 - (b) give directions restricting or prohibiting the publication or disclosure of:
 - (i) evidence given before the Tribunal, whether in public or in private; or
 - (ii) matters contained in documents lodged with the Tribunal or received in evidence by the Tribunal.
- (3) A person commits an offence if the person:
 - (a) is given a direction under paragraph (2)(a) or (b); and
 - (b) does not comply with the direction.

Penalty: 5 penalty units.

20A.14 Representation before Disciplinary Tribunal

- (1) At the hearing before the Disciplinary Tribunal, the incorporated patent attorney must be represented by a patent attorney director of the incorporated patent attorney or a legal practitioner.
- (2) A party to proceedings before the Disciplinary Tribunal, or a representative of the party, may request the Tribunal to summon witnesses.

20A.15 Summoning of witnesses

- (1) For the purpose of the hearing before the Disciplinary Tribunal, the Tribunal may, by instrument in writing signed by the person constituting the Tribunal:
 - (a) summon a person to appear before the Tribunal to give evidence and to produce any documents or articles mentioned in the summons; or
 - (b) summon a patent attorney director of the incorporated patent attorney to appear before the Tribunal:
 - (i) to produce any documents or articles mentioned in the summons; and
 - (ii) to give evidence to identify the documents or articles.
- (2) A patent attorney director who is summoned must appear in person.

20A.16 Offences by persons appearing before Disciplinary Tribunal

- (1) A person commits an offence if the person:
 - (a) is summoned to appear before the Disciplinary Tribunal; and
 - (b) does not comply with the summons by:
 - (i) appearing as required by the summons; and
 - (ii) producing documents or articles as required by the summons; and
 - (iii) appearing and reporting to the Tribunal, as required.

Penalty: 10 penalty units.

- (2) It is a defence to a prosecution for an offence against subregulation (1) if:

- (a) the defendant is prevented or hindered from complying with the summons by:
 - (i) a circumstance mentioned in Part 2.3 of the *Criminal Code*; or
 - (ii) any other circumstance that the Disciplinary Tribunal reasonably considers is an impediment to the defendant complying with the summons; or
- (b) in relation to paragraph (1)(c)—the defendant is excused by the Disciplinary Tribunal.

Note: A defendant bears an evidential burden in relation to the matters mentioned in subparagraph (2)(a)(i)(see section 13.3 of the *Criminal Code*).

- (3) A person commits an offence if:
 - (a) the person:
 - (i) is not a patent attorney director to whom subregulation (5) applies; and
 - (ii) appears as a witness before the Disciplinary Tribunal; and
 - (iii) has been paid expenses and allowances; and
 - (b) the expenses and allowances have been determined by the Disciplinary Tribunal in accordance with Part 2 of Schedule 8; and
 - (c) the person refuses:
 - (i) to be sworn or make an affirmation; or
 - (ii) to answer a question relevant to the evidence that the person was summoned to give.

Penalty: 10 penalty units.

- (4) Strict liability applies to the physical element of an offence against subregulation (3) that is constituted by:
 - (a) the circumstance mentioned in subparagraph (3)(a)(i); and
 - (b) the circumstance mentioned in paragraph (3)(b).

Note: For *strict liability*, see section 6.1 of the *Criminal Code*.

- (5) A person commits an offence if the person:
 - (a) is a patent attorney director who has been summoned to appear at a hearing before the Disciplinary Tribunal; and

- (b) refuses:
- (i) to be sworn or to make an affirmation; or
 - (ii) to answer a question relevant to the evidence that the person was summoned to give.

Penalty: 10 penalty units.

- (6) It is a defence to a prosecution for an offence against subregulation (3) or (5) if a person mentioned in the subregulation refused to answer a question or to produce a document or article because the answer to the question, or the document or article, may tend to prove that the person has committed an offence against a law of the Commonwealth or of a State or Territory.

20A.17 Protection of person constituting Disciplinary Tribunal, witnesses etc.

- (1) A person:
- (a) constituting the Disciplinary Tribunal; or
 - (b) appointed under subregulation 20.64(2);
- has, in the exercise of the powers and the performance of the functions of the Tribunal under this Part, the same protection and immunity as a Justice of the High Court.
- (2) A member of the Board has, in exercising a power under this Part, the same protection and immunity as a Justice of the High Court.
- (3) A legal practitioner or other person appearing before the Disciplinary Tribunal has the same protection and immunity as a barrister has in appearing for a party in proceedings in the High Court.
- (4) A person summoned to attend or appearing before the Disciplinary Tribunal as a witness:
- (a) has the same protection; and
 - (b) is, in addition to the penalties provided by this Part, subject to the same liabilities;
- as a witness in proceedings in the High Court.

20A.18 Decision of Disciplinary Tribunal

- (1) After hearing an application for the cancellation or suspension of the incorporated patent attorney's registration, the Disciplinary Tribunal may:
 - (a) cancel the attorney's registration as an incorporated patent attorney; or
 - (b) suspend the attorney's registration as an incorporated patent attorney.
- (2) The Disciplinary Tribunal may also impose conditions on the attorney's return to the Register of Patent Attorneys after the cancellation has been lifted or the period of suspension has elapsed.
- (3) In making a decision under this regulation, the Disciplinary Tribunal may consider the following:
 - (a) the professional misconduct engaged in;
 - (b) the behaviour of the incorporated patent attorney's officers and employees;
 - (c) whether officers and employees of the incorporated patent attorney had complied with the Code of Conduct;
 - (d) findings made about the conduct of the incorporated patent attorney in any other proceedings brought before the Disciplinary Tribunal;
 - (e) findings made about the conduct of the incorporated patent attorney's employees and officers in any other proceedings brought before the Disciplinary Tribunal;
 - (f) if the incorporated patent attorney failed, without reasonable excuse, to provide information requested by the Board under subregulation 20A.10(2)—the incorporated patent attorney's failure to provide requested information.

20A.19 Notification and publication of decisions of Disciplinary Tribunal

- (1) The Disciplinary Tribunal must, within 14 days after making a decision under regulation 20A.18:
 - (a) prepare a written statement that states:
 - (i) the decision of the Tribunal; and

- (ii) the reasons for the decision; and
 - (iii) the findings on any material questions of fact; and
 - (iv) evidence or other material on which the findings of fact are based; and
 - (b) give a copy of the statement to:
 - (i) the incorporated patent attorney who is the subject of the decision; and
 - (ii) the Board; and
 - (iii) the Designated Manager; and
 - (c) publish, in the *Official Journal*, a written statement that sets out the decision of the Tribunal.
- (2) If the registration of an incorporated patent attorney is suspended, the Designated Manager must note the suspension and its duration in the Register of Patent Attorneys.
- (3) If the registration of an incorporated patent attorney is cancelled, the Designated Manager must remove the name of the incorporated patent attorney from the Register of Patent Attorneys.

20A.20 Completion of outstanding business

- (1) If the Disciplinary Tribunal cancels the registration of an incorporated patent attorney, the Tribunal may appoint a registered patent attorney to complete the unfinished patents work of the former attorney.
- (2) If the Disciplinary Tribunal suspends the registration of an incorporated patent attorney, the Tribunal may appoint a registered patent attorney to carry on the former attorney's patents work for:
 - (a) the period of the suspension; or
 - (b) a specified period, not longer than the period of suspension.
- (3) The Disciplinary Tribunal must not appoint a registered patent attorney under subregulation (1) or (2) unless the registered patent attorney consents to the appointment.
- (4) A registered patent attorney appointed under subregulation (1) or (2) may only act as a registered patent attorney for a client of the former attorney if the client has given consent for the appointed attorney to act.

20A.21 Former attorney may be required to provide assistance

- (1) A registered patent attorney appointed under subregulation 20A.20(1) or (2) may, by written notice, request the former attorney to make available the following:
 - (a) information about the patents work that the appointed attorney may reasonably require;
 - (b) books, accounts or other documents about the patents work that the appointed attorney may reasonably require;
 - (c) money held by the former attorney:
 - (i) on behalf of a client; or
 - (ii) that has been paid by a client in relation to services not yet performed for the client.
- (2) A person commits an offence if the person:
 - (a) is a former attorney; and
 - (b) is given a notice under subregulation (1); and
 - (c) fails to comply with the notice.

Penalty: 5 penalty units.

- (3) It is a defence to a prosecution for an offence against subregulation (2) if the former attorney is prevented or hindered from complying with a request in the notice by:
 - (a) a circumstance mentioned in Part 2.3 of the *Criminal Code*; or
 - (b) any other circumstance that the Disciplinary Tribunal reasonably considers is an impediment to the defendant complying with the summons.

Note: A defendant bears an evidential burden in relation to the question of whether he or she has a reasonable excuse (see section 13.3 of the *Criminal Code*).

Part 6—Restoring attorney’s name to Register of Patent Attorneys

20A.22 Restoring name to Register of Patent Attorneys

- (1) This regulation sets out circumstances in which the Designated Manager must restore to the Register of Patent Attorneys the name of an incorporated patent attorney that has been removed under:
 - (a) regulation 20A.6, 20A.7 or 20A.8; or
 - (b) subsection 201B(7) of the Act.
- (2) The Designated Manager must restore the name if:
 - (a) the attorney requests the Designated Manager, in the form approved by the Designated Manager, to restore the name; and
 - (b) the request includes:
 - (i) the name of each patent attorney director of the company; and
 - (ii) evidence that the company is a registered company under the *Corporations Act 2001*; and
 - (ii) evidence that the company has adequate and appropriate professional indemnity insurance; and
 - (c) the request is made:
 - (i) if the name was removed under regulation 20A.7—on or before 1 September of the year that the name was removed from the Register of Patent Attorneys, or within a further period that the Designated Manager allows; or
 - (ii) in any other case—within 3 years after the name was removed from the Register of Patent Attorneys; and
 - (d) the attorney pays:
 - (i) the annual registration fee for the year the reinstatement is made; and
 - (ii) the fee mentioned in item 111 of Schedule 7.

22 Subregulation 22.12(1)

Omit “Patent Attorneys”.

23 Subparagraphs 22.26(2)(c)(ii) and (iii)

Repeal the subparagraphs, substitute:

- (ii) regulation 20.28B (suspension of registration—serious offence);
- (iii) subregulation 20.29(3) (imposing a condition when restoring attorney’s name to Register of Patent Attorneys);

24 Subparagraph 22.26(2)(c)(iv)

Omit “Register in other circumstances”); or”, substitute Register of Patent Attorneys in other circumstances);”.

25 At the end of paragraph 22.26(2)(c)

Add:

- ; (v) regulation 20A.8 (failing to maintain professional indemnity insurance); or

26 At the end of paragraph 22.26(2)(d)

Add:

- ; (vi) regulation 20A.18 (decision of Disciplinary Tribunal).

27 Part 1 of Schedule 7 (at the end of the table)

Add:

108	Applying for registration as an incorporated patent attorney	300
109	Annual registration of an incorporated patent attorney	350
110	Annual registration fee payable for combined registration as an incorporated patent attorney and incorporated trade marks attorney	550
111	Applying to be restored to the Register of Patent Attorneys, as authorised by regulation 20A.22	250

28 Further amendments—Register

The following provisions are amended by omitting “Register” and substituting “Register of Patent Attorneys”:

- (a) subregulations 20.22(1) and (2);
- (b) subregulations 20.28(1), (2) and (3);

- (c) subregulations 20.29(1), (2), (3) and (4);
- (d) regulation 20.30;
- (e) subregulation 20.31(1).

29 Further amendments—Tribunal

The following provisions are amended by omitting “Tribunal” and substituting “AAT”:

- (a) subparagraph 6.2(1)(b)(i);
- (b) paragraphs 10.6(4)(a) and (b);
- (c) paragraph 10.7(5)(b);
- (d) paragraph 13.4(1)(h);
- (e) subparagraph 13.4(1)(j)(ii);
- (f) paragraph 22.11(1B)(a);
- (g) subregulations 22.26(2), (3) and (5).

Trade Marks Regulations 1995

30 Regulation 2.1

Insert:

AAT means the Administrative Appeals Tribunal.

31 Regulation 2.1

Insert:

Board means the Professional Standards Board for Patent and Trade Marks Attorneys established by section 227A of the *Trade Marks Act 1990*.

32 Regulation 2.1

Insert:

Designated Manager has the same meaning as in the *Patents Act 1990*.

33 Regulation 2.1

Insert:

Disciplinary Tribunal means the Patent and Trade Marks Attorneys Disciplinary Tribunal established by regulation 20.61 of the *Patents Regulations 1991*.

34 Regulation 2.1

Insert:

Register of Trade Marks Attorneys means the register mentioned in section 228A of the Act.

35 Before regulation 20.1

Insert:

20.1A Application of Part

This Part applies to:

- (a) a trade marks attorney who is not an incorporated trade marks attorney; and
- (b) an individual applying for registration as a trade marks attorney.

36 Subregulation 20.1(1) (definition of *Board*)

Repeal the definition.

37 Subregulation 20.1(1) (definition of *Register* or *Register of Trade Marks Attorneys*)

Repeal the definition.

38 Subregulation 20.1(1)

Insert:

serious offence means an offence that:

- (a) involves obtaining property or a financial advantage by deception or fraudulent conduct; and
- (b) is either:
 - (i) an indictable offence against a law of the Commonwealth, a State or a Territory (whether or not the offence may be dealt with summarily); or

- (ii) an offence against a law of a foreign country that would be an indictable offence against a law of the Commonwealth, a State or a Territory if committed in Australia (whether or not the offence could be dealt with summarily if committed in Australia).

unsatisfactory professional conduct has the meaning given by regulation 20.32 of the *Patents Regulations 1991*.

