

Exposure Draft of the Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and other measures) Regulations 2017:

Draft Explanatory Statement

October 2017



Introduction

This draft Explanatory Statement accompanies an Exposure Draft of the Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and other measures) Regulations 2017, which is proposed to implement a number of measures in the Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and other measures) Bill 2017.

IP Australia invites interested parties to make written submissions on the Exposure Draft Bill and this draft Explanatory Statement by **4 December 2017**.

Please note that the draft Explanatory Statement is still being developed and is intended only as a guide to assist with the interpretation of the draft legislation. IP Australia will undertake further editorial review and will finalise the text when a final version of the legislation is settled.

Written submissions should be sent to consultation@ipaaustralia.gov.au.

For accessibility reasons, please submit responses by email in Word, RTF, or PDF format.

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Overview of Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and other measures) Regulations 2017

Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and other measures) Regulations 2017

Issued by the Authority of the Minister for Industry, Innovation and Science

Designs Act 2003

Patents Act 1990

Plant Breeder's Rights Act 1994

Trade Marks Act 1995

Legislative Authority

Subsection 149(1) of the *Designs Act 2003* ('Designs Act'), subsection 228(1) of the *Patents Act 1990* ('Patents Act'), subsection 80(1) of the *Plant Breeder's Rights Act 1994* ('Plant Breeder's Rights Act') and subsection 231(1) of the *Trade Marks Act 1995* ('Trade Marks Act') (collectively, 'the Acts') provide that the Governor-General may make regulations prescribing matters required or permitted by the Acts to be prescribed, or necessary or convenient to be prescribed for carrying out or giving effect to the Acts.

The Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and other measures) Bill 2017 ('Amendment Bill') will amend the Acts to implement recommendations from the Productivity Commission's (PC) 2016 inquiry into Australia's intellectual property ('IP') arrangements, streamline and align processes in the Acts and provide for other high priority IP law amendments that are ready to be implemented.

The Acts do not specify any conditions that must be met before the power to make the Regulation may be exercised. The Amendment Bill will not alter this status.

The Regulations

The Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and other measures) Regulations 2017 ('Amendment Regulations') amends the *Designs Regulations 2004* ('Designs Regulations'), the *Patents Regulations 1991* ('Patents Regulations'), the *Plant Breeder's Rights Regulations 1994* ('Plant Breeder's Rights Regulations'), and the *Trade Marks Regulations 1995* ('Trade Marks Regulations'),— collectively 'the Regulations'—to prescribe matters required under the provisions of the Acts as amended by the Amendment Bill. The Amendment Regulations also amend the Regulations to align and streamline some processes involved with obtaining and maintaining IP rights.

Purpose of the Amendment Regulations

The various Parts in Schedule 1 to the Amendment Regulations amend the Plant Breeder's Rights, Trade Marks and Patents Regulations as follows:

Part 1—Plant Breeder's Rights (PBR) in essentially derived varieties (EDV)

- provides for administrative details regarding a new process for EDV declarations

Part 2—Period to apply for removal of trade marks from Register for non-use

- ensures the new time period provided for in subsection 92(4) of the Trade Marks Act also applies to international trade mark applications

Part 3—Innovation Patents

- makes amendments to the Patents Regulations necessary to implement the Government's decision to abolish the innovation patent system

Part 4—Notification of extension of standard patents relating to pharmaceutical substances

- makes a consequential amendment as a result of the repeal of section 76A of the Patents Act.

The various Parts in Schedule 2 to the Amendment Regulations amend the Regulations as follows:

Part 1—Extensions of time (Trade Marks Regulations only)

- prescribes matters for extensions of time for filing notices of intention to defend.

Part 2—Written requirements

- removes requirements for giving notice in writing, as a consequence of amendments to the Acts by Part 2 of Schedule 2 to the Amendment Bill. The new provisions in the Acts permit notification by any means of communication (including by electronic means).
- requires the Registrar of Trade Marks to publish the fact of withdrawal of an application, notice or request in the Official Journal.

Part 3—Filing requirements

- outlines the consequences for providing information to IP Australia when the information does not comply with a direction; and
- makes consequential amendments due to amendments in the Plant Breeder's Rights Act regarding the filing of documents and payment of fees.

Part 4— Protection resulting from the international registration of a trade mark (Trade Marks Regulations only)

- corrects references that relate to International Registrations Designating Australia (IRDAs).

Part 5—Signatures (Patents Regulations only)

- removes the requirements for two types of documents to be signed.

Part 6—Addresses and service of documents (Designs, Patents and Trade Marks Regulations only)

- repeals provisions for addresses for correspondence.

- removes requirements for serving or filing of documents that are inconsistent with changes introduced by Schedule 3 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

Part 7—Requirements for patent documents (Patents Regulations only)

- replaces formality requirements in the Patents Regulations (including those in Schedule 3) with requirements to comply with new provisions inserted in the Patents Act by Part 7 of Schedule 2 to the Amendment Bill. This includes new section 229, which enables the Commissioner of Patents to issue an instrument determining formality requirements.
- enables patent specifications to use graphics and/or photographs to describe inventions.

Part 8—Acceptance of trade marks applications (Trade Marks Regulations only)

- amends the Trade Marks Regulations to allow applicants that are granted an extension of time for acceptance of a trade mark to submit a request for deferral during that extended period.

Part 9—Copies of design representations (Designs Regulations only)

- replaces the requirement to file five copies of design representations with a requirement that at least one of each representation of the design be filed.

Part 10—Amendment of registered trade mark due to inconsistency with international agreements (Trade Marks Regulations only)

- reinstates procedures for conducting an opposition against amendments made to a registered trade mark to overcome an inconsistency with international agreements.
- includes a small number of references that were inadvertently missed in the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* relating to trade mark oppositions.

Part 11—Secretary’s role in the Plant Breeder’s Rights Regulations (Plant Breeder’s Rights Regulations only)

- transfers the powers of the Secretary of the Department of Industry, Innovation and Science to the Registrar of PBR.

Part 12 – Other amendments (Trade Marks Regulations only)

- repeals the definition of Norfolk Island in Part 13 of the Trade Marks Regulations, as the reference is no longer correct.

Part 13—Application, transitional and saving provisions

- sets out how the amendments in Schedule 2 to the Amendment Regulations will apply in certain circumstances; and
- saves the operation of any repealed provisions, as necessary.

Consultation undertaken on Amendment Regulations

From November 2016 to February 2017, IP Australia sought public comment on the proposed changes to IP processes in the form of an Exposure Draft of the Intellectual Property Laws Amendment Bill 2017 and the Exposure Draft of the Intellectual Property Laws Amendment Regulations 2017. Seventeen non-confidential submissions were received. In light of those submissions and the Government’s response to the Productivity Commission’s inquiry into Australia’s IP arrangements, several proposals have been changed.

Regulation Impact Statement

The Office of Best Practice Regulation ('OBPR') has advised that no Regulation Impact Statement is required to be prepared for these amendments. The OBPR reference numbers are provided below.

