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Official Notice

Intellectual Property Legislation Amendment Regulations 2007 (No. 1)

On 27 March 2007, the remaining Schedules to the *Intellectual Property Laws Amendment Act 2006* ('Amendment Act') will commence (Schedules 1, 2, 3 (Part 2), 4, 10 and 12). Among other things, Schedule 12 to the Amendment Act will insert new sections into the *Designs Act 2003* and the *Olympic Insignia Protection Act 1987* to clarify the effect of the Designs Office and its State offices not being open for business ('the close down provisions').

On 22 March 2007 the Federal Executive Council made the *Intellectual Property Legislation Amendment Regulations 2007 (No. 1)*—'the amendment regulations'. The amendment regulations have been registered in the Federal Register of Legislative Instruments and will appear on ComLaw (www.comlaw.gov.au). Generally, the amendment regulations will have effect from 27 March 2007.

The amendment regulations will amend the Designs Regulations and the *Olympic Insignia Protection Regulations 1993* to prescribe several matters under the close-down provisions. Details of how the close-down provisions will operate are provided below.

The amendment regulations will also amend the Designs Regulations to

- declare Montenegro to be a Convention country in its own right, separately from Serbia which also continues as a Convention country; and
- declare Yemen to be a Convention country.

The amendment regulations will also amend the *Patents Regulations 1991*, the *Plant Breeder's Rights Regulations 1994* and the *Trade Marks Regulations 1995*. For further information on the amendments to the Patents Regulations and the Trade Marks Regulations please see the 2007 *Official Notices* for Patents and Trade Marks titled *Intellectual Property Legislation Amendment Regulations 2007 (No. 1)*, available through <http://www.ipaustralia.gov.au/resources/officialnotices.shtml>. For further information on the amendments to the Plant Breeder's Rights Regulations, please see the next issue of the *Plant Varieties Journal*, which will be available via the Plant Breeder's Rights page at www.ipaustralia.gov.au/pbr/index.shtml#journal.

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How the new close-down provisions in the Designs legislation and the Olympic Insignia Protection legislation will operate

On 27 March 2007, the new close-down provisions in the Designs legislation and the Olympic Insignia Protection legislation will commence operation. The operation of these provisions is discussed below in two separate sections, because they operate slightly differently.

Close down provisions in the Designs legislation

The close-down provisions in the Designs legislation are new section 136A of the *Designs Act 2003* and new regulations 11.32 to 11.34 of the *Designs Regulations 2004*. The close-down provisions address the following situation:

- there is some time-period provided in the Designs legislation for you to do some action at the Designs Office in Canberra ('the Canberra office') or the State sub-offices of the Designs Office ('the State offices'); and
- on the last day of that period, the Canberra office or a State office is not open for business.

Generally, the close-down provisions will let you do that action at the Canberra office or State office that was not open for business—on the next day that the particular office is open for business—and still be in time.

The close-down provisions are not limited to your filing documents or paying fees at the Canberra office or a State office. They also pick up actions that can be done by delegates of the Registrar of Designs ('the Registrar') in some period provided in the designs legislation.

For example, the registration of a design that is being examined ceases if the Registrar is not satisfied in the relevant prescribed period that a certificate of examination can be issued **or** that the registration should be revoked—see paragraphs 48(1)(a) and 65(3)(b) of the Designs Act and regulation 5.04 of the Designs Regulations. If the relevant period ends on a day when the Canberra office is closed, the close-down provisions will let a delegate decide to issue the certificate of examination or to revoke the registration on the next day the Canberra office is open for business.

In practical terms, IP Australia expects that the close-down provisions will result in minimal change for you. The principal difference is that you will not be substantially disadvantaged by the Canberra office and the State offices being closed for the period between Christmas Day and the New Year's Day holiday. Also, you will not be substantially disadvantaged by the Canberra office or any of the State offices being closed unexpectedly (e.g. owing to bushfires or power failure). Several examples of how the close-down provisions can help you are set out at the end of this notice.