39 Division 5 of Part 20 (heading)

Repeal the heading, substitute:

Division 5—Maintaining registration and removing and restoring name to Register of Trade Marks Attorneys

40 Regulation 20.14 (heading)

Repeal the heading, substitute:

20.14 Maintaining registration and removing and restoring name to Register of Trade Marks Attorneys

41 After Division 5

Insert:

Division 5A—Suspension of registration

20.14A Requirement to notify of serious offence

- (1) A registered trade marks attorney who has been charged with a serious offence must, within 14 days after being charged, notify the Designated Manager, in writing, of the charge.
- (2) If the registered trade marks attorney:
 - (a) fails to comply with subregulation (1); and
 - (b) does not have a reasonable excuse for failing to comply;the failure to comply constitutes unsatisfactory professional conduct.

20.14B Suspension from Register—serious offence

- (1) The Designated Manager may, by written notice to a registered trade marks attorney, suspend the registered trade marks attorney's registration if the Designated Manager:
 - (a) is notified under subregulation 20.14A(1); or
 - (b) becomes aware that the registered trade marks attorney has been charged with a serious offence.
- (2) If the Designated Manager suspends the attorney's registration:
 - (a) the suspension takes effect when the notice is given to the registered trade marks attorney; and
 - (b) the Designated Manager must:
 - (i) give written notice to the Board of the suspension; and
 - (ii) by written notice, give the registered trade marks attorney 28 days after the date of the notice (a ***show cause notice***) within which to show cause why the suspension should be lifted.
- (3) The Designated Manager must consider any information provided by the registered trade marks attorney in response to the show cause notice.
- (4) The Designated Manager must immediately end the suspension if:
 - (a) the Designated Manager becomes aware that the charge is not proceeded with or the prosecution of the charge is abandoned; or
 - (b) the Designated Manager becomes aware that the proceedings have been completed without a conviction being recorded; or
 - (c) the proceedings have been completed with a conviction being recorded and the Disciplinary Tribunal decides not to continue the suspension or cancel the registered trade marks attorney's registration; or
 - (d) the Designated Manager considers that the suspension is no longer necessary.
- (5) If the Designated Manager ends the suspension, the Designated Manager must notify, in writing, each of the following that the suspension has ended:
 - (a) the registered trade marks attorney;

- (b) the Board;
- (c) the Disciplinary Tribunal.

42 After Part 20

Insert:

Part 20A—Incorporated trade marks attorneys

Division 1—General

20A.1 Application of Part 20A

This Part applies to:

- (a) an incorporated trade marks attorney; and
- (b) a company applying for registration as an incorporated trade marks attorney.

20A.2 Definitions

In this Part:

professional indemnity insurance means insurance for claims that may be made against the company in relation to its business, practices or acts as an incorporated trade marks attorney.

Division 2—Obtaining registration for first time

20A.3 Form of application

An application for registration as an incorporated trade marks attorney must:

- (a) be in writing, in a form approved by the Designated Manager; and
- (b) be accompanied by the following evidence and material:
 - (i) the name of each trade marks attorney director of the company;
 - (ii) evidence that the company is a registered company under the *Corporations Act 2001*;

- (iii) evidence that the company has adequate and appropriate professional indemnity insurance; and
- (c) be accompanied by the fee set out in item 36 of Schedule 9.

20A.4 Certificate of registration

If the Designated Manager registers a company as an incorporated trade marks attorney, the Designated Manager must give the company a certificate of registration as soon as practicable.

Division 3—Maintaining registration

20A.5 Requirements for remaining on Register of Trade Marks Attorneys

- (1) To remain on the Register of Trade Marks Attorneys, a registered incorporated trade marks attorney must, for every year of registration, pay the annual registration fee.
- (2) The Designated Manager must, not later than 1 June in each year, give to each registered incorporated trade marks attorney notice of the fee that is payable.
- (3) The annual registration fee is payable on 1 July each year by a registered incorporated trade marks attorney:
 - (a) whose name is on the Register of Trade Marks Attorneys on that day; and
 - (b) that has not asked the Designated Manager, under regulation 20A.6, to remove its name from the Register of Trade Marks Attorneys.

Division 4—Removal from Register of Trade Marks Attorneys

20A.6 Voluntary removal of name from Register of Trade Marks Attorneys

If a trade marks attorney director of a registered incorporated trade marks attorney asks the Designated Manager, in writing, to remove the name of the incorporated trade marks attorney from the

Register of Trade Marks Attorneys, the Designated Manager must comply with the request.

20A.7 Failure to pay annual registration fee

If a registered incorporated trade marks attorney does not pay the annual registration fee by 31 July in the year the fee is payable, the Designated Manager must:

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

20A.8 Failure to maintain professional indemnity insurance

- (1) If an incorporated trade marks attorney does not maintain adequate and appropriate professional indemnity insurance, the Designated Manager may remove the name of the attorney from the Register of Trade Marks Attorneys.
- (2) If the Designated Manager removes the name of the incorporated trade marks attorney from the Register of Trade Marks Attorneys, the Designated Manager must notify, in writing, the attorney of the removal.

Division 5—Discipline

Subdivision A—General

20A.9 Definitions

In this Part:

former attorney means a person whose registration as an incorporated trade marks attorney has been suspended or cancelled under this Division.

20A.10 Board may apply for cancellation or suspension of incorporated trade marks attorney's registration

- (1) The Board may apply to the Disciplinary Tribunal to cancel or suspend an incorporated trade marks attorney's registration if:

- (a) a registered trade marks attorney who is, or was, an employee or officer of the incorporated trade marks attorney is found guilty of professional misconduct under Division 5 of Part 20; and
 - (b) the professional misconduct occurred when the registered trade marks attorney was an employee or officer of the incorporated trade marks attorney; and
 - (c) the Disciplinary Tribunal has cancelled or suspended the trade marks attorney's registration.
- (2) Before applying to the Disciplinary Tribunal, the Board may request an incorporated trade marks attorney to provide the Board with information relating to the professional misconduct.
- (3) In deciding whether to apply to the Disciplinary Tribunal, the Board may consider the following:
- (a) the professional misconduct engaged in by the registered trade marks attorney;
 - (b) the behaviour of the incorporated trade marks attorney's officers and employees;
 - (c) whether officers and employees of the incorporated trade marks attorney have complied with the Code of Conduct;
 - (d) any information provided under subregulation (2).
- (4) An application by the Board to the Disciplinary Tribunal must:
- (a) be in writing; and
 - (b) set out the reasons why the Board considers the incorporated trade marks attorney's registration should be cancelled or suspended.
- (5) The Board must give the incorporated trade marks attorney, as soon as practicable after the application is made to the Disciplinary Tribunal, a copy of the application.

Subdivision B—Proceedings in Disciplinary Tribunal

20A.11 Procedure of Disciplinary Tribunal

- (1) The Disciplinary Tribunal may determine procedure that is not set out in this Division.

- (2) Proceedings before the Tribunal are to be conducted quickly and informally, while allowing for proper consideration of the matter before the Tribunal.
- (3) The Tribunal is not bound by the rules of evidence but may be informed on any matter in the manner it chooses.
- (4) The Tribunal may take evidence on oath or on affirmation and, for that purpose, may administer an oath or affirmation.

20A.12 Notification of hearing

- (1) The Disciplinary Tribunal must, as soon as practicable after receiving an application under regulation 20A.10, fix a day, time and place to hear the application.
- (2) The Disciplinary Tribunal must, as soon as practicable, notify the incorporated trade marks attorney and the Board of that day, time and place.
- (3) The day of hearing must not be less than 21 days after the day the incorporated trade marks attorney is notified of the hearing.

20A.13 Hearings to be public except in special circumstances

- (1) A hearing before the Disciplinary Tribunal must be in public.
- (2) However, if the Disciplinary Tribunal is reasonably satisfied that it is desirable to do so, in the public interest or because of the confidential nature of any evidence or matter, the Tribunal may:
 - (a) direct that a hearing, or a part of a hearing, is to take place in private and give directions as to the persons who may be present; and
 - (b) give directions restricting or prohibiting the publication or disclosure of:
 - (i) evidence given before the Tribunal, whether in public or in private; or
 - (ii) matters contained in documents lodged with the Tribunal or received in evidence by the Tribunal.
- (3) A person commits an offence if the person:
 - (a) is given a direction under paragraph (2)(a) or (b); and

(b) does not comply with the direction.

Penalty: 5 penalty units.

20A.14 Representation before Disciplinary Tribunal

- (1) At the hearing before the Disciplinary Tribunal, the incorporated trade marks attorney must be represented by a trade marks attorney director of the incorporated trade marks attorney or a legal practitioner.
- (2) A party to proceedings before the Disciplinary Tribunal, or a representative of the party, may request the Tribunal to summon witnesses.

20A.15 Summoning of witnesses

- (1) For the purpose of the hearing before the Disciplinary Tribunal, the Tribunal may, by instrument in writing signed by the person constituting the Tribunal:
 - (a) summon a person to appear before the Tribunal to give evidence and to produce any documents or articles mentioned in the summons; or
 - (b) summon a trade marks attorney director of the incorporated trade marks attorney to appear before the Tribunal:
 - (i) to produce any documents or articles mentioned in the summons; and
 - (ii) to give evidence to identify the documents or articles.
- (2) A trade marks attorney director who is summoned must appear in person.

20A.16 Offences by persons appearing before Disciplinary Tribunal

- (1) A person commits an offence if the person:
 - (a) is summoned to appear before the Disciplinary Tribunal; and
 - (b) does not comply with the summons by:
 - (i) appearing as required by the summons; and
 - (ii) producing documents or articles as required by the summons; and

(iii) appearing and reporting to the Tribunal, as required.

Penalty: 10 penalty units.

- (2) It is a defence to a prosecution for an offence against subregulation (1) if:
- (a) the defendant is prevented or hindered from complying with the summons by:
 - (i) a circumstance mentioned in Part 2.3 of the *Criminal Code*; or
 - (ii) any other circumstance that the Disciplinary Tribunal reasonably considers is an impediment to the defendant complying with the summons; or
 - (b) in relation to paragraph (1)(c)—the defendant is excused by the Disciplinary Tribunal.

Note: A defendant bears an evidential burden in relation to the matters mentioned in subparagraph (2)(a)(i)(see section 13.3 of the *Criminal Code*).

- (3) A person commits an offence if:
- (a) the person:
 - (i) is not a trade marks attorney director to whom subregulation (5) applies; and
 - (ii) appears as a witness before the Disciplinary Tribunal; and
 - (iii) has been paid expenses and allowances; and
 - (b) the expenses and allowances have been determined by the Disciplinary Tribunal in accordance with Part 2 of Schedule 8 to the *Patents Regulations 1991*; and
 - (c) the person refuses:
 - (i) to be sworn or make an affirmation; or
 - (ii) to answer a question relevant to the evidence that the person was summoned to give.

Penalty: 10 penalty units.

- (4) Strict liability applies to the physical element of an offence against subregulation (3) that is constituted by:
- (a) the circumstance mentioned in subparagraph (3)(a)(i); and
 - (b) the circumstance mentioned in paragraph (3)(b).

Note: For *strict liability*, see section 6.1 of the *Criminal Code*.

- (5) A person commits an offence if the person:
- (a) is a trade marks attorney director who has been summoned to appear at a hearing before the Disciplinary Tribunal; and
 - (b) refuses:
 - (i) to be sworn or to make an affirmation; or
 - (ii) to answer a question relevant to the evidence that the person was summoned to give.

Penalty: 10 penalty units.

- (6) It is a defence to a prosecution for an offence against subregulation (3) or (5) if a person mentioned in the subregulation refused to answer a question or to produce a document or article because the answer to the question, or the document or article, may tend to prove that the person has committed an offence against a law of the Commonwealth or of a State or Territory.

20A.17 Protection of person constituting Disciplinary Tribunal, witnesses etc.

- (1) A person:
- (a) constituting the Disciplinary Tribunal; or
 - (b) appointed to the Disciplinary Tribunal under subregulation 20.64(2) of the *Patents Regulations 1991*;
- has, in the exercise of the powers and the performance of the functions of the Tribunal under this Part, the same protection and immunity as a Justice of the High Court.
- (2) A member of the Board has, in exercising a power under this Part, the same protection and immunity as a Justice of the High Court.
- (3) A legal practitioner or other person appearing before the Disciplinary Tribunal has the same protection and immunity as a barrister has in appearing for a party in proceedings in the High Court.
- (4) A person summoned to attend or appearing before the Disciplinary Tribunal as a witness:
- (a) has the same protection; and

(b) is, in addition to the penalties provided by this Part, subject to the same liabilities;
as a witness in proceedings in the High Court.

20A.18 Decision of Disciplinary Tribunal

- (1) After hearing an application for the cancellation or suspension of the incorporated trade marks attorney's registration, the Disciplinary Tribunal may:
 - (a) cancel the attorney's registration as an incorporated trade marks attorney; or
 - (b) suspend the attorney's registration as an incorporated trade marks attorney.
- (2) The Disciplinary Tribunal may also impose conditions on the attorney's return to the Register of Trade Marks Attorneys after the cancellation has been lifted or the period of suspension has elapsed.
- (3) In making a decision under this regulation, the Disciplinary Tribunal may consider the following:
 - (a) the professional misconduct engaged in;
 - (b) the behaviour of the incorporated trade marks attorney's officers and employees;
 - (c) whether officers and employees of the incorporated trade marks attorney had complied with the Code of Conduct;
 - (d) findings made about the conduct of the incorporated trade marks attorney in any other proceedings brought before the Disciplinary Tribunal;
 - (e) findings made about the conduct of the incorporated trade marks attorney's employees and officers in any other proceedings brought before the Disciplinary Tribunal;
 - (f) if the incorporated trade marks attorney failed, without reasonable excuse, to provide information requested by the Board under subregulation 20A.10(2)—the incorporated trade marks attorney's failure to provide requested information.