Schedule 1

Parts 1 to 4: 21654

Schedule 2

Part 1—Extensions of time: 17734

Part 2—Written requirements: 17570

Part 3—Filing requirements: 17573

Part 4— Protection resulting from the international registration of a trade mark: 17734

Part 5—Signatures: 17576

Part 6—Addresses and service of documents: 17734

Part 7—Requirements for patent documents: 17578

Part 8—Acceptance of trade marks applications: 17734

Part 9—Copies of design representations: 17567

Part 10—Amendment of registered trade mark due to inconsistency with international agreements: 21007

Part 11—Secretary's role in the Plant Breeder's Rights Regulations: 19009

Part 12 – Other amendments: 17734

Commencement of the Amendment Regulations

The commencement arrangements for each of the Parts of Schedules 1 and 2 are set out in the commencement table at regulation 2 of the Amendment Regulations. The majority of the items in the Amendment Regulations are intended to operate in conjunction with the corresponding items in the Amendment Bill, so the commencement provisions for the relevant items are aligned with the Amendment Bill.

Schedule 1—Responses to the Productivity Commission

Part 1—PBR in essentially derived varieties

This Part amends the Plant Breeder’s Rights Regulations to implement certain administrative details regarding the process for considering an application to declare that a non-PBR-protected variety is an EDV.

Part 2 of Schedule 1 to the Amendment Bill will implement a process for making an EDV declaration for a non-PBR-protected variety. To help ensure procedural fairness to all parties, the Bill provides that the second breeder must be notified, details of the application for a declaration must be published, and any interested person must have an opportunity to be heard before a decision is made. The procedure for the notification, publication, and hearing processes is prescribed in the regulations.

Plant Breeder’s Rights Regulations 1994

Item 1: Regulations 3AB to 3AD

[regs 3AB, 3AC, 3AD]

Regulations 3AB, 3AC and 3AD provide the administrative procedures for the notification, publication and hearing processes associated with an application for a declaration for a non-PBR-protected variety.

Under new subsection 41B(1) of the Plant Breeder’s Rights Act, the applicant for a declaration must give a copy of the application and any other prescribed information to the person that they reasonably believe is the breeder of the second variety (the **notified person**). This regulation prescribes additional information that the applicant for a declaration must give to the alleged second breeder.

The applicant for a declaration must give the notified person details of the opportunity to be heard (paragraph 3AB(a)). This ensures that the notified person is aware of the steps that they must take if they wish to contest the application for a declaration.

The applicant for a declaration must also give a statement to the effect that, if the notified person does not participate in the proceedings the Registrar may draw an inference that is unfavourable to their interest in deciding the application for a declaration (paragraph 3AB(b)). This ensures that the notified person is aware that a failure to participate in proceedings or provide written or oral submissions may increase the likelihood that the Registrar makes a decision to make an EDV declaration. This provides an incentive for the notified person to participate if they have a genuine interest in how the matter is resolved.

Under subsection 41B(3), the Registrar must publish a notification of the application for a declaration in the *Plant Varieties Journal*, along with any prescribed information. Regulation 3AC prescribes what additional information that must be published.

The Registrar must publish a description of both the initial variety and the second variety (paragraph 3AC(a)). This ensures that an interested person (eg a competitor in the plant industry) has sufficient information to be able to determine if an application for a declaration relates to a variety that they have an interest in.

The Registrar must publish details of both the grantee (applicant for a declaration) and the notified person (paragraph 3AC(b)). This ensures that an interested person has enough information to determine who is

involved. In particular, the applicant for a declaration may incorrectly identify the second breeder on the application, so this publication provides the opportunity for others to be informed that this matter is in dispute.

The Registrar must publish any other relevant information that they possess (other than commercial-in-confidence information) (paragraph 3AC(c)).

Similar to 3AB above, the Registrar must also publish details for how an interested party can participate in the proceedings and the consequences if they fail to so participate (paragraph 3AC(d) and (e)).

Under subsection 41C(3) the Registrar must give any interested person an opportunity to be heard. Regulation 3AD provides the administrative procedure for an interested person to provide information. For the purposes of section 41A of the Plant Breeder's Rights Act, an interested person is considered to provide the Registrar information if they make a submission (written or oral), pay any prescribed fee, and comply with any other aspect of the regulation. Currently no fee is prescribed. The requirement to comply with other aspects of the regulation provides a consequence if an interested person does not comply with the hearing procedures and directions given in accordance with the subregulations below.

The Registrar decides how the interested person may be heard (subregulation 3AD(3)). The Registrar can request that the interested person provides written submissions. The Registrar can hear the person orally if the person requests a hearing or they can decide to hold a hearing on a particular date and notify the interested person to attend on that date. In any event, the Registrar must give at least 10 business days for the person to prepare.

The Registrar may convene an oral hearing (subregulation 3AD(4)), and manage the procedural aspects of the hearing (subregulations 3AD(5) to (7)). The Registrar may hold a hearing in-person or by telephone or other means. The Registrar can adjourn the proceedings and require the person to provide a summary of submissions beforehand. The Registrar also has a power to direct persons attending the hearing to ensure that the hearing operates efficiently and effectively.

Item 2: Clause 1 of Schedule 1 (table item 9)

This item amends the existing fee item for filing an application for a declaration to extend the fee to an application for a declaration for a non-PBR-protected second variety under the new subsection 41A(1). The amount of the fee remains the same.

Part 2—Period to apply for removal of protected international trade marks from Register for non-use

This Part contains amendments to the Trade Marks Regulations to ensure the changes made to the period provided under subsection 93(2) of the Trade Marks Act in Part 3 of Schedule 1 to the Amendment Bill will also apply to international trade marks filed through the system established under the Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol). It also contains amendments to correct drafting errors in the Trade Marks Regulations.

Trade Marks Regulations 1995

Item 3: Paragraph 17A.48D(2)(g)

[reg 17A.48D]

Item 1 amends paragraph 17A.48D(2)(g) to correct a drafting oversight. The ‘filing date’ mentioned in this provision should refer to the filing date of an application for a trade mark, rather than to the filing date of the registration of the trade mark.

Item 4: Subparagraph 17A.48D(2)(g)(ii)

[reg 17A.48D]

This item amends subparagraph 17A.48D(2)(g)(ii) to replace an incorrect reference to Article 3^{ter} 2(2) with a reference to Article 3^{ter} (2).

Item 5: At the end of subregulation 17A.48D(2)

[subreg 17A.48D(2)]

This item adds a new paragraph to subregulation 17A.48D(2) of the Trade Marks Regulations.

Regulation 17A.48D provides for the application of Part 9 of the Trade Marks Act and Part 9 of the Regulations (Removal of trade mark from Register for non-use) to international applications filed through the Madrid Protocol.