In addition, even when the Canberra office is closed, IP Australia will continue to provide facilities for receiving electronic communications through IP Australia's secure corporate fax number—02 6283 7999. Responses to examiner's reports can also be sent by e-mail to IP Australia's general e-mail address: assist@ipaaustralia.gov.au. See the news item of 3 January 2007, at www.ipaustralia.gov.au/resources/news_new.shtml#2, announcing the revised Electronic Business Rules and providing a link to them.

When will the Canberra office and the State offices be closed?

As is currently the case, the Canberra office and the State offices will be closed for several national and local public holidays.

Soon the Director General of IP Australia will declare the days on which the Canberra office and State offices will not be open for business during the 2007 Calendar year. This declaration will be published promptly on the *Whats New* and *Official Notices* pages of IP Australia's website (at www.ipaustralia.gov.au/resources/news_new.shtml and www.ipaustralia.gov.au/resources/officialnotices.shtml respectively). The declaration will also be published in the *Official Journal of Designs*, which is available through <http://pericles.ipaustralia.gov.au/ols/epublish/content/olsEpublications.jsp>.

If the Canberra office or any State office is closed unexpectedly, then the Director General will also declare the particular days that the Canberra office or particular State office affected were not open for business. The declaration will be published on the *Whats New* and *Official Notice* pages of IP Australia's website, and in the *Official Journal*.

What actions will not be governed by the new close-down provisions?

Actions that are *not* done at the Canberra office and the State offices will not be governed by the new close-down provisions. These are actions done in relation to proceedings in a court or a tribunal. For these actions, the previous position will continue unchanged. For periods provided in legislation governing a court or tribunal (e.g. court rules), you will need to continue to refer to that legislation. For periods provided in the Designs legislation for a court proceeding, you will need to continue to refer to subsection 36 (2) of the *Acts Interpretation Act 1901* to consider when you can do the action.

For example, subsection 71 (4) of the Designs Act requires that court proceedings for infringement of a design must be started within 6 years from the day on which the alleged infringement occurred. Infringement proceedings may be brought in the Federal Court or a Supreme Court of a State or Territory. If the last day of that 6-year period ends on a public holiday in the place where a particular court is located, subsection 36 (2) of the *Acts Interpretation Act* will allow the infringement proceedings to be commenced on the next business day in that place.

For a discussion of the operation of subsection 36 (2) of the *Acts Interpretation Act*, please see the 2004 Official Notice *Time periods and local holidays*. The notice was published on the *Official notices: Designs notices 2002 – 2005* webpage on 17 December 2004 at http://www.ipaustralia.gov.au/resources/officialnotices_d0.shtml#1, where it can still be found.

Here are several examples of how the close-down provisions can help you.

Weekends and other days on which all the Canberra office and State offices are closed

On Friday 22 June 2007, a person in New Zealand files an application for registration of a design (the first application for that design anywhere). Under section 27 of the Designs Act and regulation 3.06 of the Designs Regulations, the New Zealand applicant has 6 months to make an application in Australia for the same design claiming a right of priority from the New Zealand filing—i.e. by Saturday 22 December 2007 at the latest.

The Canberra office and all of its State offices close for the Christmas period on the afternoon of Monday 24 December 2007, and do not re-open for business until the morning of Wednesday 2 January 2008. During that period (if the applicant wishes), the Australian application can be filed at the Canberra office by way of IP Australia's secure corporate fax number—02 6283 7999.

On Wednesday 2 January 2008, the application can be filed at the Canberra office—in person, by receipt of post or by fax to IP Australia's secure corporate fax number (see above). It can also be filed at any of the State offices in person or by receipt of post. If the application for the design is filed on that Wednesday, it will be in time to validly claim a right of priority from the New Zealand filing.