20A.19 Notification and publication of decisions of Disciplinary Tribunal

- (1) The Disciplinary Tribunal must, within 14 days after making a decision under regulation 20A.18:
 - (a) prepare a written statement that states:
 - (i) the decision of the Tribunal; and
 - (ii) the reasons for the decision; and
 - (iii) the findings on any material questions of fact; and
 - (iv) evidence or other material on which the findings of fact are based; and
 - (b) give a copy of the statement to:
 - (i) the incorporated trade marks attorney who is the subject of the decision; and
 - (ii) the Board; and
 - (iii) the Designated Manager; and
 - (c) publish, in the *Official Journal*, a written statement that sets out the decision of the Tribunal.
- (2) If the registration of an incorporated trade marks attorney is suspended, the Designated Manager must note the suspension and its duration in the Register of Trade Marks Attorneys.
- (3) If the registration of an incorporated trade marks attorney is cancelled, the Designated Manager must remove the name of the incorporated trade marks attorney from the Register of Trade Marks Attorneys.

20A.20 Completion of outstanding business

- (1) If the Disciplinary Tribunal cancels the registration of an incorporated trade marks attorney, the Tribunal may appoint a registered trade marks attorney to complete the unfinished trade marks work of the former attorney.
- (2) If the Disciplinary Tribunal suspends the registration of an incorporated trade marks attorney, the Tribunal may appoint a registered trade marks attorney to carry on the former attorney's trade marks work for:
 - (a) the period of the suspension; or

- (b) a specified period, not longer than the period of suspension.
- (3) The Disciplinary Tribunal must not appoint a registered trade marks attorney under subregulation (1) or (2) unless the registered trade marks attorney consents to the appointment.
- (4) A registered trade marks attorney appointed under subregulation (1) or (2) may only act as a registered trade marks attorney for a client of the former attorney if the client has given consent for the appointed attorney to act.

20A.21 Former attorney may be required to provide assistance

- (1) A registered trade marks attorney appointed under subregulation 20A.20(1) or (2) may, by written notice, request the former attorney to make available:
 - (a) information about the trade marks work that the appointed attorney may reasonably require; or
 - (b) books, accounts or other documents about the trade marks work that the appointed attorney may reasonably require; or
 - (c) money held by the former attorney:
 - (i) on behalf of a client; or
 - (ii) that has been paid by a client in relation to services not yet performed for the client.
- (2) A person commits an offence if the person:
 - (a) is a former attorney; and
 - (b) is given a notice under subregulation (1); and
 - (c) fails to comply with the notice.

Penalty: 5 penalty units.

- (3) It is a defence to a prosecution for an offence against subregulation (2) if the former attorney is prevented or hindered from complying with a request in the notice by:
 - (a) a circumstance mentioned in Part 2.3 of the *Criminal Code*; or
 - (b) any other circumstance that the Disciplinary Tribunal reasonably considers is an impediment to the defendant complying with the summons.

Note: A defendant bears an evidential burden in relation to the question of whether he or she has a reasonable excuse (see section 13.3 of the *Criminal Code*).

Division 6—Returning to Register of Trade Marks Attorneys

20A.22 Restoring name to Register of Trade Marks Attorneys

- (1) This regulation sets out circumstances in which the Designated Manager must restore to the Register of Trade Marks Attorneys the name of an incorporated trade marks attorney that has been removed from the Register of Trade Marks Attorneys under:
 - (a) regulation 20A.6, 20A.7 or 20A.8; or
 - (b) subsection 157A(7) of the Act.
- (2) The Designated Manager must restore the name if:
 - (a) the attorney requests the Designated Manager, in the form approved by the Designated Manager, to restore the name; and
 - (b) the request includes:
 - (i) the name of each trade marks attorney director of the company; and
 - (ii) evidence that the company is a registered company under the *Corporations Act 2001*; and
 - (iii) evidence that the company has adequate and appropriate professional indemnity insurance; and
 - (c) the request is made:
 - (i) if the name was removed under regulation 20A.7—on or before 1 September of the year that the name was removed from the Register of Trade Marks Attorneys, or within a further period that the Designated Manager allows; or
 - (ii) in any other case—within 3 years after the name was removed from the Register of Trade Marks Attorneys; and
 - (d) the attorney pays:
 - (i) the annual registration fee for the year the reinstatement is made; and

- (ii) the fee mentioned in item 39 of Schedule 9.

43 Subparagraphs 21.35(2)(b)(ii) and (iii)

Repeal the subparagraphs, substitute:

- (ii) subregulation 20.29(3) (imposing a condition when restoring attorney’s name to Register of Trade Marks Attorneys);

44 Subparagraph 21.35(2)(b)(iv)

Re-number as subparagraph (iii).

45 After paragraph 21.35(2)(b)

Insert:

- (ba) the Designated Manager under the following provisions:
- (i) regulation 20.14B (suspending registration for serious offence);
 - (ii) regulation 20A.8 (failing to maintain professional indemnity insurance); or
- (bb) the Disciplinary Tribunal under regulation 20A.18 (decision of Disciplinary Tribunal); or

46 Schedule 9 (at the end of the table)

Add:

36	Applying for registration as an incorporated trade marks attorney	\$300
37	Annual registration of an incorporated trade marks attorney	\$350
38	Annual registration fee payable for combined registration as an incorporated trade marks attorney and an incorporated patent attorney	\$550
39	Applying to be restored to the Register of Trade Marks Attorneys, as authorised by regulation 20A.22	\$250

47 Further amendments—Tribunal

The following provisions are amended by omitting “Tribunal” and substituting “AAT”:

- (a) subparagraph 4.14(3)(g)(ii);

- (b) subregulation 7.1(2);
- (c) subparagraph 17A.22(3)(h)(ii);
- (d) subparagraph 21.35(2).

48 Further amendments—Administrative Appeals Tribunal

The following provisions are amended by omitting “Administrative Appeals Tribunal” and substituting “AAT”:

- (a) paragraph 4.13(2)(c);
- (b) subparagraph 4.14(3)(g)(ii);
- (c) paragraph 7.1(2)(a);
- (d) regulation 16.7;
- (e) subregulation 16.10(5);
- (f) paragraph 17A.21(2)(c);
- (g) subparagraph 17A.22(3)(h)(ii).

Schedule 5—Amendments relating to improving mechanisms for trade mark and copyright enforcement

Copyright Regulations 1969

1 Regulations 21 to 22A

Repeal the regulations, substitute:

21 Restriction of importation of copyright material

- (1) For paragraph 135(8)(c) of the Act, the CEO may direct a person who notifies the CEO under subsection 135(2) of the Act to give to the CEO information and evidence about the following:
 - (a) the subsistence of copyright in the material;
 - (b) the ownership of the copyright;
 - (c) if the person who objects is an agent for the owner of the copyright—the authority for the person to give the notice.
- (2) The person must comply with the direction.

Note: The definition of *CEO* is in section 134B of the Act.

22 Action period

For the definition of *action period* in section 134B of the Act, the period is 10 working days.

22A Claim period

For the definition of *claim period* in section 134B of the Act, the period is 10 working days.

22B Claim for release of seized copies

- (1) For paragraph 135AEA(3)(a) of the Act, the claim must be in a form approved by the CEO.

- (2) For paragraph 135AEA(3)(b) of the Act, the claim must include the following information:
- (a) the importer's full name, home or business address and address for service;
 - (b) a telephone number for the importer;
 - (c) the grounds for seeking the release of the seized copies;
 - (d) if the importer's home or business address is not in Australia:
 - (i) the full name and the home or business address of a person who is the importer's agent in Australia; and
 - (ii) an address for service for the person who is the importer's agent in Australia; and
 - (iii) a telephone number for the person; and
 - (iv) information showing that the person agreed to be the importer's agent;
 - (e) if a person or body other than the agent made arrangements on the importer's behalf for the seized copies to be brought to Australia:
 - (i) the full name, home or business address and address for service of the person or body; and
 - (ii) a telephone number for the person or body.

Note: Examples of grounds for paragraph (c) are:
(a) that the copies are not infringing copies; and
(b) that the importation of the copies did not infringe copyright.

Trade Marks Regulations 1995

2 Regulations 13.1 and 13.2

Repeal the regulations, substitute:

13.1A Definition

In this Part, a reference to the *Customs CEO* includes a reference to:

- (a) for Norfolk Island—the Collector as defined in the *Customs Act 1913* of Norfolk Island; and
- (b) for Christmas Island—the Comptroller as defined in the *Customs Act 1901* of Christmas Island; and

- (c) for the Cocos (Keeling) Islands—the Comptroller as defined in the *Customs Act 1901* of the Cocos (Keeling) Islands.

13.1 Action period

For the definition of *action period* in section 6 of the Act, the period is 10 working days.

13.2 Claim period

For the definition of *claim period* in section 6 of the Act, the period is 10 working days.

13.3 Notice of objection to importation—prescribed document

For subsection 132(1) of the Act, a document that sets out the particulars of registration of the registered trade mark is prescribed.

13.4 Notice of objection to importation—authorised users

- (1) For paragraph 132(3)(b) of the Act, the period is 2 months from the day the request is made by the authorised user under subsection 132(2) of the Act.
- (2) For paragraph 132(3)(e) of the Act, the authorised user must give to the Customs CEO documents that show:
 - (a) the authorised user has power to give a notice of objection under subsection 132(1) of the Act; and
 - (b) the authorised user has made the request; and
 - (c) if the authorised user gives to the Customs CEO the notice after the period mentioned in subregulation (1) has ended—the period has ended.

Note: Examples of documents for paragraph (2)(a) are:

- (a) an agreement between the registered owner of a trade mark, and the authorised user of the trade mark, that the authorised user of the trade mark is able to give notice of objection; and
- (b) a declaration by the registered owner that the authorised user of the trade mark is able to give notice of objection.

13.5 Claim for release of seized goods

- (1) For paragraph 136(3)(a) of the Act, the claim must be in a form approved by the Customs CEO.
- (2) For paragraph 136(3)(b) of the Act, the claim must include the following information:
 - (a) the designated owner's full name, home or business address and address for service;
 - (b) a telephone number for the designated owner;
 - (c) the grounds for seeking the release of the seized goods;
 - (d) if the designated owner's home or business address is not in Australia:
 - (i) the full name and the home or business address of a person who is the designated owner's agent in Australia; and
 - (ii) an address for service for the person who is the designated owner's agent in Australia; and
 - (iii) a telephone number for the person; and
 - (iv) information showing that the person agreed to be the designated owner's agent;
 - (e) if a person or body other than the agent made arrangements on the designated owner's behalf for the seized goods to be brought to Australia:
 - (i) the full name, home or business address and address for service of the person or body; and
 - (ii) a telephone number for the person or body.

Note: Examples of grounds for paragraph (c) are:

- (a) that the goods do not infringe the notified trade mark; and
- (b) that the importation of the goods does not infringe the notified trade mark.

3 Regulations 13.3 to 13.6

Re-number as regulations 13.6 to 13.10.

4 Schedules 3, 4 and 5

Repeal the Schedules, substitute:

Schedule 3—Modifications of Part 13 of the Act (Norfolk Island)

1 After section 131

Insert:

131A Definitions

In this Part:

Administration has the meaning given by the *Norfolk Island Act 1979*.

Administrator has the meaning given by the *Norfolk Island Act 1979*.

Collector means the Collector of Customs appointed under section 1B to the *Customs Act 1913* of Norfolk Island.

designated owner, in relation to goods imported into Norfolk Island, means the person identified as the owner of the goods on the import entry form made in relation to the goods under section 4A of the *Customs Act 1913* of Norfolk Island.

2 Paragraph 133(1)(b)

Omit “*Customs Act 1901*”, substitute “*Customs Act 1913* of Norfolk Island”.

3 Section 133A

Omit “or an officer of Customs (within the meaning of subsection 4(1) of the *Customs Act 1901*)”.

4 Paragraph 139(1)(b)

Omit “as the Customs CEO directs.”, substitute “by the Collector in accordance with any direction of the Executive Member who administers the *Customs Act 1913* of Norfolk Island.”.

5 Section 140

Omit “of the Commonwealth”, substitute “in force in Norfolk Island”.

6 Further amendments—Administration

The following provisions are amended by omitting each mention of “Commonwealth” and substituting “Administration”:

- (a) section 133;
- (b) subsection 134(5);
- (c) section 135;
- (d) subsection 136A(1);
- (e) section 136E;
- (f) paragraph 137(3)(b);
- (g) section 139, including the heading;
- (h) section 142, including the heading.

7 Further amendments—Collector

The following provisions are amended by omitting each mention of “Customs CEO” and substituting “Collector”:

- (a) sections 131 and 132;
- (b) section 133, including the heading;
- (c) sections 134 to 137;
- (d) section 139, note;
- (e) sections 140 to 143.