Subregulation 17A.48D(2) clarifies how specific provisions in Part 9 of the Trade Marks Act and Regulations should be read in order to apply to international applications. New paragraph 17A.48D(2)(h) provides that a reference to ‘the date the particulars of the trade mark were entered into the Register under section 69’ should be taken to be a reference to ‘the date the trade mark became a protected international trade mark under regulation 17A.36’. These two dates are equivalent for the purposes of applying Part 9 of the Trade Marks Act and Regulations to international trade marks. This amendment will ensure the period for filing a non-use application is the same for domestic and international trade mark applications.

Part 3—Innovation patents

Patents Regulations 1991

Item 6: At the end of subregulation 3.2B(1)

[reg 3.2B]

This item amends subregulation 3.2B(1) as a consequence of the amendment to section 52 of the Patents Act in Part 4 of Schedule 1 to the Amendment Bill.

Regulation 3.2B prescribes the details and procedures for the formalities check of innovation patent applications. Subregulation 3.2B(1) sets out the criteria that the application must meet in order to pass the formalities check. Part 4 of Schedule 1 to the Amendment Bill added a new criterion to the formalities check by inserting subsection 52(3) into the Patents Act. Accordingly, this item adds new paragraph 3.2B(1)(i) to include a reference to this new requirement in subsection 52(3) of the Patents Act.

Item 7: Subregulation 3.2B(2)

This item makes a consequential amendment to subregulation 3.2B(2) as a result of the addition of paragraph 3.2B(1)(i) by item 6.

Item 8: At the end of regulation 10.2B

This item adds a new provision to regulation 10.2B to prevent the conversion of a standard patent application into an innovation patent application in certain circumstances.

Part 4 of Schedule 1 to the Amendment Bill includes amendments to commence the abolition of the innovation patent by preventing any new applications from being filed after that Part of the Bill commences. Following the commencement of those amendments, the only innovation patent applications that can be progressed are those that would have a date of patent, as determined under section 65 of the Patents Act, that is earlier than the commencement date.

One way that an innovation patent application can be made is by amending an existing standard patent application to convert it to an innovation patent application. Regulation 10.2B prescribes the amendments of a patent request that are not allowable for the purposes of subsection 102(2D) of the Patents Act. This item amends regulation 10.2B to provide that an amendment that would convert a standard patent application to an innovation patent application is not allowable if the date of the patent for that application would be on or after the commencement date of this regulation. The commencement date of this regulation will be the same as the commencement date of Part 4 of Schedule 1 to the Amendment Bill.

Part 4—Notification of extension of standard patents relating to pharmaceutical substances

Patents Regulations 1991

Item 9: Regulation 22.10AC

[reg 22.10AC]

This item amends regulation 22.10AC as a consequence of the repeal of section 76A of the Patents Act by the Amendment Bill. Regulation 22.10AC prescribes acts for the purposes of subsection 222A(7) of the Patents Act and paragraph 22.10AC(a) includes 'lodging a return under section 76A' as a prescribed act. Item 9 repeals and replaces regulation 22.10AC with a new provision that does not include reference to section 76A.

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Schedule 2—Other Measures

Part 1—Extensions of time

This Part amends the Trade Marks Regulations to prescribe matters for extensions of time for filing notices of intention to defend. This ensures that extensions of time are granted promptly when they are warranted, taking the public interest into account.

Trade Marks Regulations 1995

Items 1, 3, 5 and 7: Extensions for filing a notice of intention to defend

[regs 5.13A, 5.13B, 9.15A, 9.15B, 17A.34HA, 17A.34HB, 17A.48QA, 17A.48QB]

Section 52A of the Trade Marks Act provides that if a notice of opposition is filed, in accordance with section 52 of the Trade Marks Act, an applicant may file a notice of intention to defend.

Item 1 inserts new regulations 5.13A and 5.13B which set out how and when an application for an extension of time to file a notice of intention to defend ('the extension application') must be filed and under what circumstances the Registrar may grant the extension application.

New subregulation 5.13A(1) enables a person to apply for an extension application for filing a notice of intention to defend under subsection 52A(1).

New subregulation 5.13A(2) provides the extension application must be made within three months from when the applicant was given a copy of the statement of grounds and particulars.

New subregulation 5.13A(3) provides that the extension application must be in the approved form and be accompanied by a declaration stating the relevant facts and circumstances.

New subregulation 5.13A(4) provides the limited grounds on which an extension may be sought. An applicant can only seek an extension on either or both of the following grounds: if an error or omission was made by the applicant (or their agent), the Registrar or an employee; or, if there were circumstances beyond the control of the person.

New subregulation 5.13B(1) allows the Registrar some discretion to refuse or grant an extension application under new subregulation 5.13A(1)— the Registrar may only grant the application if satisfied that it is justified.

New subregulation 5.13B(2) provides that the Registrar can only grant an extension application that is filed after the period provided in subregulation 5.13(1), i.e. one month after the applicant received the statement of grounds and particulars, if the Registrar is satisfied there is sufficient reason for the delay in making the application.

New subregulation 5.13B(3) requires the Registrar to decide the length of the extended period for filing a notice of intention to defend according to what is reasonable in the circumstances. These amendments ensure that later extension applications are granted only when they are warranted.

Item 3 inserts corresponding provisions (new regulations 9.15A and 9.15B) to prescribe matters relating to extension of time applications for filing the notice of intention to defend if there is an application to remove a trade mark from the Register for non-use.

Item 5 inserts corresponding provisions (new regulations 17A.34HA and 17A.34HB) to prescribe matters relating to extension of time applications for filing the notice of intention to defend when a person opposes the extension of protection to Australia from an international registration of a trade mark.

Item 7 inserts corresponding provisions (new regulations 17A.48QA and 17A.48QB) to prescribe matters relating to extension of time applications for filing the notice of intention to defend when a person applies for cessation of protection of a protected international trade mark for non-use.

Items 2, 4 and 6: References to extension of time

[regs 9.15, 17A.34H, 17A.48Q]

These items amend subregulations 9.15(3), 17A.34H(4) and 17A.48Q(3) to clarify that the period for filing the notice of intention to defend can be extended.

Items 8, 9 and 10: Prescribed acts and documents for extensions of time

[reg 21.28]

Item 8 amends subregulation 21.28(1) to replace an incorrect reference to regulation 17.48P with a reference to regulation 17.48R.

Items 9 and 10 amend subregulation 21.28(2) to include a notice of intention to defend as a prescribed document.

Items 11 to 14: Fees for Extension Applications

[sch 9, Item 6]

Items 11 to 14 amend item 6 in the fee table under Schedule 9 to include references to the new regulations related to extension applications for filing a notice of intention to defend (regulations 5.13A, 9.15A, 17A.34HA and 17A.48QA).

Part 2—Written requirements

This Part amends the Regulations to:

- remove requirements for giving notice in writing, as a consequence of amendments to the Acts which provide for notification by any means of communication; and
- require the Registrar of Trade Marks to publish the fact of withdrawal of an application, notice or request in the Official Journal.