Public holidays affecting the Canberra office but not the State offices

On Monday 17 September 2007, an applicant files at the Victorian State office in Melbourne an application for a design, and does not request the registration of the design in the application. This is the first filing of the design by the applicant. Generally, the applicant has six months to request the registration of the design—by Monday 17 March 2008, at the latest. The application will lapse otherwise.

The Canberra Day holiday is celebrated on a Monday in March each year—in 2008 on 17 March. The Canberra office is not open for business on that day, but all the State offices are open. The request for registration of the design could be filed at any of the State offices in person or by receipt of post. Alternatively, as IP Australia's secure corporate fax number (see above) is available on Canberra day, the request can also be filed via that means on Canberra Day.

On Tuesday 18 March 2008 when the Canberra office re-opens, the request for registration of the design could be filed in time with the Canberra office—in person, by receipt of post or by IP Australia's secure corporate fax number (see above). However, on that Tuesday, the request could *not* be filed in time at any of the State offices, which were open on the Monday.

State or local public holidays affecting a State office

On 1 July 2004, an application for registration of a design is filed, and the design is registered. On 20 August 2007, the registered owner requests the Registrar to examine the design, but the registered owner does not pay the prescribed fee when filing the request. The Registrar writes to the registered owner on 6 September 2007, inviting the registered owner to pay the outstanding fee within 2 months after the date of the invitation—by 6 November 2007 at the latest. If the registered owner does not pay the fee by that date, the registration will cease.

The Victorian office in Melbourne is closed for the Melbourne Cup holiday, a public holiday in Melbourne—in 2007 on 6 November. The Canberra office and the *other* State offices are open for business. The fee can be paid at the Canberra office—in person, by receipt of post or by faxing credit card details to IP Australia's secure corporate fax number (see above). The fee could also be paid at the other State offices—in person or by receipt of post.

On Wednesday 7 November 2007, the fee could be paid in time at the Victorian office, in person or by receipt of post. On that Wednesday, the fee could *not* be paid in time at the Canberra office or at any of the *other* State offices, which were open on the Tuesday. This would also exclude paying the fee by faxing credit card details to IP Australia's secure corporate fax number (see above), since the receiving fax machine is located in Canberra.

Unexpected closure of a Canberra office or State office

The five-year initial term of registration of a design expires on 18 June 2009. Under section 47 of the Designs Act, the registered owner may apply for a renewal of the registration for a further five years counted from that expiry date. Under subsection 47 (2) of the Designs Act and regulation 4.09 of the Designs Regulations, the application for renewal may be made and the prescribed fee for renewal may be paid up to six months after the expiry date—provided the registered owner also pays the additional fee for each month or part of month after the expiry date that the fee is paid. So the registered owner has until 18 December 2007 at the latest to apply for renewal of the registration.

As it happens, on Friday 18 December 2009, the Canberra office is closed because of a city-wide failure of the water supply. The Canberra office re-opens for business on Monday 21 December 2009, when the water supply is restored. On the Monday, the Director General of IP Australia declares that the Canberra office was not open for business on the Friday.

On the Monday, the application for renewal can be filed and the renewal fee and the additional fee for six months can be paid at the Canberra office—in person, by receipt of post or by faxing it to IP Australia's secure corporate fax number. The request cannot be made and the fees cannot be paid at any of the State offices that were open on the Thursday, and still be in time.

Close down provisions in the Olympic Insignia Protection legislation

The close-down provisions in the Olympic Insignia Protection legislation are new section 14A of the *Olympic Insignia Protection Act 1987* (OIP Act) and new regulations 6A to 6C of the *Olympic Insignia Protection Regulations 1993* (OIP Regulations). The close-down provisions apply only to Chapter 2 of the OIP Act, which protects the Olympic insignia by:

- making the Australian Olympic Committee (AOC) the owner of copyright in the Olympic symbol;
- making the AOC the owner of certain Olympic designs; and
- providing that the Olympic motto, the Olympic symbol and certain other Olympic images must not be registered as trade marks.