8 Further amendments—Norfolk Island

The following provisions are amended by omitting each mention of “Australia” and substituting “Norfolk Island”:

- (a) section 131;
- (b) subsection 133(1);
- (c) paragraph 134(4)(a);
- (d) subparagraph 136C(2)(b)(ii);
- (e) section 143.

9 Section 144

Repeal the section.

Schedule 4—Modifications of Part 13 of the Act (Christmas Island)

1 After section 131

Insert:

131A Definitions

In this Part:

Comptroller means the Comptroller of the Indian Ocean Territories
Customs Service.

designated owner, in relation to goods imported into Christmas
Island, means the person identified as the owner of the goods on
the entry made in relation to the goods under subsection 68(2) or
(3) of the *Customs Act 1901* of Christmas Island.

2 Paragraph 133(1)(b)

After “*Customs Act 1901*”, insert “of Christmas Island”.

3 Section 133A

After “*Customs Act 1901*”, insert “of Christmas Island”.

4 Section 140

Omit “of the Commonwealth”, substitute “in force in Christmas Island”.

5 Further amendments—Christmas Island

The following provisions are amended by omitting each mention of
“Australia” and inserting “Christmas Island”:

- (a) section 131;
- (b) subsection 133(1);
- (c) paragraph 134(4)(a);
- (d) subparagraph 136C(2)(b)(ii);
- (e) section 143.

6 Further amendments—Comptroller

The following provisions are amended by omitting each mention of “Customs CEO” and inserting “Comptroller”:

- (a) sections 131 and 132;
- (b) section 133, including the heading;
- (c) sections 134 to 137;
- (d) section 139, including the note;
- (e) sections 140 to 143.

7 Further amendments—Territory of Christmas Island

The following provisions are amended by omitting each mention of “Commonwealth” and inserting “Territory of Christmas Island”:

- (a) section 133;
- (b) subsection 134(5);
- (c) section 135;
- (d) subsection 136A(1);
- (e) section 136E;
- (f) paragraph 137(3)(b);
- (g) section 139, including the heading;
- (h) section 142, including the heading.

8 Section 144

Repeal the section.

Schedule 5—Modifications of Part 13 of the Act (Cocos (Keeling) Islands)

1 After section 131

Insert:

131A Definitions

In this Part:

Comptroller means the Comptroller of the Indian Ocean Territories Customs Service.

designated owner, in relation to goods imported into Christmas Island, means the person identified as the owner of the goods on the entry made in relation to the goods under subsection 68(2) or (3) of the *Customs Act 1901* of Cocos (Keeling) Islands.

2 Paragraph 133(1)(b)

After “*Customs Act 1901*”, insert “of the Cocos (Keeling) Islands”.

3 Section 133A

After “*Customs Act 1901*”, insert “of the Cocos (Keeling) Islands”.

4 Section 140

Omit “of the Commonwealth”, substitute “in force in the Cocos (Keeling) Islands”.

5 Further amendments—the Cocos (Keeling) Islands

The following provisions are amended by omitting each mention of “Australia” and inserting “the Cocos (Keeling) Islands”:

- (a) section 131;
- (b) subsection 133(1);
- (c) paragraph 134(4)(a);
- (d) subparagraph 136C(2)(b)(ii);
- (e) section 143.

6 Further amendments—Comptroller

The following provisions are amended by omitting each mention of “Customs CEO” and inserting “Comptroller”:

- (a) sections 131 to 132;
- (b) section 133, including the heading;
- (c) sections 134 to 137;
- (d) section 139, including the note;
- (e) sections 140 to 143.

7 Further amendments—Cocos (Keeling) Islands

The following provisions are amended by omitting each mention of “Commonwealth” and inserting “Cocos (Keeling) Islands”:

Schedule 5 Amendments relating to improving mechanisms for trade mark and copyright enforcement

- (a) section 133;
- (b) subsection 134(5);
- (c) section 135;
- (d) subsection 136A(1);
- (e) section 136E;
- (f) paragraph 137(3)(b);
- (g) section 139, including the heading;
- (h) section 142, including the heading.

8 Section 144

Repeal the section.

Schedule 6—Amendments relating to simplifying the IP system

Designs Regulations 2004

1 Regulation 1.05

Repeal the regulation, substitute:

1.05 Convention country

For the definition of ***Convention country*** in subsection 5A(1) of the Act, the following countries are prescribed:

- (a) a foreign country that is a signatory to the Paris Convention for the Protection of Industrial Property of 20 March 1883, as in force from time to time;
- (b) a foreign country that is a full member of the World Trade Organization.

Note 1: For signatories to the Paris Convention for the Protection of Industrial Property, see www.wipo.int.

Note 2: For full members of the World Trade Organization, see www.wto.org.

2 Subparagraph 5.04(c)(iii)

After “Federal Court”, insert “, the Federal Magistrates Court or the Federal Circuit Court of Australia”.

3 Regulations 11.22 and 11.23

Repeal the regulations, substitute:

11.22 Exercise of discretionary powers by Registrar

- (1) The Registrar must give a person an opportunity to be heard before exercising a discretionary power under these Regulations adversely to the person.

Note: See section 148 of the Act for a similar provision.

- (2) For section 148 of the Act and subregulation (1), the Registrar must give the person an opportunity to be heard by:

- (a) asking the person for written submissions; or
 - (b) notifying the person that, on request to the Registrar, the person may be heard by way of an oral hearing on a date, and at a time and place, determined by the Registrar; or
 - (c) notifying the person of the date, time and place of an oral hearing.
- (3) The Registrar may exercise the discretionary power if the person:
- (a) notifies the Registrar that the person does not want to be heard; or
 - (b) does not file written submissions if requested under subregulation 11.23(1); or
 - (c) does not attend an oral hearing if notified under subregulation 11.23(2).
- (4) If the Registrar exercises discretionary power in any of the circumstances mentioned in subregulation (3), the Registrar must notify the person of the Registrar's decision.

11.23 Written submissions and oral hearings

Written submissions

- (1) If the Registrar decides that a person may be heard by way of written submissions, the Registrar must:
- (a) notify the person of the period in which the submissions must be filed (being a period of at least 10 business days); and
 - (b) decide the matter after considering the written submissions; and
 - (c) notify the person of the Registrar's decision in relation to the exercise of the discretionary power.

Oral hearings

- (2) If the Registrar decides that a person may be heard by way of an oral hearing, the Registrar must give notice of the date, time and place of the hearing to the person at least 10 business days before the day the hearing is to begin.
- (3) The Registrar may adjourn an oral hearing from time to time or from place to place by notifying the person.

- (4) The Registrar may hold an oral hearing in which:
 - (a) a person appears in person; or
 - (b) a person participates by telephone or other means of telecommunications that the Registrar reasonably allows.
- (5) In addition to the Registrar's other powers, the Registrar may direct a person to provide a written summary of submissions.
- (6) The Registrar must notify a person who appears at the hearing of the Registrar's decision in relation to the exercise of the discretionary power.

4 Schedule 1

Repeal the Schedule.

Patents Regulations 1991

5 Regulation 1.4

Repeal the regulation, substitute:

1.4 Meaning of *Convention country*

For the definition of *Convention country* in subsection 29B(5) of the Act, the following countries are prescribed:

- (a) a foreign country that is a signatory to the Paris Convention for the Protection of Industrial Property of 20 March 1883, as in force from time to time;
- (b) a foreign country that is a full member of the World Trade Organization.

Note 1: For signatories to the Paris Convention for the Protection of Industrial Property, see www.wipo.int.

Note 2: For full members of the World Trade Organization, see www.wto.org.

6 Regulations 1.6 and 1.6A

Repeal the regulations, substitute:

1.6 Secret use—prescribed period

For paragraph 9(e) of the Act, the period is 12 months after the first use of the invention that would, but for the application of paragraph 9(e), have constituted secret use.

7 Regulations 2.2 and 2.3

Repeal the regulations, substitute:

2.2 Information made publicly available—recognised exhibitions

- (1) This regulation sets out:
 - (a) for paragraph 24(1)(a) of the Act—a circumstance in relation to information made publicly available by, or with the consent of, the nominated person, patentee or predecessor in title of the nominated person or patentee; and
 - (b) for subsection 24(1) of the Act—a period for making a complete application for an invention if the circumstance applies.

Circumstance—invention shown, used or published at recognised exhibition

- (2) The circumstance is that the information has been made publicly available because the invention was:
 - (a) shown or used at a recognised exhibition; or
 - (b) published during a recognised exhibition at which the invention was shown or used.

Period

- (3) The period for making a complete application for the invention is:
 - (a) if the complete application claims priority from a basic application made within 6 months of the day of the showing, use or publication—12 months from the day the basic application was made; or
 - (b) if the complete application is associated with a provisional application made within 6 months of the day of the showing, use or publication—12 months from the day the provisional application was made; or

(c) otherwise—12 months from the day of the showing, use or publication.

(4) In this regulation:

Paris Convention means the Paris Convention for the Protection of Industrial Property of 20 March 1883, as in force for Australia on the commencing day.

recognised exhibition means:

- (a) an official or officially recognised international exhibition within the meaning of Article 11 of the Paris Convention or Article 1 of the Convention relating to International Exhibitions done at Paris on 22 November 1928, as in force for Australia on the commencing day; or
- (b) an international exhibition recognised by the Commissioner by a notice published in the *Official Journal* before the beginning of the exhibition.

2.2A Information made publicly available—learned societies

(1) This regulation sets out:

- (a) for paragraph 24(1)(a) of the Act—a circumstance in relation to information made publicly available by, or with the consent of, the nominated person, patentee or predecessor in title of the nominated person or patentee; and
- (b) for subsection 24(1) of the Act—a period for making a complete application for an invention if the circumstance applies.

Circumstance—information read before learned society or published by or on behalf of learned society

(2) The circumstance is that the information has been made publicly available in a paper:

- (a) read before a learned society; or
- (b) published by or on behalf of a learned society.

Period

(3) The period for making a complete application for the invention is:

- (a) if the complete application claims priority from a basic application made within 6 months of the day of the reading or publication—12 months from the day the basic application was made; or
- (b) if the complete application is associated with a provisional application made within 6 months of the day of the reading or publication—12 months from the day the provisional application was made; or
- (c) otherwise—12 months from the day of the reading or publication.

2.2B Information made publicly available—reasonable trial of invention

- (1) This regulation sets out:
 - (a) for paragraph 24(1)(a) of the Act—a circumstance in relation to information made publicly available by, or with the consent of, the nominated person, patentee or predecessor in title of the nominated person or patentee; and
 - (b) for subsection 24(1) of the Act—a period for making a complete application for an invention if the circumstance applies.

Circumstance—working of invention for reasonable trial

- (2) The circumstance is that:
 - (a) the information has been made publicly available because the invention was worked in public; and
 - (b) the working of the invention was for the purposes of a reasonable trial of the invention; and
 - (c) because of the nature of the invention, it was reasonably necessary for the working to be in public.

Period

- (3) The period for making a complete application for the invention is:
 - (a) if the complete application claims priority from a basic application made within 12 months of the start of the public working of the invention—12 months from the day the basic application was made; or

- (b) if the complete application is associated with a provisional application made within 12 months of the start of the public working of the invention—12 months from the day the provisional application was made; or
- (c) otherwise—12 months from the start of the public working of the invention.

2.2C Information made publicly available—other circumstances

- (1) This regulation sets out:
 - (a) for paragraph 24(1)(a) of the Act—a circumstance in relation to information made publicly available by, or with the consent of, the nominated person, patentee or predecessor in title of the nominated person or patentee; and
 - (b) for subsection 24(1) of the Act—a period for making a complete application for an invention if the circumstance applies.

Circumstance

- (2) The circumstance is that the information has been made publicly available in circumstances other than the circumstances described in regulations 2.2, 2.2A and 2.2B.

Period

- (3) The period for making a complete application for the invention is 12 months from the day the information was made publicly available.

2.2D Information made publicly available without consent—period

For subsection 24(1) of the Act, for information made publicly available in the circumstances mentioned in paragraph 24(1)(b) of the Act, the prescribed period for making a complete application for an invention is 12 months from the day the information was made publicly available.

2.3 Divisional applications—period

- (1) For subsection 24(1) of the Act, this regulation applies to an invention if:
 - (a) the specification containing the claim in which the invention is defined was filed for a divisional application under section 79B or 79C of the Act; and
 - (b) the claim is entitled under regulation 3.13D or 3.13E to the priority date that it would have if the claim was in the specification filed with a previous application (the *original application*); and
 - (c) a circumstance mentioned in regulations 2.2 to 2.2D applies; and
 - (d) the original application was filed in the period prescribed in the circumstance under regulations 2.2 to 2.2D.
- (2) The prescribed period for making the divisional application is:
 - (a) if the divisional application was filed in the period mentioned in paragraph (1)(d)—that period; or
 - (b) otherwise—the period ending on the day the divisional application was made.

8 Paragraphs 3.1(2)(a) and (b)

Repeal the paragraphs.

9 At the end of regulation 3.1A

Add:

- (2) For a PCT application, the applicant is taken to be the nominated person.

10 Subregulation 3.2A(3)

After “standard patent”, insert “(other than a PCT application)”.

11 After regulation 3.2A

Insert:

3.2AB PCT application—title of specification

- (1) The title of a specification for a PCT application is taken to be:
 - (a) the title approved by the ISA for the application under rule 44.2 of the PCT; or
 - (b) the title established by the ISA for the application under rule 37.2 of the PCT.
- (2) For subregulation (1), if the title is in a language other than English, the title is taken to be the English translation of the title.