The amendments will provide greater flexibility for IP Australia when communicating with customers (for example by allowing electronic communication).

Designs Regulations 2004

Item 15: Notice – minimum filing requirements

[reg 3.03]

This item repeals regulation 3.03 as it is no longer required. Regulation 3.03 prescribes how a notice under section 24 of the Designs Act may be sent and the content of the notice. However, the requirement of giving written notice in section 24 of the Designs Act has been replaced by simply notifying the applicant. The information the ‘notification’ should contain is already provided by new subsections 24(2) and (3) of the Designs Act.

Items 16 to 33: Notification

[regs 3.14, 4.04, 4.05, 5.03, 5.04, 9.03, 9.05, 10.02, 11.03, 11.23, 11.28]

Items 19, 29, 32 and 33 amend subregulations 5.03(2), 9.05(3), 11.23(2) and regulation 11.28 to replace ‘give notice’ with ‘notify’ or ‘notification’.

Notifications must be given in accordance with section 144D of the Designs Act (as introduced by the Amendment Bill). This provides that notification can be provided by any means of communication, including electronically.

Item 26 amends subparagraph 5.04(b)(ii) to substitute ‘written notice’ with ‘a notification’ and item 23 amends subsection 5.03(8) to substitute ‘send a copy of the notice’ with ‘give a copy of the notification’. These are consequential amendments as the requirement that the Registrar must ‘give written notice’ has been replaced by the requirement to ‘notify’ in regulations 5.03 and 5.04 as per the amendments to subsection 66(2) of the Designs Act in the Amendment Bill.

The remaining items that amend the Designs Regulations in this Part replace the term ‘notice’ with the more general term ‘notification’. This is consistent with the changes made to the Designs Act in Part 2 of Schedule 2 to the Amendment Bill to give IP Australia more flexibility in communication means into the future.

Patents Regulations 1991

Items 34 to 37, 46, 47, 53 and 56: Notify

[regs 3.2A, 3.2B, 3.2C, 3.4, 3.5A, 3.24, 3.25H, 9.1, 9A.1]

These items substitute the terms ‘tell’, ‘advise’ and ‘inform’ with ‘notify’, to use more modern and

consistent drafting language.

Item 54 also amends subregulation 3.25H(1) to remove the requirement for a notice to be given 'in writing' when the Commissioner informs relevant persons about his or her decision on a certification request for micro-organisms. The Commissioner may instead 'notify' the relevant persons (by any means of communication including electronically) in accordance with section 220A of the Patents Act (as inserted by the Amendment Bill).

Items 38 to 45, 57 and 58: Notification

[regs 3.5, 3.5A, 9A.4, 13.4]

Items 38 and 42 remove the requirement for the Commissioner to give the applicant notice 'in writing' about missing information in a filing. Items 57 and 58 remove the requirement for the Commissioner to notify the applicant 'in writing' of matters in relation to a hearing on an innovation patent. In these cases the Commissioner is now required to do so by 'notifying the applicant'. Notification is to be given in accordance with the Patents Act. This is consistent with the changes made to the Patents Act in Part 2 of Schedule 2 to the Amendment Bill to give IP Australia more flexibility in communication means into the future.

The remaining items are consequential amendments as a result of items 38 and 42.

Items 48 to 52: Notify

[regs 3.24, 3.25]

Items 48 and 50 remove the requirement for the Commissioner to give relevant persons a notice 'in writing' about certain decisions in respect of micro-organism samples. Instead, the Commissioner may 'notify' or 'invite' relevant persons (by any means of communication, including electronic).

Items 49, 51 and 52 make consequential amendments as a result of 'notice' being replaced with 'notification'.

Plant Breeder's Rights Regulations 1994

Items 59 and 60: Notify

[regs 3A, 5]

These items remove the requirement for the Registrar to give notices about certain decisions to relevant persons in 'written' form. The Registrar may simply 'notify' relevant persons instead. Notifications may be given by any means of communication (including by electronic means) as provided by section 72A of the Plant Breeder's Rights Act (as inserted by the Amendment Bill). This is consistent with the changes in the Plant Breeder's Rights Act to give IP Australia more flexibility in communication means into the future.

Trade Marks Regulations 1995

Items 67 to 78, 87, 88, 90, 105 and 107 to 110: Notify

[regs 4.2, 4.3, 4.8, 4.10, 4.11, 4.13, 4.14, 4.18, 6.1, 6.4, 10.4, 10.5, 11.3, 17A.18, 17A.19, 17A.21, 17A.22, 17A.25, 17A.59, 21.9, 21.16, 21.33]

These items remove the requirement for the Registrar to give a notice to relevant persons about certain decisions or events in written form. The Registrar may 'notify' the relevant persons instead, by any means of communication (including by electronic means), as provided by section 214A of the Trade Marks Act (as

inserted by the Amendment Bill). This is consistent with the changes in the Trade Marks Act to give IP Australia more flexibility in communication means into the future.

Consequently all occurrences of 'notice' are replaced by 'notification' and all requirements for notifications to be in writing have been omitted.

Items 79 to 85 and 89: Notification

[regs 7.5, 7.7, 7.8, 8.1, 10.5]

These items make consequential amendments as a result of 'notice' being replaced by 'notification' in the Trade Marks Act.

Item 86: Repeal notice requirements

[reg 8.1A]

This item repeals a redundant regulation because the provisions are set out in subsection 84A(4) of the Trade Marks Act as amended by the Amendment Bill.

Item 106: Notification of withdrawal of application etc.

[reg 21.10]

This item replaces regulation 21.10 because the current regulation is unclear about who must be informed about a withdrawal of an application, notice or request. The amendment addresses this by inserting a requirement to publish the fact of the withdrawal in the Official Journal. This also has the benefit of aligning with the publication requirements for the other IP rights for withdrawals.

Part 3—Filing requirements

This Part amends the Regulations to:

- outline the consequences for providing information to IP Australia when the information does not comply with a direction; and
- make consequential amendments due to amendments in the Plant Breeder's Rights Act regarding the filing of documents and payment of fees.

The amendments will align the processes across the Regulations.

Designs Regulations 2004

Items 111 to 113 and 117 to 119: Repeal of unnecessary provisions relating to document or evidence filing and the payment of fees

[regs 1.04, 5.08, 11.25]

Under the Amendment Bill, the Designs Act will be amended such that the Registrar may direct, by published determination or direction, how documents or evidence can be filed and fees are paid. These amendments will cover all forms of document or evidence filing and fee payment. As a result, these items amend the Designs Regulations by repealing provisions relating to the means or form by which documents or evidence can be filed and fees paid.

These items also make consequential amendments as a result of the repealed provisions to retitle the corresponding regulations appropriately.

