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Amendments

New provisions from 27 March 2007

The *Trade Marks Act 1995* (the Act) allows for some circumstances where it is possible to amend your trade mark application once you have filed it. Shortly after a trade mark application is filed, it is published on the Database of Trade Marks as a pending application. The Database is publicly available and can be searched online by any interested party, such as those considering filing their own application. This means amendments to trade mark applications need to be carefully considered by the Registrar before they are made, in order to lessen the potential adverse impact of such an amendment on other parties.

Amendments to the Act effective as of 27 March 2007 have clarified existing provisions and introduced new provisions for amending trade mark applications. If you wish to amend your application you will need to be aware of the provisions.

What are the new provisions for amendment?

The new provisions for amendment are:

- Amendment to section 65, chiefly to clarify it, and include two more examples of circumstances where there may be an error or omission, where amendments would be allowable – ie. adding a class or classes of goods or services, and deleting a mark from a invalid series
- A new section 65A (65 capital A) that allows the Registrar to amend an

application to correct a clerical error or obvious mistake, if she thinks it is fair and reasonable to do so.

- A new section 66A which allows the Registrar to ask for your request for amendment in writing if the amendment is not of a minor nature. Note that the words 'in writing' have been deleted from the other provisions. This has the effect of allowing the Registrar to make some minor amendments in response to a request by phone.

How will the new section 65A work?

- It will only apply to amendments to correct details that are clearly the result of an error or omission. The Registrar may require you to file a declaration in support of your request.
- The Registrar will only consider the request if she considers it is fair and reasonable – eg a request made a long time after filing your application might not be allowed.
- The Registrar might, in the process of considering the request, conduct a search of the trade marks database for marks that might become conflicting because of the amendment. If any conflicts are located, this may well affect the Registrar's consideration.



Australian Government

IP Australia

- Once the Registrar is satisfied that she wants to proceed with the amendment, the amendment will be set up to be advertised in the Official Journal for opposition purposes.
- After one month, if no opposition has been filed, the amendment will be approved.
- If an opposition to the amendment has been filed, then the opposition process will take place, in line with the procedures set down for opposition to an extension of time of more than 3 months.
- Note that there are no provisions for deferment of an application whilst this sort of opposition process is in progress – extensions of time would need to be requested, if required.

When may I make a request for amendment under the new provisions?

At any time on or after 27 March 2007.

Where in the Act and Regulations does it refer to the making of amendments?

The provisions contained in section 65 have been changed and the addition of a new section, 65A has been made. Further information can be found in Part 9 of the Trade Marks Office Manual of Practice and Procedure. This is a reference manual used by trade mark staff at IPAustralia and can be accessed via the following link:

<http://www.ipaustralia.gov.au/resources/manuals/trademarks.shtml>

Making Amendments by Phone

What is a phone amendment?

Some amendments to applications may now be made by phone.

What amendments may be made by phone?

Only minor amendments that do not in any way affect the rights granted to the applicant. They could be straightforward things such as correction of typographical errors or very minor changes to your personal details.

Will the Registrar be able to do all amendments by phone?

No, only minor amendments will be able to be done. If the amendment is of a complex nature, the examiner will ask that the amendment be requested in writing.

What is a minor amendment?

- A typographical or clerical mistake, such as;
 - Punctuation
 - Misspellings - such as the words in your address.
- Priority claim – only convention application number, not the date or convention country
- Address for service – only if the same firm, but different city has been nominated eg Melbourne for Sydney
- Endorsements – translations only

What is not a minor amendment?

- Name of applicant



Australian Government

IP Australia

- Address of applicant
- Address for service
- Trade Mark
- Goods/services
- Class – a change of class or addition of a class
- Endorsements – other than translations

If I notice a mistake in the details of my trade mark application on the trade marks office database (ATMOSS)?

If the mistake is because we have not copied your details correctly onto ATMOSS, then you may phone the office. As long as it is clear that this is what has happened IP Australia staff will be able to correct the information without notice in writing.

If I discover that I have put the wrong trade mark or other details in my application, soon after filing it, can I make these changes by phone?

You can only make such changes, if the details of your application have not yet been captured on our system. However, such changes are not usually minor, and it is not likely that they could be done without confirmation in writing.

If I have received an examiner's report, and they have suggested an amendment to the goods and/or services, could I phone and agree to the amendment?

If the proposed amendment has been clearly spelt out in the examiner's report, and it is not for the purpose of overcoming a major problem (e.g. a citation or a descriptive problem), then it is possible that the

examiner will agree to process this amendment, as a result of your phone call. IP Australia staff will always make and keep a record of your request on our files.

When may I make a phone amendment?

At any time on or after 27 March 2007.

Where in the Act and Regulations does it refer to the making of phone amendments?

The provisions that have been changed are section 63, section 65 and a new section 65A. Further information can be found in Part 9 of the Trade Marks Office Manual of Practice and Procedure. This is a reference manual used by trade mark staff at IP Australia and can be accessed via the following link:

<http://www.ipaustralia.gov.au/resources/manuals/trademarks.shtml>