12 Paragraph 3.2B(1)(d)

Omit “6A.1, 6A.2 or subregulation 8.5(2),”, substitute “3.11, 6A.1 or 6A.2,”.

13 After regulation 3.2B

Insert:

3.2C Specifications—formalities check for PCT application

- (1) This regulation applies to a PCT application that complies with subsection 29A(5) of the Act.

Note: This regulation was added on 15 April 2013. If the PCT application was filed before 15 April 2013, see subregulation (7).
- (2) The applicant must:
 - (a) provide:
 - (i) an address for service in Australia at which a document under the Act or these Regulations may be given to the applicant personally, or to a person nominated as the applicant’s representative; or
 - (ii) another address for service in Australia to which it is practicable and reasonable for Australia Post, or a person acting for Australia Post, to deliver mail; and
 - (b) if a translation of the application is filed for subsection 29A(5) of the Act—file a certificate of verification for the translation.
- (3) The PCT application must substantially comply with the requirements of Schedule 3.

- (4) The Commissioner may, within one month from the date the PCT application complies with subsection 29A(5) of the Act, direct the applicant to do anything necessary to ensure that the application complies with the requirements mentioned in subregulations (2) and (3).
- (5) The PCT application lapses if:
 - (a) the applicant has been given a direction under subregulation (4); and
 - (b) the applicant has not complied with the direction within 2 months of the date of the direction.
- (6) If the PCT application lapses under subregulation (5), the Commissioner must:
 - (a) advertise that fact in the *Official Journal*; and
 - (b) tell the applicant that the PCT application has lapsed.
- (7) If the PCT application was filed before 15 April 2013:
 - (a) a reference in this regulation to subsection 29A(5) of the Act:
 - (i) is taken to be a reference to subsection 89(3) of the Act, as in force immediately before 15 April 2013; and
 - (ii) if a translation of a PCT application is required to be filed—is taken not to include the requirement to file a related certificate of verification; and
 - (b) for the purposes of the reference to subsection 89(3) of the Act, as in force immediately before 15 April 2013, paragraph 8.2(3)(c) of these Regulations, as in force immediately before 15 April 2013:
 - (i) is taken to apply in relation to the PCT application; and
 - (ii) is taken not to include the requirement to file a related certificate of verification; and
 - (iii) is taken not to include the requirement to file a document setting out an address for service of documents in Australia.

14 Regulation 3.5 (heading)

Repeal the heading, substitute:

3.5 Filing date—patent applications other than PCT applications

15 Subregulation 3.5(1)

After “patent application”, insert “(other than a PCT application)”.

16 After regulation 3.5

Insert:

3.5AA Filing date—PCT applications

For section 30 of the Act, the filing date of a PCT application is:

- (a) the international filing date; or
- (b) if the Commissioner has treated another date as the international filing date under Rule 82^{ter} of the PCT—that date; or
- (c) if section 10 of the Act applies to the application—the date taken to have been given as the international filing date under that section.

17 Subregulation 3.5A(1)

After “patent application”, insert “(other than a PCT application)”.

18 After regulation 3.5A

Insert:

3.5AB PCT applications—international applications taken to be applications under the Act

- (1) This regulation applies to an international application that specifies Australia as a designated State under Article 4(1)(ii) of the PCT if:
 - (a) the receiving Office has declared that the international application is taken to be withdrawn; or
 - (b) the International Bureau has made a finding under Article 12(3) of the PCT.
- (2) The international application is taken to be a PCT application, as if a declaration or finding had not been made, if:

- (a) the applicant has made a request referred to in Article 25(1)(a) of the PCT within the time limit specified in Rule 51.1 of the PCT; and
- (b) the Commissioner has received, within the time limit specified in Rule 51.3 of the PCT:
 - (i) the fees prescribed for paragraph 29A(5)(b) of the Act; and
 - (ii) if the application is not in English—a translation of the application into English; and
- (c) the Commissioner believes on reasonable grounds that:
 - (i) the declaration was the result of an error or omission by the receiving Office; or
 - (ii) the finding was the result of an error or omission by the International Bureau.

3.5AC PCT applications—amendment

- (1) For subsection 29A(3) of the Act, this regulation sets out the circumstances and manner in which, and the day on which, a specification of a PCT application is taken to be amended.

Translation of application into English

- (2) If paragraph 29A(5)(a) of the Act applies to the PCT application:
 - (a) the description, drawings and claims contained in the application are taken to have been amended by substituting the description, drawings and claims in the translation; and
 - (b) the amendment is taken to have occurred on the day the translation was filed.

Application amended under Article 19 of PCT

- (3) If:
 - (a) a PCT application was amended under Article 19 of the PCT; and
 - (b) the application was amended before the applicant met the requirements of subsection 29A(5) of the Act;the description, drawings and claims contained in the application are to be taken to have been amended on the day the amendment was made.

Application rectified under Rule 91 of PCT

- (4) If:
- (a) a PCT application was rectified under Rule 91 of the PCT;
and
 - (b) the rectification was made before the applicant met the requirements of subsection 29A(5) of the Act;
- the description, drawings and claims contained in the application are to be taken to have been amended on the day the rectification was effective, unless the Commissioner disregards the rectification under Rule 91.3(f) of the PCT.

Application amended under Article 34 of PCT

- (5) If:
- (a) a PCT application in respect of which Australia has been elected under Chapter II of the PCT has been amended under Article 34 of the PCT; and
 - (b) an international preliminary examination report is established before the applicant meets the requirements of subsection 29A(5) of the Act;
- the description, drawings and claims contained in the application are taken to have been amended on the day the amendment was made.
- (6) However, subregulation (5) does not apply if:
- (a) the Commissioner has notified the applicant under regulation 3.17C or paragraph 10.2(1)(d); and
 - (b) the applicant:
 - (i) provides the advice mentioned in paragraph 3.17B(2)(b) or subparagraph 10.2(3)(c)(ii); or
 - (ii) elects under paragraph 3.17B(2)(c) or subparagraph 10.2(3)(c)(iii) to abandon any amendments that may have been made under Article 34 of the PCT.

Indications under Rule 13^{bis}.4 of the PCT

- (7) If an indication in relation to a deposited micro-organism is furnished according to Rule 13^{bis}.4 of the PCT in relation to a PCT application:
- (a) the description contained in the application is taken to have been amended to include that indication; and
 - (b) the amendment is taken to have occurred on the day that indication is furnished to the International Bureau.

3.5AD PCT applications—prescribed requirements

For subsection 29A(4) of the Act, the following requirements are prescribed:

- (a) the requirements of subsection 29(4) of the Act;
- (b) subregulation 3.1(1);
- (c) subregulation 3.2A(1);
- (d) paragraphs 3.2A(2)(a) and (b).

3.5AE PCT applications—prescribed period

- (1) For subsection 29A(5) of the Act, the prescribed period is 31 months after the priority date of the application.

- (2) In this regulation:

priority date has the same meaning as in the PCT.

3.5AF PCT applications—translations and prescribed documents

Translations published under Article 21 of PCT

- (1) For paragraph 29A(5)(a) of the Act, subregulation (2) applies if:
- (a) a PCT application is not filed in English; and
 - (b) the PCT application has been published in English under Article 21 of the PCT; and
 - (c) a translation of the application into English was not filed before the date of publication under Article 21 of the PCT.
- (2) The publication under Article 21 of the PCT is taken:

- (a) to be the translation mentioned in paragraph 29A(5)(a) of the Act; and
- (b) to have been filed within the prescribed period; and
- (c) to have been verified in accordance with these Regulations.

Copy of application

(3) For paragraph 29A(5)(b) of the Act, if a PCT application has not been published under Article 21 of the PCT, a copy of the application is a prescribed document.

(4) In this regulation:

PCT application includes:

- (a) an amendment under Article 19 or 34 of the PCT; and
- (b) a rectification under Rule 91 of the PCT.

3.5AG Convention application—prescribed particulars

- (1) For paragraph 29B(4)(a) of the Act, the following particulars are prescribed in relation to a relevant basic application:
 - (a) the country in which the application was made;
 - (b) the number allocated to the application by the foreign patent office of the Convention country in which the application was made;
 - (c) the date the application was made.

(2) A reference to a country or a Convention country in subregulation (1) includes an intergovernmental authority to the extent that Rule 4.10 of the PCT permits for a PCT application.

Note: An example for subregulation (2) is that the PCT allows the European Patent Office to be specified for a regional application instead of a particular Convention country.

19 Regulation 3.5B

After “sub-office of the Patent Office”, insert “(if any)”.

20 After regulation 3.10

Insert:

3.11 Prescribed period—making Convention application

For subsections 29B(2) and 38(1A) of the Act, the prescribed period is 12 months from the day a basic application is first made in a Convention country for the invention.

21 Regulation 3.14

Omit “If subsection 114(1)”, substitute “If section 114”.

22 Paragraph 3.14(a)

Omit “subsection 89(4) or (5)”, substitute “subsection 29A(3)”.

23 Paragraph 3.14(b)

Omit “subsection 114(1)”, substitute “subparagraph 114(1)(c)(ii)”.

24 After regulation 3.14B

Insert:

3.14C Priority dates—Convention applications and PCT applications: prescribed period for disregarding earlier applications

For paragraph 43(5)(b) of the Act, the period of more than 12 months before the filing of the Convention application or PCT application is prescribed.

3.14D Prescribed documents: basic application

- (1) For subsection 43AA(1) of the Act, the following documents that relate to a basic application are prescribed:
 - (a) a copy of the specification filed for, and at the same time as, the basic application;
 - (b) a copy of any other document filed for the basic application, whether filed at the same time as, or after, the basic application is filed;
 - (c) a document mentioned in paragraph (a) or (b) that has been certified by the competent authority of the Convention country in which the basic application was made;

- (d) if the application relates to a micro-organism—a copy of a receipt for the deposit of the micro-organism issued by a prescribed depository institution;
 - (e) if a document mentioned in paragraphs (a) to (d) is not in English—a translation of the document into English and a certificate of verification of the translation.
- (2) For subsection 43AA(4) of the Act, if the Commissioner requires that a prescribed document relating to a basic application be made available to the Commissioner:
- (a) the prescribed means for making the document available are:
 - (i) filing the document with the Australian Patent Office; or
 - (ii) making the document available through an approved digital library; and
 - (b) the prescribed period for making the document available is 3 months from the day the Commissioner requires the document be made available.
- (3) However, if the Commissioner is satisfied that:
- (a) a document was made available for inspection by the Commissioner in an approved digital library within the period mentioned in paragraph (2)(b); and
 - (b) the document is no longer available for inspection;
- the prescribed period is 2 months after the day the Commissioner notifies the applicant or patentee that the Commissioner has not been able to inspect the document in the approved digital library.

25 Regulation 3.15 (heading)

Repeal the heading, substitute:

3.15 Requirements of request for examination

26 At the end of regulation 3.15

Add:

- (3) An applicant of a PCT application may not make a request for the examination of the patent request and complete specification until the applicant has complied with the requirements of subsection 29A(5) of the Act.

27 Subregulation 3.16(2)

Omit “6 months”, substitute “2 months”.

28 Regulations 3.17A and 3.17B

Repeal the regulations, substitute:

3.17A PCT applications—Commissioner not to give certain directions

- (1) This regulation applies to a PCT application that is treated as an application for a standard patent under the Act.
- (2) The Commissioner must not give a direction under section 44 of the Act unless the applicant has complied with the requirements of subsection 29A(5) of the Act.

3.17B PCT applications—examination requirements

- (1) For subsection 45(1A) of the Act, this regulation prescribes requirements for a PCT application.
- (2) The requirements are that the applicant must:
 - (a) give a copy of the international preliminary examination report to the Commissioner; or
 - (b) advise that:
 - (i) no demand was made under Article 31 of the PCT; or
 - (ii) no amendments were made under Article 34 of the PCT; or
 - (iii) the demand was made under Article 31 of the PCT, or the international preliminary examination report was established, after the applicant complied with the requirements of subsection 29A(5) of the Act; or
 - (c) elect to abandon any amendments that may have been made under Article 34 of the PCT.
- (3) However, subregulation (2) applies only if:
 - (a) each of the following applies:
 - (i) the applicant demanded an international preliminary examination under Article 31 of the PCT before

- complying with the requirements of subsection 29A(5) of the Act;
- (ii) at least 3 months after the applicant complied with the requirements of subsection 29A(5) of the Act, the Commissioner asks for a copy of the international preliminary examination report from the International Bureau;
 - (iii) the International Bureau advises that the international preliminary examination report is not available; or
- (b) both of the following apply:
- (i) the applicant asks for the examination to be expedited under subregulation 3.17(2);
 - (ii) a copy of an international preliminary examination report relating to the application has not been provided to the Commissioner.

Note: Under subparagraph 3.5AC(9)(b)(ii), if the applicant provides the advice, or makes the election, mentioned in paragraph (2)(b) or (c), any amendments made under Article 34 of the PCT are not taken to be included in the application.

- (4) In this regulation:

international preliminary examination report has the same meaning as it has in the PCT.

3.17C PCT applications—notice if examination declined

If the Commissioner declines to examine a request and specification under subsection 45(1A) of the Act, the Commissioner must notify the applicant and ask the applicant to meet the requirements in subregulation 3.17B(2).

29 Subregulation 3.18(2)

Omit “the purposes of paragraph 45(1)(d) or 48(1)(c)”, substitute “paragraph 45(1)(d)”.