Items 114 to 116: Publication of notices in the Official Journal

[regs 11.01, 11.18, 11.18A]

These items amend the Designs Regulations as a consequence of the introduction of sections 130A, 144A, 144B and 144C into the Designs Act by the Amendment Bill. These sections of the Designs Act require the Registrar, after determining the means of filing fees or the providing a direction as to the filing of documents or evidence, to publish a notice of his or her determination or direction in accordance with the regulations.

Consequently, items 114 to 116 introduce the requirement that publication must be in the Official Journal.

Items 120 and 121: Non-compliance in relation to form of filing of documents

[reg 11.27]

These items amend the Designs Regulations as a consequence of the introduction of section 144B of the Designs Act by the Amendment Bill. Section 144B allows the Registrar to direct the form in which documents are to be filed, but does not specify any consequences if the documents are not in the specified form.

These items amend regulation 11.27, which provides the consequences of filing documents in a non-compliant form. The amendments specify that documents must, in addition to substantially complying with Schedule 2, be filed in accordance with a direction of the Registrar under section 144B of the Designs Act (if any). Documents that do not comply with filing requirements may be treated as never having been filed.

Item 122: Non-compliance with Registrar's direction in relation to the filing of evidence

[reg 11.27A]

This item amends the Designs Regulations as a consequence of the introduction of section 144C of the Designs Act by the Amendment Bill. Section 144C allows the Registrar to direct the number of copies of evidence to be filed and the form and means by which evidence is to be filed, but does not specify any consequence if the evidence does not comply with the Registrar's directions.

This item introduces new regulation 11.27A, which provides a consequence for filing evidence that is not compliant with the Registrar's direction under the new section 144C of the Designs Act. It provides that the Registrar may treat non-compliant evidence as not having been filed, or may direct the person filing the evidence to correct the non-compliance.

Item 123: Consequential amendments

[sch 4, items 1, 2 and 5]

This item amends Schedule 4 to the Designs Regulations to replace references to 'approved means' with references to 'preferred means'. These amendments are a consequence of the repeal of the definition of 'approved means' by item 111 of this Part and the inclusion of the new definition of 'preferred means' in the Designs Act by the Amending Bill.

Patents Regulations 1991

Items 124 to 132 and 136: Repeal of unnecessary provisions relating to document or evidence filing and the payment of fees

[regs 1.3, 5.3, 22.1, 22.2AA, 22.12, 22.16]

Part 3 of Schedule 2 to the Amendment Bill amends the Patents Act to enable the Commissioner to direct, by published determination or direction, how documents or evidence can be filed and fees paid. These amendments will cover all forms of document or evidence filing and fee payment. As a result, these items amend the Patents Regulations by repealing the provisions relating to the means or form by which documents or evidence can be filed and fees paid.

These items also retitle the corresponding regulations appropriately. In addition, item 131 repeals subregulation 22.12(1) and item 132 amends subregulation 22.12(2) as a consequence of the introduction of section 214C into the Patents Act by the Amendment Bill.

Items 133 to 135: Non-compliance in relation to form of filing of documents

[regs 22.15, 22.16]

These items amend the Patents Regulations as a consequence of the introduction of section 214B of the Patents Act by the Amendment Bill. Section 214B allows the Commissioner to direct the form in which documents may be filed, but does not specify any consequences if the documents are not in the specified form.

Item 134 amends regulation 22.15 which deals with the requirements for the filing of documents. The amendments provide that the English language documents must be in the form specified in a direction under section 214B of Patents Act (if any).

Items 133 and 135 make amendments to the title of regulations 22.15 and 22.16 to make it clear that the

regulations deal with requirements for filing documents (regulation 22.15) and the consequence of documents not meeting filing requirements (regulation 22.16). Documents that do not comply with filing requirements may be treated as never having been filed.

Item 137: Non-compliance with Commissioner's direction in relation to the filing of evidence

[reg 22.16A]

This item amends the Patents Regulations as a consequence of the introduction of section 214C of the Patents Act by the Amendment Bill. Section 214C allows the Commissioner to direct the number of copies of evidence to be filed and the form and means by which evidence is to be filed, but does not specify any consequence if the evidence does not comply with the Commissioner's directions.

This item introduces new regulation 22.16A which provides a consequence for filing evidence that is not compliant with the Commissioner's direction under the new section 214C of the Patents Act. It provides that the Commissioner may treat non-compliant evidence as not having been filed, or may direct the person filing the evidence to correct the non-compliance.

Item 138: Consequential amendments

[sch 7, items 201, 202, 203, 211, 212, 214A]

This item replaces references to 'approved means' in Schedule 7 to the Patents Regulations with references to 'preferred means'. These amendments are a consequence of the repeal of the definition of 'approved means' by item 124 of this Part and the inclusion of the new definition of 'preferred means' in the Patents Act by the Amending Bill.

Plant Breeder's Rights Regulations 1994

Items 139 and 140: Repeal of unnecessary definition and provision relating to actions

[regs 3, 4A]

Part 3 of Schedule 2 to the Amendment Bill amends the Plant Breeder's Rights Act to enable the Registrar to make a determination as to how documents can be filed or fees paid. As a result, these items amend the Plant Breeder's Rights Regulations by repealing provisions relating to the 'approved means' of doing an action listed in Schedule 1, such as the payment of fees or the filing of documents.

Item 141: Consequential amendments

[sch 1, item 4]

This item replaces references to 'approved means' in Schedule 1 to the Plant Breeder's Rights Regulations with references to 'preferred means'. These amendments are a consequence of the repeal of the definition of 'approved means' by item 139 of this Part and the inclusion of the new definition of 'preferred means' in the Plant Breeder's Rights Act by the Amending Bill.

Trade Marks Regulations 1995

Items 142, 143, 148, 152, 154 and 156: Repeal of unnecessary provisions relating to document or evidence filing and the payment of fees

[regs 2.1, 5.3, 9.3, 17A.30, 17A.48A, 21.17, 21.18, 21.21AA, 21.22, sch 7]

Part 3 of Schedule 2 to the Amendment Bill amends the Trade Marks Act to enable the Registrar to direct, by published determination or direction, how documents or evidence can be filed and fees paid. These amendments will cover all forms of document or evidence filing and fee payment. As a result, these items amend the Trade Marks Regulations by repealing provisions relating to the means or form by which documents or evidence can be filed and fees are paid.

These items also retitle or renumber the corresponding regulations appropriately. In addition, item 149 repeals subregulation 21.17(1) and item 150 amends subregulation 21.17(2) as a consequence of the introduction of section 213C into the Trade Marks Act by the Amendment Bill.

Item 144: Requirements for filing documents

[reg 21.2]

This item amends regulation 21.2, which requires that documents filed with the Trade Marks Office must comply with the requirements of Schedule 7 to the Trade Marks Regulations. Schedule 7 is repealed by item 156 of this Part and the Amendment Bill introduces section 213B into the Trade Marks Act to allow the Registrar to give a direction on the form in which documents may be filed. This item amends regulation 21.2 to specify some minimal filing requirements and require that documents must comply with directions issued by the Registrar under section 213B of the Trade Marks Act (if any).