Chapter 2 of the OIP Act is the only chapter in the OIP Act that provides for any actions to be done at the Designs Office in some prescribed period. Those actions are:

- a person making representations objecting to the grant of an application for registration of a Olympic design—in a specified period of at least 60 days after the date of a notice in the *Gazette* and *Official Journal* (subsections 10(5) and 10(6) of the OIP Act);
- the AOC applying to the Registrar of Designs to extend the protection period of a registered Olympic design—during the period beginning on the day the design is registered to not later than 6 months before the end of the protection period (subsection 11(1) of the OIP Act);
- a person making representations objecting to the grant of an application for extension of the protection period—in a specified period of at least 60 days after the date of a notice in the *Gazette* and *Official Journal* (subsections 11(4) and 11(5) of the OIP Act); and
- the Registrar extending the protection period before the end of that period—subsection 11(6) of the OIP Act.

The close-down provisions in the OIP legislation operate differently from those in the Designs legislation. The *Designs Act 2003* provides that actions may be taken at the State sub-offices of the Designs Office. In contrast, the OIP Act does not provide for any action to be done at any of those State offices. Any action to be done at the Designs Office under the OIP legislation must be done at the Canberra office. So the close-down provisions in the OIP legislation address the following situation:

- there is some period provided in Chapter 2 of the OIP legislation for doing some action at the Canberra office; and
- on the last day of that period, the Canberra office is not open for business.

As a result, the close-down provisions will allow the actions listed above to be done on the next day that the Canberra office is open for business, and still be done in time.

When will the Canberra office be closed?

As is currently the case, the Canberra office will be closed for several national and local public holidays. See the discussion under the heading *When will the Canberra office and the State offices be closed?* Above, as to when the Canberra Office will be closed. At the same time the Director General declares when the Canberra office is not open for business for the purposes of the Designs legislation, the Director General will also declare when the Canberra office is not open for the purposes of the OIP legislation. These declarations will be published in the same manner as declarations under the Designs close-down provisions (see above).

What actions will not be governed by the new close-down provisions?

As with the operation of the close-down provisions in the Designs legislation, actions that are not done at the Canberra office will not be governed by the close-down provisions in the OIP legislation. These are actions done in relation to proceedings in a court or a tribunal.

There is a single action of this type to be done in a period provided in Chapter 2 of the OIP Act. This action is the AOC granting or refusing consent to a licensee instituting an action or proceeding for infringement of the monopoly in a protected design—which must be done within 7 days after the day on which the licensee serves notice on the AOC (subsection 8(5) of the OIP Act). If the AOC fails to grant or refuse consent in that period, it is deemed at the end of that period to have granted the consent required.

The exclusion of this action from the close-down provisions means that subsection 36(2) of the *Acts Interpretation Act 1901* will continue to apply to the action. As a result, if the period provided in subsection 8(5) of the OIP Act ends on a weekend, a public holiday or a bank holiday in a place where the action can be performed, the action can be done on the next business day at that place. The AOC is currently based in Sydney, so the place where the consent could be granted or refused is the office of the AOC in Sydney. Accordingly, it is public holidays and bank holidays in Sydney that are relevant, *not* those in Canberra.

Actions to be done under the *other* chapters of the OIP Act will not be governed by the close-down provisions. This is because these actions are not done at the Designs Office at all. For example, Chapter 3 of the OIP Act prohibits the commercial use of certain Olympic expressions—e.g. Olympic, Olympiad etc—unless the user holds a licence granted by the AOC. Among other things, that chapter provides for applying to the courts for remedies for contravening use of protected Olympic expressions. The chapter also provides for seizure by Customs of imported goods bearing such expressions. There are several actions to be taken before the Chief Executive Officer of Customs (CEO) in particular periods. For example, the objector can request that the CEO extend the period for holding the seized goods—in which the objector can apply to a court for an injunction in relation to those goods—by up to 10 *working days*. The expression *working days* is already defined to exclude days of the weekend and public holidays in the ACT.

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To be published in the Australian Official Journal of Designs on 5 April 2007.