30 Paragraph 3.18(2)(a)

Repeal the paragraph, substitute:

- (a) whether, to the best of the Commissioner's knowledge, the request and specification comply with the following provisions of the Act:
- (i) section 15 (Who may be granted a patent?);
 - (ii) section 29 (Application for patent—general rules);
 - (iii) section 29B (Applications for patents—special rules for Convention applications);
 - (iv) section 38 (Time for making complete application);
 - (v) section 79B (Divisional applications prior to grant of patent);
 - (vi) section 81 (Grant of patent of addition);

31 Paragraph 3.18(2)(f)

Repeal the paragraph, substitute:

- (f) for a PCT application—whether, to the best of the Commissioner's knowledge, the application complies with subregulations 3.2C(2) and (3).

32 Subregulation 3.18(3)

Repeal the subregulation.

33 Subregulation 3.18(4)

Omit “or 48”.

34 Subregulation 3.19(3)

Omit “or 48”.

35 Regulations 3.20 and 3.21

Repeal the regulations.

36 Regulation 4.1

Omit “the purposes of section 53”, substitute “subsection 53(1)”.

37 Paragraph 4.1(f)

Repeal the paragraph, substitute:

- (f) particulars of priority documents.

38 Paragraphs 4.3(2)(b) and (c)

Repeal the paragraphs, substitute:

- (b) a document that the Commissioner has reasonable grounds for believing should not be open to public inspection.

39 At the end of Chapter 4

Add:

4.4 Publication and inspection of PCT applications

- (1) For subsection 56A(1) of the Act, a PCT application is taken to have become open to public inspection, and to have been published in Australia:
 - (a) if a notice in relation to the application is published under subregulation (3)—on the day the notice is published; or
 - (b) if subregulation (5) applies—on the day the application is published under Article 21 of the PCT.
- (2) Subregulation (3) applies to a PCT application:
 - (a) that has not lapsed, or been withdrawn or refused; and
 - (b) for which the applicant has complied with subsection 29A(5) of the Act before the end of 18 months after the priority date of the application.
- (3) The Commissioner must publish a notice in the *Official Journal* stating that the PCT application is open to public inspection:
 - (a) if the applicant asks the Commissioner in writing to publish the notice; or
 - (b) in any case—as soon as practicable after the end of 18 months after the priority date of the application.
- (4) A request for publication under subregulation (3) must be in the approved form.
- (5) The PCT application is open to public inspection if:
 - (a) the applicant does not comply with subsection 29A(5) of the Act within 18 months after the priority date of the application; and
 - (b) the application is published under Article 21 of the PCT.

- (6) The following documents are open for inspection if a notice is published under subregulation (3) or if subregulation (5) applies:
- (a) a copy of the relevant application;
 - (b) all documents in the possession of the Patent Office, other than those mentioned in subregulation (7), that are associated with:
 - (i) the application; or
 - (ii) any provisional application from which the application claims priority under Article 8 of the PCT.
- (7) Subregulation (6) does not apply to the following documents:
- (a) a document that would be privileged from production in legal proceedings on the ground of legal professional privilege;
 - (b) a document mentioned in subregulation 4.3(2).
- (8) In this regulation:
- priority date* has the same meaning as in the PCT.

40 After regulation 6.1

Insert:

6.1A Prescribed particulars—grant of standard patent

For subsection 61(1) of the Act, the following particulars are prescribed:

- (a) the date the patent is granted by the Commissioner;
- (b) any other particulars of the grant that the Commissioner considers appropriate.

41 After regulation 6.2

Insert:

6.2A Prescribed particulars—grant of innovation patent

For subsection 62(1) of the Act, the following particulars are prescribed:

- (a) the date the innovation patent is granted by the Commissioner;

- (b) any other particulars of the grant that the Commissioner considers appropriate.

42 Subregulation 6.3(10)

Omit “section 94”, substitute “subsections 29B(1) and (2)”.

43 At the end of regulation 6.3

Add:

- (11) If a PCT application claims the priority of an earlier application under Article 8 of the PCT, and a circumstance mentioned in an item of the following table applies, the date of the patent is the date 12 months from the date of making the first application mentioned in the item.

Circumstances		
Item	Column 1	Column 2
	The earlier application was...	and:
1	an application made in Australia more than 12 months before the international filing date of the PCT application	both of the following apply: (a) a receiving Office has restored priority under Rule 26 ^{bis} .3 of the PCT; (b) the restored priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49 ^{ter} .1 of the PCT
2	an application made in Australia more than 12 months before the international filing date of the PCT application	the Commissioner has restored priority under Rule 49 ^{ter} .2 of the PCT
3	an application made in Australia more than 12 months before the international filing date of the PCT application	the Commissioner has granted an extension of time under section 223 of the Act that has the effect of restoring a right of priority
4	a basic application made more than 12 months before the international filing date of the PCT application, being the first application made in a Convention country for the	both of the following apply: (a) a receiving Office has restored priority under Rule 26 ^{bis} .3 of the PCT; (b) the restored priority has not been

Schedule 6 Amendments relating to simplifying the IP system

Circumstances		
Item	Column 1	Column 2
	The earlier application was...	and:
	invention	found to be ineffective by the Commissioner or a prescribed court under Rule 49 ^{ter} .1 of the PCT
5	a basic application made more than 12 months before the international filing date of the PCT application, being the first application made in a Convention country for the invention	the Commissioner has restored priority under Rule 49 ^{ter} .2 of the PCT
6	a basic application made more than 12 months before the international filing date of the PCT application, being the first application made in a Convention country for the invention	the Commissioner has granted an extension of time under section 223 of the Act that has the effect of restoring a right of priority

44 Regulation 6.4

Repeal the regulation.

45 Chapter 8

Repeal the Chapter.

46 Regulations 9A.2A and 9A.2B

Repeal the regulations.

47 Paragraphs 9A.4(d) and (e)

Repeal the paragraphs, substitute:

(d) if the Commissioner requires a document to be made available under subsection 43AA(4) of the Act—5 months from the date the requirement is made;

(e) if:

(i) the Commissioner has informed the patentee of a notice under subsection 28(1) of the Act; and

- (ii) a ground for revocation is raised based on information in the notice;
3 months from the date of the report that first mentions the ground for revocation;
- (f) if:
 - (i) the Commissioner gives the applicant an opportunity to be heard in relation to a report under section 101B of the Act or regulation 10.2 by:
 - (A) notifying the applicant in writing of the date by which written submissions must be filed; or
 - (B) notifying the applicant in writing of the date, time and place of an oral hearing; and
 - (ii) the Commissioner makes a decision in writing in relation to the report;
3 months from the date the decision is made;
- (g) if the Commissioner revokes a certificate of examination under section 101EA of the Act—3 months from the date the decision to revoke is made.

48 After subregulation 10.1(1)

Insert:

- (1AA) However, an applicant of a PCT application may not ask the Commissioner for leave to amend until the applicant has complied with the requirements of subsection 29A(5) of the Act.

49 Paragraph 10.2(1)(d)

Repeal the paragraph, substitute:

- (d) notify the applicant of that fact; and

50 Sub-subparagraph 10.2(3)(c)(ii)(C)

Omit “subsection 89(3)”, substitute “subsection 29A(5)”.

51 Subparagraph 10.2(3)(c)(iii) (note)

Repeal the note, substitute:

- Note: If the applicant provides the advice mentioned in subparagraph (c)(ii), or makes the election mentioned in subparagraph (c)(iii), any amendments made under Article 34 of the PCT are not taken to be included in the application.

52 Paragraph 10.5(1)(b)

Omit “section 45 or 48”, substitute “section 45 ”.

53 After subregulation 10.6A

Insert:

10.6B Revocation of grant of leave

- (1) A grant of leave to amend a patent request, complete specification or other filed document under regulation 10.5 is revoked if:
 - (a) leave to amend was granted at the same time as the acceptance of the patent request and complete specification under subsection 49(1) of the Act; and
 - (b) acceptance of the patent request and complete specification is later revoked under section 50A of the Act.
- (2) A grant of leave to amend a patent request, complete specification or other filed document under regulation 10.5 is revoked if:
 - (a) leave to amend was granted at the same time as the decision mentioned in paragraph 101E(a) of the Act was made; and
 - (b) the certificate of examination issued in relation to the patent is later revoked under subsection 101EA(1) of the Act.
- (3) The Commissioner may revoke a grant of leave to amend a patent request, complete specification or other filed document under regulation 10.5 if the Commissioner is satisfied that:
 - (a) leave to amend should not have been granted, taking into account all of the circumstances that existed when leave was granted (whether or not the Commissioner knew the circumstances existed); and
 - (b) it is reasonable to revoke the grant and allowance of the amendment(if applicable), taking into account all of the circumstances; and
 - (c) there are no relevant proceedings pending.
- (4) If leave to amend a patent request, complete specification or other filed document under regulation 10.5 is revoked (whether automatically or by the Commissioner):
 - (a) leave to amend is taken to never have been granted; and

- (b) if allowed under regulation 10.6, the amendment is taken not to have been allowed; and
- (c) the Commissioner must continue to examine and report on the amendment in accordance with subregulation 10.2(1); and
- (d) regulations 10.5 and 10.6 continue to apply in relation to the amendment.

54 Regulation 10.7

Repeal the regulation, substitute:

10.7 Rectification of Register

- (1) A person applying for rectification of the Register under section 191A of the Act must do so in the approved form.
- (2) The Commissioner:
 - (a) may seek further information from any person for the purpose of considering the application; and
 - (b) is not required to consider the application while seeking the further information.
- (3) The Commissioner must publish a notice of the rectification request in the *Official Journal* unless the rectification:
 - (a) relates to an address included in the Register; or
 - (b) relates to a name included in the Register and does not relate to a change of identity; or
 - (c) relates to the title of an invention included in the Register; or
 - (d) is to correct an obvious mistake made in the Register; or
 - (e) does not materially alter the meaning or scope of an entry in the Register.
- (4) However, the Commissioner is not required to publish a notice under subregulation (3) if the Commissioner is satisfied that the rectification should not be made.
- (5) If the Commissioner publishes a notice under subregulation (3), the Commissioner must not rectify the Register until the later of:
 - (a) 2 months after publishing the notice; and

- (b) if a person requests to be heard in relation to the rectification request—after the person has been heard.

55 Regulation 11.1

Omit “specified in Schedule 4”, substitute “mentioned in regulation 1.4”.

56 Subregulation 12.1(1)

Omit “sealing”, substitute “granting”.

57 After regulation 13.1B

Insert:

13.1C PCT applications—prescribed circumstances in which application may be withdrawn or taken to be withdrawn

- (1) For subsection 141(2) of the Act, a PCT application may be withdrawn if the conditions mentioned in subsection 141(1) of the Act are met.
- (2) For subsection 141(2) of the Act, a PCT application is taken to be withdrawn if Article 11(3) of the PCT ceases to have effect in Australia in relation to the PCT application under Article 24(1)(i) of the PCT.

58 Regulation 13.2

Repeal the regulation.

59 Paragraphs 13.4(1)(a) and (b)

Repeal the paragraphs, substitute:

- (a) if examination of the patent request and complete specification is requested before 15 April 2013—21 months from the date of the first report (if any) under section 45 of the Act;
- (b) if examination is requested on or after 15 April 2013—12 months from the date of the first report (if any) under section 45 of the Act;

60 Paragraph 13.4(1)(c)

Repeal the paragraph.

61 Subparagraph 13.4(1)(f)(ii)

Repeal the subparagraph, substitute:

- (ii) the Commissioner has made a declaration under paragraph 36(1)(c) of the Act;

62 Paragraph 13.4(1)(g)

Repeal the paragraph, substitute:

- (g) subject to subregulation (3), if:
 - (i) the Commissioner gives the applicant an opportunity to be heard in relation to a report under section 45 of the Act or regulation 10.2 by:
 - (A) notifying the applicant in writing of the date by which written submissions must be filed; or
 - (B) notifying the applicant in writing of the date, time and place of an oral hearing; and
 - (ii) the Commissioner makes a decision in writing in relation to the report;
3 months from the date the decision is made;
- (ga) subject to subregulation (3), if the Commissioner revokes an acceptance under subsection 50A(1) of the Act—3 months from the date the decision to revoke is made;

63 Paragraph 13.4(1)(k)

Repeal the paragraph, substitute:

- (k) if the Commissioner requires a document to be made available under subsection 43AA(4) of the Act—the period of 5 months from the date the requirement is made;

64 Subregulation 13.4(3)

Omit “or (f) or subparagraph (1)(g)(iii)”, substitute “, (f), (g) or (ga)”.

65 After regulation 13.5

Insert:

13.5A PCT application—prescribed circumstances for lapsing of application

- (1) For paragraph 142(2)(f) of the Act, a circumstance in which a PCT application lapses is that the applicant has not met the requirements of subsection 29A(5) of the Act within the prescribed period for that subsection.
- (2) For paragraph 142(2)(f) of the Act, a circumstance in which a PCT application lapses is that the effect of the international application under Article 11(3) of the PCT ceases in Australia under Article 24(1)(ii) of the PCT before the requirements of subsection 29A(5) of the Act have been met.

66 Subregulation 22.2(4)

Omit “paragraph 89(3)(b)”, substitute “paragraph 29A(5)(b)”.

67 Regulation 22.2E

Repeal the regulation.

68 Paragraph 22.2F(1)(a)

Omit “, 22.2D or 22.2E”, substitute “or 22.2D”.

69 Paragraph 22.10AA(b)

Omit “Patent Office”, substitute “Patent Office (if any)”.