Item 145: Consequences for documents not meeting filing requirements

[reg 21.4]

This item amends the Trade Marks Regulations as a consequence of the introduction of section 213B of the Trade Marks Act by the Amendment Bill. Section 213B allows the Registrar to direct the form in which documents may be filed, but does not specify any consequence if the documents are not in the specified form.

Item 271 amends regulation 21.4 which deals with the consequences for documents not meeting filing requirements. It provides that the Registrar may treat a non-compliant document as not having been filed or direct the person filing the document to correct the non-compliance.

Item 146: Removal of facsimile as means of document filing

[reg 21.5]

Filing by facsimile has not been an approved means of filing documents with the Registrar since 2014, except in limited circumstances. Currently the Trade Marks Regulations create uncertainty by suggesting that filing by facsimile remains an option. This item removes any ambiguity by removing the reference to 'facsimile' from subregulation 21.5(2).

Item 147: Non-compliance in relation to form of filing of evidence

[reg 21.5A]

This item amends the Trade Marks Regulations as a consequence of the introduction of section 213C of the Trade Marks Act by the Amendment Bill. Section 213C allows the Registrar to direct the form and means by which evidence may be filed, but does not specify any consequence if the evidence does not meet the filing requirements.

Item 147 introduces new regulation 21.5A which deals with the consequences of filing evidence that does not comply with the Registrar's direction. It provides that the Registrar may treat non-compliant evidence as not having been filed, or may direct the person filing the evidence to correct the non-compliance.

Item 153: Consequential amendment

[reg 21.22]

This item adds a note to regulation 21.22 to direct the reader to the relevant subsections of the Trade Marks Act for details on how fees are to be paid to the Registrar.

Item 157: Consequential amendments

[Sch 9, items 1, 3 and 10]

This item replaces the references to 'approved means' in Schedule 9 to the Trade Marks Regulations with references to 'preferred means'. These amendments are a consequence of the repeal of the definition of 'approved means' by item 142 of this Part and the inclusion of the new definition of 'preferred means' in the Trade Marks Act by the Amending Bill.

DRAFT

Part 4—Protection resulting from the international registration of a trade mark

This Part amends the Trade Marks Regulations to replace a number of incorrect references that relate to international registrations designating Australia (IRDAs).

Trade Marks Regulations 1995

Items 158 to 184: References to IRDAs

[regs 4.13, 4.14, 17A.21, 17A.22, 17A.25, 17A.36, 17A.39, 17A.42A, 17A.45, 17A.73, 17A.74]

These items correct a number of references to regulations that relate to IRDAs. In addition to updating references, items 165, 166, 167, 174, 175, 177, 178, 180 and 182 make some changes to the language of the regulations to clarify the meaning. The effects of the provisions are unchanged.

DRAFT

Part 5—Signatures

This Part amends the Patents Regulations to remove the requirements for signing certain documents.

The amendments will streamline processes and will remove an unnecessary burden on applicants, patentees and opponents.

Patents Regulations 1991

Item 185: Request for patent of addition

[reg 3.1]

This item amends paragraph 3.1(2)(g) to remove the need for patent applicants or patentees to sign the filed statement authorising another person to request a patent of addition.

Currently, if a request for a patent of addition is made by a person other than the applicant or patentee, then a statement authorising that person to make the request must be signed by the applicant or patentee and filed before acceptance. However, the requirement for a signature is unnecessary as the identity and authority of the person in question can be confirmed from other information in the documentation, and so places an undue burden on applicants for a patent of addition.

Item 377: Withdrawal of opposition

[reg 5.26]

This item amends subregulation 5.26(1) by removing the need for an opponent wishing to withdraw an opposition to sign the notice of withdrawal.

The requirement for a signature is unnecessary and places an undue burden on opponents.

Part 6—Addresses and service of documents

This Part amends the Patents, Trade Marks and Designs Regulations to:

- repeal provisions that provide for addresses for correspondence, as this can be handled by means of approved forms; and
- remove requirements for serving or filing documents that are inconsistent with changes introduced by the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

These amendments will clarify and simplify the processes, remove inconsistencies and improve efficiency.

Designs Regulations 2004

Item 187: Service of documents

[reg 11.19]

This item amends regulation 11.19 to repeal requirements to serve and file copies of notices and documents with other opposition parties or the Registrar. Subregulations 11.19(3) and (4) are no longer necessary as a consequence of amendments made regarding the service of opposition documents by the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*, which removed the requirements for parties to serve documents on each other.

Item 188: Address for correspondence

[reg 11.20]

This item repeals regulation 11.20 to remove the requirements for an address for correspondence. The address information required to contact applicants will be required by the approved form. This amendment simplifies the address requirements in the legislation.

Patents Regulations 1991

Item 189: Address for service

[reg 22.10]

This item repeals subregulation 22.10(4) to remove the requirement to file copies of notices and documents with the Commissioner. These requirements are no longer necessary as a consequence of amendments made regarding the service of opposition documents by the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

Item 381: Address for correspondence

[reg 22.10A]

This item repeals regulation 22.10A to remove the requirement for an address for correspondence. The address information required to contact applicants will be required by the approved form. This amendment simplifies the address requirements in the legislation.

Trade Marks Regulations 1995

Item 191: Service of documents

[reg 8.4]

This item amends subregulation 8.4(3) to establish that it is the responsibility of the Registrar to give a copy of the opposition notice to the registered owner of the trade mark. This is consistent with the changes made regarding service of documents by the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

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Part 7—Requirements for patent documents

This Part amends the Patents Regulations to:

- move existing formality requirements for patent documents from the Patents Regulations into the Patents Act and to provide the Commissioner with a new instrument-making power for determining further formality requirements; and
- enable patent specifications to use graphics and/or photographs to describe inventions.

The amendments allow applicants to use colour drawings at a future date to enable applicants to better describe their inventions and will ensure the legislation aligns with Australia’s international obligations.

Patent Regulations 1991

Item 192: Provisional application—direction to meet formalities requirements

[reg 3.2]

The Amendment Bill has consolidated all requirements for patent applications and specifications in section 29 of the Patents Act. It also enables the Commissioner to prescribe the formalities requirements for a patent request in relation to complete applications and specifications in a (non-legislative) instrument made under new section 229 of the Patents Act, rather than being set out in Schedule 3 to the Patents Regulations.

As a consequence, regulation 3.2 has been amended by this item to remove requirements for provisional specifications, which are now covered by the reference to subsection 29(4) of the Patents Act. It also renames the regulation to reflect its changed purpose.

Items 193 to 196: Complete application for standard patent—direction to meet formalities requirements

[reg 3.2A]

These items amend regulation 3.2A in light of the repeal of Schedule 3 to the Patents Regulations, consolidation of all requirements for patent applications and specifications in section 29 of the Patents Act and the introduction of section 229 to the Patents Act by the Amendment Bill.

