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Official Notice

Title Changes to Part 17A of the *Trade Marks Regulations 1995* relating to:

- **Grounds of opposition to extension of protection to international registrations designating Australia (IRDAs)**
- **Applications for cessation of protection of protected international trade marks (PITMs)**

Part 1 of Schedule 1 to the *Trade Marks Amendment Act 2006* (the Amendment Act) commenced on 23 October 2006. The *Trade Marks Amendment Regulations 2006* (No. 1) were made on 13 December 2006. With effect from 19 December 2006, those amending regulations made consequential amendments to Part 17A of the *Trade Marks Regulations 1995*. These amendments are to make sure that some amendments made by Part 1 of Schedule 1 to the Amendment Act apply appropriately to trade marks governed by Part 17A of the Trade Marks Regulations—i.e. to IRDAs and PITMs.

The amending regulations:

- amend subregulations 17A.31 (2) and (3) to include references to the ground of opposition set out in new section 62A of the Trade Marks Act for an application for registration made in bad faith—this is to ensure that a trade mark that is the subject of an IRDA can be opposed on the same grounds as can a trade mark filed under the general provisions of the trade marks legislation;
- replace paragraph 17A.45 (2) (b) to ensure that a court can amend or cease the protection extended to a PITM, if use of the mark is likely to deceive or cause confusion because of the circumstances applying at the time of filing the application for amendment or cessation of protection—this ground is directly modelled on that applying to a registered trade mark under amended paragraph 88(2)(c) of the Trade Marks Act, with necessary changes;
- insert new paragraph 17A.45 (2) (c) to make it clear that a court can still amend or cease the protection extended to a certification trade mark that is a PITM, on the ground set out in section 177 of the Trade Marks Act—which continues to be a ground for the amendment or cancellation of a registered trade mark; and
- relace subregulation 17A.48 (1) and amend subregulation 17A.48 (2) to provide that any person can apply to the Registrar or to a court for a PITM to cease to be protected for non-use—this is for consistency with amended section 92 of the Trade Marks Act which allows any person to apply for removal of a registered trade mark from the Register of Trade Marks for non-use.

You should also note that since 23 October 2006, a number of other amendments made by Part 1 of Schedule 1 to the Amendment Act have applied to IRDAs and PITMs. For example, the amendments made by that Part to the grounds of opposition in sections 60 and 61 of the Trade Marks Act apply to all IRDAs that the Registrar



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accepted on or after that date. This is because of the application provisions in subregulations 17A.31 (2) and (3) of the Trade Marks Regulations. For the same reason, the new ground of opposition in new section 58A of the Trade Marks Act ('Opponent's earlier use of similar trade mark') has applied to IRDAs that the Registrar accepted on or after that date.

More information about the amendments made by the Amendment Act is available at:

<http://www.ipaustralia.gov.au/pdfs/news/MDB-OLS%20-%20TM%20Bill%20AOJTM%2026%20October06.pdf>

Correction: that notice implied that it may be necessary to amend Part 17A of the Regulations so as to apply to IRDAs the new ground of opposition in new section 58A of the Trade Marks Act. As already stated above, this is not so.

Further amendments will be required to the Trade Marks Regulations as a result of amendments to be made to the Trade Marks Act by Part 2 of Schedule 1 to the Amendment Act—which, subject to approval by the Governor-General, will commence on 27 March 2007. Details of those further amending regulations will be the subject of a further Official Notice, once they have been approved by the Federal Executive Council. We expect that the further amending regulations would be considered by the Federal Executive Council in March 2007.

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