



Australian Government

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### Official Notice

## TRADE MARKS OFFICE

### Legislation and Examination Practice in Relation to Divisional Applications

New provisions for divisional applications came into effect on 27 March 2007. The intent of the amended legislation was for the goods/services of the divisional application to be clearly divided from those of the parent and to avoid duplication.

Some divisional applications filed on or after 27 March 2007 have been invalid.

The most common problems are those divisional applications where the goods and/or services that are to remain in the parent have *not* been specified or where an *overlap* exists between the goods and/or services of the parent and the divisional.

To avoid submitting an invalid divisional, you must inter alia:

- Specify the goods and/or services **to remain in the parent [section 46(1)(c)]** on the divisional application at the time of filing; and
- Ensure that there is **no overlap** between the goods and/or services of the parent and the divisional. According to section 46(2), when a divisional application is made, the Registrar *must exclude* the goods/services of the divisional from the goods/services of the parent. In cases of overlap the Registrar must therefore exclude goods and/or services from the parent that the applicant *has specified to remain* in the parent.

For example, a divisional application is filed for “headgear” where the goods of the parent are “clothing, footwear and headgear”. The divisional application specifies “clothing, footwear, caps” as the goods to remain in the parent. There is an overlap with “caps” and “headgear”. Since the Registrar must exclude the goods of the divisional from the goods of the parent there is no option under section 46(2) for “caps” to remain in the parent. If the application is to proceed with the divisional priority date, the parent specification will be amended by the Registrar to read “Clothing and footwear”. Alternatively, the applicant may retain the overlapping goods by forfeiting the divisional priority claim.

A list of questions follows (see next page) to assist applicants and agents when filing divisional applications.



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### FILING DIVISIONALS ON OR AFTER 27 MARCH 2007

- Is the applicant of the divisional application the same as the applicant for the parent application?
- Was this application filed while the parent application was still pending? (pending includes status “accepted”)
- Is the trade mark for this application the same as the trade mark on the parent application
- Are the goods/services of the divisional **some only** of the goods/services of the parent?
- Does the application specify the goods/services that are to remain in the **parent** application?
- Are the goods/services of the divisional **clearly distinct** from the goods/services to remain in the parent? (NB. There should be no overlap in the goods/services of the parent with the goods/services of the divisional.)

Please contact IP Australia if you have any queries regarding divisional applications.

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