Item 193 substitutes a new heading to reflect the changed purpose of regulation 3.2A. Item 194 replaces subregulations 3.2A(1) to (3) with new subregulations 3.2A(1) and (2). This removes the formalities requirements, which are now provided for in new subsections 29(4A) and (4B) of the Patents Act, and introduces references to the requirements of those new subsections.

Items 195 and 196 make consequential changes to references in regulation 3.2A due to the repeal of subregulation 3.2A(3).

Subclauses 11(1) to 11(18) in Schedule 3 to the Patent Regulations currently set out the formal requirements for drawings in patent specifications. One of these requirements is that the drawings are to be in black and white rather than colour. Colour drawings and photographs are better able to convey information in certain situations and the cost and reliability of colour imaging has improved. Recognising this, the International Patent Cooperation Union (PCT Union) intends to amend the Regulations under the Patent Cooperation Treaty (PCT Regulations) to allow colour drawings to be filed in international

applications. It is not certain when the PCT Regulations will be changed and what the exact requirements will be. The amended regulations will provide greater flexibility to allow for colour drawings at a future date, in a manner consistent with Australia's international obligations.

Item 197: Specifications—formalities check for innovation patents

[reg 3.2B]

Regulation 3.2B concerns the formalities requirements for innovation patents. As a consequence of the consolidation of the formalities requirements in section 29 of the Patents Act by the amendments in Schedule 2 to the Amendment Bill, item 197 replaces two paragraphs of subregulation 3.2B(1) to remove requirements from the regulation and instead reference new subsections 29(4A) and 29(4B) of the Patents Act.

Items 198 to 201: Specifications—formalities check for PCT applications

[reg 3.2C]

These items amend regulation 3.2C regarding the requirements for PCT patent documents, as a consequence of the changes to the formality requirements in the Patents Act.

Item 198 clarifies the wording of subregulation 3.2C(1) without changing its effect. Item 199 amends subregulation 3.2C(3) to provide that the PCT application must comply with the formalities requirements set out in an instrument under new section 229 instead of in Schedule 3 to the Patents Regulations. Items 200 and 201 amend subregulation 3.2C(4) to clarify the wording without changing its effect.

Items 202 to 206: Consequential amendments

[regs 3.3, 3.5, 3.5AC]

These items amend regulations 3.3, 3.5 and 3.5AC, following changes made to the Patents Act by Part 7 of Schedule 2 to the Amendment Bill to allow specifications to include graphics and photographs.

Items 207 and 208: PCT applications—prescribed requirements

[reg 3.5AD]

The Amendment Bill has consolidated all requirements for patent applications and specifications in section 29 of the Patents Act. The requirements for complete applications and specifications—formerly at section 29(4)—will now be set out in new subsections 29(4A) and (4B).

Regulation 3.5AD sets out the relevant prescribed requirements for PCT applications. Item 207 amends paragraph 3.5AD(a) to delete a reference to subsection 29(4) and replace it with references to new subsections 29(4A) and (4B). Item 208 removes paragraphs (c) and (d) in regulation 3.5AD. The requirements formerly set out in those paragraphs are now covered in new subsections 29(4A) and (4B) of the Patents Act.

This amendment ensures that PCT applications that enter the national phase in Australia will be required to meet the same formality requirements as non-PCT applications.

Item 209: Report of Commissioner—examination

[reg 3.18]

This item amends regulation 3.18 as a consequence of changes made to subregulation 3.2C(3) by item 199. Regulation 3.18 prescribes those matters that the Commissioner must address in a patent report, in addition to those listed in subsection 45(1) of the Patents Act. This item amends paragraph 3.18(2)(f) to prescribe that the Commissioner must report on whether, to the best of his or her knowledge, the requirements of subregulations 3.2C(2) and (3) have been met in respect of a PCT application.

Item 210: Notice that specification is open to public inspection

[reg 4.2]

This item amends paragraph 4.2(2)(c) to omit the reference to subregulation 3.2A(2) and substitute it with new subregulation 3.2A(1), as a consequence of changes made by item 194.

Item 211: Form of amendments

[reg 10.1]

This item repeals subregulation 10.1(2) to remove the requirement for an applicant or patentee to file two copies of documents (or parts of documents) in instances where amendments have been requested by means of substituting a document or part of a document.

Item 212: Form of amendments

[reg 10.2]

This item repeals paragraph 10.2(1)(a) to remove the reference to compliance with Schedule 3 to the Patents Regulations and replaces it with a reference to the formalities requirements as determined in an instrument made under new section 229 of the Patents Act.

Item 213: Documents other than specifications and abstracts

[reg 22.16]

This item removes the reference in subregulation 22.16(2) to a document not substantially complying with Schedule 3 to the Patents Regulations, and replaces this with a reference to the formalities requirements as determined in an instrument under new section 229 of the Patents Act.

Item 214: Schedule 3—Formal requirements for documents to be filed

[sch 3]

This item repeals Schedule 3 to the Patents Regulations, in line with the changes to the Patents Act that move patent formality requirement provisions from the Patents Regulations to the Patents Act.

Part 8—Acceptance of trade mark applications

This Part amends the Trade Marks Regulations to allow applicants that are granted an extension of time for acceptance of a trade mark to also submit a request for deferral during that extended period.

Items 215 and 216: Time period for requesting deferment of acceptance

[regs 4.13 and 17A.21]

These items amend paragraphs 4.13(1)(a) and 17A.21(1)(a) so if an applicant is granted an extension of time for the acceptance of a trade mark, the applicant will also be able to submit a request for deferral during that extended period.

This is not presently possible, as paragraphs 4.13(1)(a) and 17A.21(1)(a) limit requests for deferral to the period prescribed in subregulations 4.12(1) and 17A.20(1), respectively.

As a result, requests for deferment may become due before the end of the acceptance period. This can cause confusion for applicants and third parties, as the status of a deferment application can become unclear. It can also result in additional administrative costs, as applicants may file speculative requests for deferment without knowing whether their extension of time under section 224 of the Trade Marks Act will be accepted, or may have to file two requests under section 224 (one to extend the time for acceptance, and another to extend the time to request deferment).

These items address this problem by aligning the period in which deferment must be requested with the acceptance period, whether or not the acceptance period has been extended under regulation 4.12 or 17A.20 or section 224 of the Trade Marks Act.

Part 9—Copies of design representations

This Part amends the Designs Regulations to replace the outdated requirement to file five copies of each design in an application because design applications are now filed electronically or scanned upon receipt.

Designs Regulations 2004

Items 217 and 218: Multiple copies of design representations

[regs 4.04, 4.05]

These items amend paragraphs 4.04(1)(f) and 4.05(1)(f) of the Designs Regulations to require at least one of each representation of the design be included in a design application, as opposed to five.

When filing a design application for registration an application must undergo formalities check, the requirements for which are set out in regulations 4.04 and 4.05. One of the requirements of the formalities check is that a design application includes five copies of each representation.