70 Regulation 22.10AA (note)

Omit “of the Patent Office”, substitute “of the Patent Office (if any)”.

71 Subregulation 22.10AB(1)

Omit “of the Patent Office”, substitute “of the Patent Office (if any)”.

72 Regulation 22.15

Repeal the regulation, substitute:

22.15 Documents in English and English translations

- (1) An abstract that is filed must be in English.

- (2) A document required to be in an approved form that is filed must be in English.
- (3) If any other document is filed:
 - (a) the document must be in English; or
 - (b) the document must be filed with:
 - (i) a translation of the document into English; and
 - (ii) a related certificate of verification.
- (4) However, this regulation does not apply to documents relating to a basic application that are prescribed under subsection 43AA(1) of the Act.

Note: For a list of these documents, see subregulation 3.14B(1).

73 Subregulation 22.16(2)

Omit “Schedule 3”, substitute “regulation 22.15 or Schedule 3,”.

74 Paragraph 22.16(2)(a)

Repeal the paragraph, substitute:

- (a) as not having been filed and notify the person from whom it was received, including in the notification a statement indicating how the document or form does not so comply or accord; or

75 Subregulation 22.16(3)

Repeal the subregulation.

76 Subregulation 22.16(4)

Omit “3 months”, substitute “2 months”.

77 Regulations 22.22 and 22.23

Repeal the regulations, substitute:

22.22 Exercise of discretionary powers by Commissioner

- (1) The Commissioner must give a person an opportunity to be heard before exercising a discretionary power under the Act or these Regulations adversely to the person.

Note: See section 216 of the Act for a similar provision.

- (2) The Commissioner must give the person an opportunity to be heard by:
 - (a) asking the person for written submissions; or
 - (b) notifying the person that, on request to the Commissioner, the person may be heard by way of an oral hearing on a date, and at a time and place, determined by the Commissioner; or
 - (c) notifying the person of the date, time and place of an oral hearing.
- (3) The Commissioner may exercise the discretionary power if the person:
 - (a) notifies the Commissioner that the person does not want to be heard; or
 - (b) does not file written submissions if requested under subregulation 22.23(1); or
 - (c) does not attend an oral hearing if notified under subregulation 22.23(2).
- (4) If the Commissioner exercises discretionary power in any of the circumstances mentioned in subregulation (3), the Commissioner must notify the person of the Commissioner's decision.

22.23 Written submissions and oral hearings

Written submissions

- (1) If the Commissioner decides that a person may be heard by way of written submissions, the Commissioner must:
 - (a) notify the person of the period in which the submissions must be filed (being at least 10 business days); and
 - (b) determine the matter after considering the written submissions; and
 - (c) notify the person of the Commissioner's decision in relation to the exercise of the discretionary power.

Oral hearings

- (2) If the Commissioner decides that a person may be heard by way of an oral hearing, the Commissioner must give notice of the date,

time and place of the hearing, to the person, at least 10 business days before the day the hearing is to begin.

- (3) The Commissioner may adjourn an oral hearing from time to time or from place to place by notifying the person.
- (4) The Commissioner may hold an oral hearing in which:
 - (a) a person appears in person; or
 - (b) a person participates by telephone or other means of telecommunications that the Commissioner reasonably allows.
- (5) In addition to the Commissioner's other powers, the Commissioner may direct a person to provide a written summary of submissions.
- (6) The Commissioner must notify a person who appears at the hearing of the Commissioner's decision in relation to the exercise of the discretionary power.

78 After regulation 22.26

Insert:

22.27 Documents not to infringe copyright—prescribed documents

- (1) For paragraph 226(2)(c) of the Act, the following documents are prescribed:
 - (a) a document open to public inspection under Chapter 4 of the Act;
 - (b) a document open to public inspection under these Regulations.
- (2) However, a journal, book or catalogue is not prescribed if:
 - (a) it is provided for prosecution, examination or proceedings in relation to a patent application, or subsequent patent; and
 - (b) a right subsisting in the journal, book or catalogue under the *Copyright Act 1968* is held by a party other than the patent applicant, patentee or another person who has filed a document for the application or patent.

79 Schedules 1, 1A, 2 and 2A

Repeal the Schedules.

80 Schedule 3 (heading)

Repeal the heading, substitute:

Schedule 3—Formal requirements for documents to be filed

81 Schedule 4

Repeal the Schedule.

82 Part 2 of Schedule 7 (item 214)

Repeal the item, substitute:

- 214 Filing an application or request under section 17, 32 or 36, or subsection 191A(2) of the Act \$600

83 Part 2 of Schedule 7 (item 214A)

Omit “89(3)(b)”, substitute “29A(5)(b)”.

84 Part 2 of Schedule 7 (item 221)

Repeal the item.

85 Part 2 of Schedule 7 (item 224)

After “amend”, insert “a complete specification relating to”.

86 Item 232 of Schedule 7

Repeal the item.

Trade Marks Regulations 1995

87 Paragraph 4.4(6)(b)

After “sub-offices”, insert “(if any)”.

88 Paragraph 4.7(2)(c)

Repeal the paragraph.

89 Regulation 4.15, note 2

After “sub-offices”, insert “(if any)”.

90 Paragraph 17A.28(2)(b)

Omit “paragraph 41 (6) (a)”, substitute “paragraph 41(3)(b)”.

91 Regulation 17A.42F (heading)

Repeal the heading, substitute:

17A.42F Appeals to Federal Court or Federal Magistrates Court

92 Regulation 17A.42F

After “Federal Court”, insert “or Federal Magistrates Court”.

93 Regulation 19.1

After “sub-office” (wherever occurring), insert “(if any)”.

94 Subregulation 21.5(2)

After “sub-office” (wherever occurring), insert “(if any)”.

95 Regulations 21.15 and 21.16

Repeal the regulations, substitute:

21.15 Opportunity to be heard by Registrar

- (1) This regulation applies if the Act or these Regulations provide for a person to be heard by the Registrar.
- (2) The Registrar may give the person an opportunity to be heard by:
 - (a) asking the person for written submissions; or
 - (b) notifying the person that on request to the Registrar, the person may be heard by way of an oral hearing on a date, and at a time and place, determined by the Registrar; or
 - (c) notifying the person of the date, time and place of an oral hearing.
- (3) A request for a hearing must be in an approved form.
- (4) The Registrar is not bound by the rules of evidence, but may be informed on any matter that is before the Registrar in a way that the Registrar reasonably believes to be appropriate.

- (5) The Registrar may decide a matter if each person that is a party to the matter:
 - (a) notifies the Registrar that the person does not want to be heard; or
 - (b) does not file written submissions if requested under subregulation 21.16(1); or
 - (c) does not request an oral hearing after being notified under paragraph (2)(b); or
 - (d) does not attend an oral hearing if notified under subregulation 21.16(2).
- (6) In the circumstances mentioned in subregulation (5), the Registrar may make a decision by reference to relevant information that is held in the Trade Marks Office.
- (7) If the Registrar makes a decision in any of the circumstances mentioned in subregulation (5), the Registrar must notify each party of the Registrar's decision.

21.16 Written submissions and oral hearings

Written submissions

- (1) If the Registrar decides that a person may be heard by way of written submissions, the Registrar must:
 - (a) notify the person of the period in which the submissions must be filed (being at least 10 business days); and
 - (b) determine the matter after considering the written submissions; and
 - (c) notify the person of the Registrar's decision in relation to the matter.

Oral hearings

- (2) If the Registrar decides that a person may be heard by way of an oral hearing, the Registrar must give notice of the date, time and place of the hearing, to the person, at least 10 business days before the day the hearing is to begin.
- (3) The Registrar may adjourn an oral hearing from time to time or from place to place by notifying the person.

- (4) The Registrar may hold an oral hearing in which:
 - (a) a person appears in person; or
 - (b) a person participates by telephone or other means of telecommunications that the Registrar reasonably allows.
- (5) In addition to the Registrar's other powers, the Registrar may direct a person to provide a written summary of submissions.
- (6) An oral hearing must be conducted with as little formality and technicality, and as quickly, as the requirements of the Act, these Regulations and a proper consideration of the matters before the Registrar, allow.
- (7) Subject to these Regulations, the Registrar may give a direction that is reasonably necessary for the conduct of the hearing.
- (8) The Registrar must notify a person who appears at the hearing of the Registrar's decision in relation to the matter.

96 Paragraph 21.24A(b)

After "sub-office", insert "(if any)".

97 Subregulation 21.29(1)

Repeal the subregulation, substitute:

- (1) For the definition of *Convention country* in subsection 6(1) of the Act, the following countries are prescribed:
 - (a) a foreign country that is a signatory to the Paris Convention for the Protection of Industrial Property of 20 March 1883, as in force from time to time;
 - (b) a foreign country that is a full member of the World Trade Organization.

Note 1: For signatories to the Paris Convention for the Protection of Industrial Property, see www.wipo.int.

Note 2: For full members of the World Trade Organization, see www.wto.org.

98 Schedule 9 (table items 1 and 3)

Repeal the items, substitute:

- 1 Filing an application to register a trade mark under subsection 27(5) or 45(1) of the Act in respect of

Schedule 6 Amendments relating to simplifying the IP system

	goods or services in one or more of the prescribed classes:	
	(a) by approved means	\$120 for each class
	(b) in addition to the fee for paragraph (a), if the goods and services are specified in the application otherwise than by using the official Goods and Services pick list	\$80 for each class
	(c) by another means	\$220 for each class
	(d) by AFS request mentioned in regulation 4.2A	\$120 for each class
3	Filing an application to register 2 or more trade marks as a series under section 51 of the Act:	
	(a) by approved means	\$270 for each class
	(b) in addition to the fee for paragraph (a), if the goods and services are specified in the application otherwise than by using the official Goods and Services pick list	\$80 for each class
	(c) by another means	\$370 for each class

99 Schedule 10

Repeal the Schedule.

Schedule 7—Amendments relating to transitional provisions

Patents Regulations 1991

1 Before regulation 23.1

Insert:

Part 1—General

2 At the end of Chapter 23

Add:

Part 2—Amendments made by particular instruments

23.36 Amendments made by *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*

- (1) The amendments of these Regulations made by the items of Schedule 1 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* apply as set out in the following table.

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
1	item 1	the matters referred to in subitem 55(1) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
2	item 2	the matters referred to in subitem 55(9) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
3	item 3	the matters referred to in subitem 55(1) of

No. 31, 2013

Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)

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Schedule 7 Amendments relating to transitional provisions

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
		Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
4	item 5	the matters referred to in subitem 55(4) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
5	items 6, 7 and 8, in their application to the re-examination of a standard patent	the matters referred to in subitem 55(5) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
6	items 6, 7 and 8, in their application to the re-examination of an innovation patent	the matters referred to in subitem 55(7) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
7	item 9	the matters referred to in subitem 55(9) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
8	item 10, new subregulation 10.3(1)	a provisional specification filed on or after 15 April 2013
9	item 10, new subregulation 10.3(2)	the matters referred to in subitem 55(9) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i> , but treating the first reference to a complete specification in that subitem as a reference to an abstract
10	item 11	the matters referred to in subitem 55(9) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
11	item 12	the matters referred to in subitem 55(4) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
12	item 13	the matters referred to in subitem 55(8) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
13	items 15, 16, 17, 18 and 20	the matters referred to in subitem 55(3) of Schedule 1 to the <i>Intellectual Property Laws</i>

Transitional provisions

Item	Column 1	Column 2
	The amendments made by:	apply in relation to:

Amendment (Raising the Bar) Act 2012

(2) The amendments of these Regulations made by the items of Part 1 of Schedule 3 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* apply as set out in the following table.

Transitional provisions

Item	Column 1	Column 2
	The amendments made by:	apply in relation to:

1	item 2 (new regulation 5.3)	an opposition proceeding commenced before 15 April 2013
2	item 2 (new subregulations 5.9(1) to (5)) and item 9 (new item 218 of Schedule 7)	an opposition proceeding commenced before 15 April 2013 in which an extension of time is requested for a period that commences on or after 15 April 2013 However: (a) a reference in subregulation 5.9(1) to regulation 5.8 is taken to be a reference to regulation 5.8 as in force immediately before 15 April 2013; and (b) paragraph 5.10(1)(b) and subregulation 5.10(2), as in force immediately before 15 April 2013, are taken not to apply
3	item 2 (new regulation 5.20)	an opposition proceeding commenced before 15 April 2013 in which the Commissioner has not set a hearing date, or issued a notice of hearing to the parties, before 15 April 2013 However: (a) a reference in that regulation to regulation 5.26 is taken to be a reference to regulation 5.15 as in force immediately before 15 April 2013; and (b) a reference in that regulation to Part 5.4 is taken to be a reference to regulation 5.5 as in

Schedule 7 Amendments relating to transitional provisions

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
		force immediately before 15 April 2013; and (c) a reference in that regulation to regulation 5.19 is taken to be a reference to regulation 5.6 as in force immediately before 15 April 2013; and (d) regulation 5.12, as in force immediately before 15 April 2013, is taken not to apply
4	items 2, 7 and 9	an opposition proceeding commenced by the filing of a notice of opposition on or after 15 April 2013 However, if: (a) an amendment was advertised under regulation 10.5 before 15 April 2013; and (b) a notice of opposition is filed for subsection 104(4) of the Act on or after 15 April 2013; the reference in subregulation 5.10(1) to 2 months is taken to be a reference to 3 months Also, if: (a) an opposition proceeding was commenced by the filing of a notice of opposition before 15 April 2013; and (b) a document or evidence was not served in relation to the opposition proceeding before 15 April 2013; and (c) the document or evidence is required to be served on or after 15 April 2013; then: (d) a requirement in Chapter 5, or regulation 22.21, as in force immediately before 15 April 2013, for a party to serve a document or evidence on a person is taken to be a requirement to file the document or evidence; and (e) a reference to a document or evidence

Transitional provisions

Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
		<p>having been served is taken to be a reference to the document or evidence having been filed; and</p> <p>(f) the Commissioner must give a copy of the document or evidence to the person; and</p> <p>(g) if:</p> <p>(i) under Chapter 5, as in force immediately before 15 April 2013, a period for the person to do an action was calculated from the date that a party served the document or evidence; and</p> <p>(ii) the Commissioner does not give the document or evidence to the person on the filing date;</p> <p>the Commissioner must extend the period for the person to do the action by a number of days equal to the number of days between when the document or evidence was filed and when the Commissioner gave the document or evidence to the person</p>
5	item 3 (new regulation 6A.1)	the matters referred to in subitem 32(3) of Schedule 3 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
6	item 3 (new regulation 6A.2)	the matters referred to in subitem 32(4) of Schedule 3 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>

- (3) The amendment of these Regulations made by item 14 of Schedule 4 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* applies in relation to a charge that:
- (a) is laid against a registered patent attorney on or after 15 April 2013; and
 - (b) alleges the commission of a serious offence.

Schedule 7 Amendments relating to transitional provisions

(4) The amendments of these Regulations made by the items of Part 2 of Schedule 6 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* apply as set out in the following table.

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
1	item 5	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
2	item 6	the matters referred to in subitem 133(1) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
3	item 7	the matters referred to in subitem 133(4) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
4	item 8	a complete application for a standard patent in which a request for examination is made on or after 15 April 2013
5	items 9 to 12	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
6	item 13	a PCT application that enters the national phase on or after 15 April 2013
7	items 14 to 18	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
8	item 20	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
9	item 21	the matters referred to in subitem 55(9) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
10	item 22	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
11	item 23	the matters referred to in subitem 55(9) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
12	item 24, regulation 3.14C	the matters referred to in subitem 133(8) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
13	item 25 and 26	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
14	item 27	a direction issued under subsection 44(2) of the Act, on or after 15 April 2013
15	item 28	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws</i>
<i>No. 31, 2013</i>	<i>Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)</i>	<i>187</i>

Schedule 7 Amendments relating to transitional provisions

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
		<i>Amendment (Raising the Bar) Act 2012</i>
16	item 30	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
17	item 31	a PCT application that enters the national phase on or after 15 April 2013
18	items 36 and 37	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
19	item 38	a document that: (a) is related to a patent application; and (b) is not a specification; filed before, on or after 15 April 2013
20	item 39	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
21	items 40 and 41	the matters referred to in subitem 133(9) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
22	item 42	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
188	<i>Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)</i>	<i>No. 31, 2013</i>

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
23	item 43	a PCT application filed with a receiving Office on or after 15 April 2013
24	item 44	the matters referred to in subitem 133(9) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
25	item 45	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
26	item 47, paragraph 9A.4(f)	an application in relation to which a request for examination is made on or after 15 April 2013
27	item 47, paragraph 9A.4(g)	the matters referred to in subitem 133(12) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
28	items 48 to 50	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
29	item 51	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
30	item 53	an application or patent in relation to which leave to amend the patent request, complete specification or other filed document is granted on or after 15 April 2013

Schedule 7 Amendments relating to transitional provisions

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
31	item 54	the matters referred to in subitem 133(3) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i> unless other arrangements are made in this regulation
32	item 54	a request to rectify the Register to which the following apply: (a) the request was published before 15 April 2013; (b) the period to file an opposition under subregulation 5.3(5A) had not expired before 15 April 2013; (c) no notice of opposition was filed before 15 April 2013; as if it were a request to rectify the Register made on 15 April under regulation 10.7
33	item 55	all of the following: (a) aircraft, land vehicles and vessels that were foreign aircraft, foreign land vehicles or foreign vessels, within the meaning of the Act, immediately before 15 April 2013; (b) aircraft and vessels that are registered on or after 15 April 2013; (c) land vehicles the ownership of which is acquired on or after 15 April 2013
34	item 56	the matters referred to in subitem 133(9) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
35	item 57	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
36	item 58	the matters referred to in subitem 133(15) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
37	item 61	the matters referred to in subitem 133(6) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
38	item 62, new paragraph 13.4(1)(g)	an application in relation to which a request for examination is made on or after 15 April 2013
39	item 62, new paragraph 13.4(1)(ga)	the matters referred to in subitem 133(11) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
40	item 64, reference to new paragraph 13.4(1)(g)	an application in relation to which a request for examination is made on or after 15 April 2013
41	item 64, reference to new paragraph 13.4(1)(ga)	the matters referred to in subitem 133(11) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
42	items 65 and 66	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>

Schedule 7 Amendments relating to transitional provisions

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
43	items 67 and 68	an application in relation to which a request for examination is made on or after 15 April 2013
44	item 77, other than the insertion of new subregulation 22.22(1)	a hearing for which the Commissioner has issued a hearing notice, or an invitation to be heard, on or after 15 April 2013
45	item 78	an act referred to in subsection 226(1) of the Act done in relation to a prescribed document on or after 15 April 2013
46	item 80	a PCT application that enters the national phase on or after 15 April 2013
47	item 81	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
48	item 82	the matters referred to in subitem 133(3) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
49	item 83	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
50	items 84 and 85	the matters referred to in subitem 133(9) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
51	item 86	an application in relation to which a request for examination is made on

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Transitional provisions

Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
		or after 15 April 2013

(5) The amendments of these Regulations made by the items of Part 2 of Schedule 6 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* do not apply as set out in the following table.

Transitional provisions

Item	Column 1	Column 2
	The amendments made by:	do not apply:
1	item 29	in relation to the matters referred to in subitem 134(1) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
2	items 32 to 35	in relation to the matters referred to in subitem 134(1) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
3	item 52	in relation to the matters referred to in item 134 of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
4	item 54	to the extent that they would prevent the correction of a patent granted before 15 April 2013 in accordance with regulation 10.7 as in force immediately before 15 April 2013
5	item 60	in relation to the matters referred to in item 134 of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>

(6) Regulation 8.3, as continued in force in accordance with this regulation, is amended by omitting subregulation 8.3(2) and inserting:

(2) At the end of section 141:

Add:

- (3) Despite subsection (2), a PCT application is also to be treated as having been withdrawn if Article 11(3) of the PCT ceases to have effect in Australia in relation to the application under Article 24(1)(i) of the PCT.

Note: This amendment applies in relation to a PCT application that was made before 15 April 2013 and for which a notice of withdrawal was filed on or after 15 April 2013.

Trade Marks Regulations 1995

3 Before regulation 22.1

Insert:

Division 1—General

4 At the end of Part 22

Add:

Division 2—Amendments made by particular instruments

22.9 Amendments made by the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*

- (1) The amendments of these Regulations made by the items of Part 2 of Schedule 3 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* apply as set out in the following table.

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
1	all items of Part 2	the matters referred to in subitem 32(7) of Schedule 3 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
2	items 10 to 30	an opposition proceeding commenced by the filing of a notice of intention to oppose on or after 15 April 2013 However, if:

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Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
		<p>(a) an application was advertised before 15 April 2013; and</p> <p>(b) a notice of intention to oppose is filed on or after 15 April 2013;</p> <p>the reference in subregulations 5.6(1), 9.8(1), 17A.33(1) and 17A.48G(1) to 2 months is taken to be a reference to 3 months</p> <p>Also, if:</p> <p>(a) an opposition proceeding was commenced before 15 April 2013; and</p> <p>(b) a document or evidence was not served in relation to the opposition proceeding before 15 April 2013; and</p> <p>(c) the document or evidence is required to be served on or after 15 April 2013;</p> <p>then:</p> <p>(d) a requirement in Part 5, 6 or 9, Subdivision 3 of Division 3 of Part 17A, Subdivision 3 or Subdivision 4 of Division 5 of Part 17A, as in force immediately before 15 April 2013, for a party to serve a document or evidence on a person is taken to be a requirement to file the document or evidence; and</p> <p>(e) a reference to a document or evidence having been served is taken to be a reference to the document or evidence having been filed; and</p> <p>(f) the Registrar must give a copy of the document or evidence to the person; and</p> <p>(g) if:</p> <p>(i) under Part 5, 6 or 9, Subdivision 3 of Division 3 of Part 17A, Subdivision 3 or Subdivision 4 of Division 5 of Part 17A, as in force immediately before 15 April 2013, a period for the person to do an action was calculated</p>

Schedule 7 Amendments relating to transitional provisions

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
		<p>from the date that a party served the document or evidence; and</p> <p>(ii) the Registrar does not give the document or evidence to the person on the filing date;</p> <p>the Registrar must extend the period for the person to do the action by a number of days equal to the number of days between when the document or evidence was filed and when the Registrar gave the document or evidence to the person</p>
3	item 11 (new regulation 5.3), item 14 (new regulation 9.3), item 16 (new regulation 17A.30) and item 17 (new regulation 17A.48A)	an opposition proceeding commenced before 15 April 2013
4	item 11 (new regulation 5.17), item 13 (new regulation 6.9), item 14 (new regulation 9.20), item 16 (new regulation 17A.34M), item 17 (new regulation 17A.48V) and item 18 (new regulation 21.20E)	<p>an opposition proceeding commenced before 15 April 2013 in which the Registrar has not set a hearing date, or issued a notice of hearing to the parties, before 15 April 2013</p> <p>However:</p> <p>(a) a reference in regulation 5.17 to paragraph 5.8(3)(b) or subregulation 5.8(4) is taken not to apply; and</p> <p>(b) a reference in regulation 5.17 to regulation 5.14 is taken to be a reference to regulations 5.7 to 5.13 as in force immediately before 15 April 2013; and</p> <p>(c) a reference in paragraph 6.9(1)(a) to a party requesting a hearing is taken to include the conditions set out in subregulations 5.14(1) and (2) as in force immediately before 15 April 2013; and</p> <p>(d) a reference in regulation 9.20 to</p>

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
		<p>regulation 9.10 is taken not to apply; and</p> <p>(e) a reference in regulation 9.20 to regulation 9.16 is taken to be a reference to regulation 9.4 as in force immediately before 15 April 2013; and</p> <p>(f) a reference in regulation 17A.34M to regulation 17A.34B or 17A.34H is taken not to apply; and</p> <p>(g) a reference in regulation 17A.34M to regulation 17A.34J is taken to be a reference to regulation 17A.33 as in force immediately before 15 April 2013; and</p> <p>(h) a reference in regulation 17A.34M to regulation 17A.34N is taken to be a reference to regulation 17A.34 as in force immediately before 15 April 2013; and</p> <p>(i) a reference in regulation 17A.48V to regulation 17A.48K is taken not to apply; and</p> <p>(j) a reference in regulation 17A.48V to regulation 17A.48R is taken to be a reference to subregulation 17A.48(5) as in force immediately before 15 April 2013; and</p> <p>(k) a reference in paragraph 21.20E(1)(a) to a party requesting a hearing is to include the conditions set out in subregulations 5.14(1) and (2) as in force immediately before 15 April 2013; and</p> <p>(l) regulation 5.14, as in force immediately before 15 April 2013, is taken not to apply</p>
5	<p>item 11 (new regulation 5.15), item 14 (new regulation 9.18), item 16 (new regulation 17A.34K), item 17 (new regulation 17A.48T) and</p>	<p>an opposition proceeding commenced before 15 April 2013 in which an extension of time is requested for a period that commences on or after 15 April 2013</p> <p>However:</p> <p>(a) a reference in subregulation 5.15(1) to</p>

Schedule 7 Amendments relating to transitional provisions

Transitional provisions

Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
	item 24 (Schedule 9, new item 6)	regulation 5.14 is taken to be a reference to regulations 5.7 to 5.13 as in force immediately before 15 April 2013; and (b) a reference in subregulation 9.18(1) to regulation 9.16 is taken to be a reference to regulation 9.4 as in force immediately before 15 April 2013; and (c) a reference in subregulation 17A.34K(1) to regulation 17A.34J is taken to be a reference to regulation 17A.33 as in force immediately before 15 April 2013; and (d) a reference in subregulation 17A.48T(1) to regulation 17A.48R is taken to be a reference to subregulation 17A.48(5) as in force immediately before 15 April 2013; and (e) paragraph 5.15(1)(a) and subparagraph 5.15(3)(c)(i), as in force immediately before 15 April 2013, are taken not to apply

- (2) The amendment of these Regulations made by item 41 of Schedule 4 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* applies in relation to a charge that:
- (a) is laid against a registered trade mark attorney on or after 15 April 2013; and
 - (b) alleges the commission of a serious offence.
- (3) The amendments of these Regulations made by item 95 of Schedule 6 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* apply in relation to a hearing for which the Registrar issues a hearing notice, or an invitation to be heard, on or after 15 April 2013.

Designs Regulations 2004

5 Before regulation 12.01

Insert:

Part 1—General

6 At the end of Chapter 12

Add:

Part 2—Amendments made by particular instruments

12.05 Amendments made by the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*

The amendments of these Regulations made by item 3 of Schedule 6 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*, other than the insertion of new subregulation 11.22(1), apply in relation to a hearing for which the Registrar issues a hearing notice, or an invitation to be heard, on or after 15 April 2013.