This requirement was useful when applications were filed on paper and quality of representations was lost through reproduction. However, design applications are now filed electronically or scanned upon receipt, and as such, multiple copies of representations are no longer necessary.

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Part 10—Amendment of registered trade mark due to inconsistency with international agreements

This Part amends the Trade Marks Regulations to:

- reinstate procedures for conducting an opposition to amendments made to a registered trade mark to overcome an inconsistency with international agreements; and
- include a small number of references that were inadvertently missed in the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* relating to trade mark oppositions.

Trade Marks Regulations 1995

Item 219: Amendment due to inconsistency with international agreements – opposition proceedings

[regs 8.5, 8.6, 8.7, 8.8]

Under section 83A of the Trade Marks Act, the owners of registered trade marks may request amendments to their trade marks on a number of specified grounds. One of the grounds for requesting an amendment is in circumstances where using the trade mark would be inconsistent with an obligation of Australia under an international agreement. Where Australia agrees to new international obligations, the owners of previously registered marks that would be affected by the new obligations can request amendments to remove the inconsistency.

The Trade Marks Act allows other persons to oppose amendments on certain grounds. Subsection 83A(4) of the Trade Marks Act enables any person to oppose the granting of an amendment of a registered trade mark due to inconsistency with international agreements, on the ground that the resulting trade mark would be too similar to a trade mark registered being used by the person for the same type of goods or services.

Regulation 8.5 of the Trade Marks Regulations is intended to set out the process for this type of opposition. However, due to a drafting error in the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*, regulation 8.5 still refers to regulations 5.7 to 5.17 which were amended so that they only apply to ordinary trade mark oppositions.

This item repeals regulation 8.5 and substitutes it with new regulations 8.5, 8.6 and 8.7.

New regulation 8.5 provides that the Registrar may decide the opposition procedures and give directions to the registered owner who made the request for amendment, and the opponent.

New regulation 8.6 provides the procedures for conducting a hearing of the opposition under subsection 83A(4) of the Trade Marks Act, which are similar to those of regulation 6.9. Subregulation 8.6(1) provides that the Registrar must hold a hearing on request in writing by either the registered owner or an opponent. Subregulation 8.6(2) provides that, at the Registrar's discretion, the hearing may be oral or by written submissions. Subregulations 8.6(3) to (5) set out requirements for the Registrar and the relevant parties for an oral hearing, and the consequences of failing to meet the requirements. Subregulation 8.6(6) provides that regulations 21.15 and 21.16, which relate to general hearing procedures, do not apply to oppositions under subsection 83A(4) of the Trade Marks Act.

New regulation 8.7 provides that the Registrar may give a direction in relation to an opposition under

subsection 83A(4) of the Trade Marks Act. Subregulation 8.7(1) provides that the Registrar may give a direction on his or her own initiative, or when requested in writing by either the registered owner or an opponent.

Subregulations 8.7(2) to (4) set out the requirements that the Registrar must comply with if he or she gives a direction, these include: giving the relevant parties an opportunity to make representations about the direction; requiring that the direction must be consistent with the Trade Marks Act or Trade Marks Regulations; and notifying relevant parties of the direction as soon as practicable. These provisions are very similar to those of existing regulations 5.19, 6.10, 9.21, 17A.34Q, 17A.48W and 21.20F relating to other types of oppositions.

New regulation 8.8 provides that the Registrar must notify the relevant parties where an opposition under section 222 of the Trade Marks Act is dismissed or discontinued because security for the costs of the proceeding is not given by an opponent who neither resides nor carries on business in Australia.

Item 220: Conduct of proceedings

[reg 21.14]

This item amends the note in regulation 21.14 to list all the provisions that govern the Registrar's power to direct parties for the different types of oppositions.

Item 221: Award of costs

[sch 8, Part 1, items 5 and 6]

This item amends Part 1 of Schedule 8 to the Trade Marks Regulations to provide that costs could be awarded for the time spent preparing and perusing notices of opposition filed under subregulation 8.4(1). This reference was inadvertently not included in the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

Item 222: Fees for filing notices of opposition

[sch 9, item 8]

This item includes a reference to section 83A of the Trade Marks Act in Schedule 9 to the Trade Marks Regulations to provide that there is a fee for filing a notice of opposition under section 83A. This was inadvertently not included in the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

Part 11—Secretary’s role in the Plant Breeder’s Rights Regulations

This Part amends the Plant Breeder’s Rights Regulations to transfer the powers, functions and obligations of the Secretary of the Department of Industry, Innovation and Science to the Registrar to reflect existing practice.

Plant Breeder’s Rights Regulations 1994

Items 223 to 229: Transfer of Secretary’s powers and obligations to the Registrar

[regs 3A, 3D, 5]

These items amend regulations 3A, 3D and 5 of the Plant Breeder’s Rights Regulations to transfer the powers, functions and obligations of the Secretary of the Department of Industry, Innovation and Science to the Registrar.

The Amendment Bill transfers the powers, functions and obligations of the Secretary in the Plant Breeder’s Rights Act to the Registrar. In practice the Secretary’s powers are all delegated to the Registrar, so it is appropriate that the Registrar has such powers under the legislation. The equivalent powers, functions and obligations for the other IP rights all reside with Commissioner of Patents or the Registrars of Designs and Trade Marks.

These amendments omit and repeal references to the ‘Secretary’ and, where appropriate, substitute the ‘Registrar’ in order to transfer the Secretary’s powers, functions and obligations to the Registrar.

Item 226 repeals regulation 3D in its entirety because it is no longer needed. It does not need to be replaced as regulation 3B already provides for the same matters in relation to the Registrar, namely it prescribes who the Registrar may delegate his or her functions to.

These amendments better align with the changes to the Plant Breeder’s Rights Act, with the other IP rights legislation, better reflect actual practice, and improve transparency.

Part 12—Other amendments

This Part repeals the definition of Norfolk Island in Part 13 of the Trade Marks Regulations, which relates to the importation of goods infringing Australian trade marks, as the reference is no longer correct.

Trade Marks Regulations 1995

Items 474A – Repeal of definition of Norfolk Island

[reg 13.1A]

The repeal of the definition of Norfolk Island in regulation 13.1A was inadvertently overlooked when Schedule 3 to the Trade Marks Regulations was amended by the *Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016*. These amendments followed changes to the application of the *Customs Act 1901*, *Customs Regulation 2015* and *Customs (International Obligations) Regulation 2015* in Norfolk Island.

Due to the amendment of Schedule 3 the definition of Norfolk Island in 13.1A is incorrect and has been omitted by the Amendment Regulations. Customs seizure provisions relating to Norfolk Island are provided for in Schedule 3 to the Trade Marks Regulations.

Part 13—Application, transitional and saving provisions

This Part amends the Regulations to:

- set out how the amendments in Schedule 2 to the Amendment Regulations will apply in certain circumstances; and
- save the operation of any repealed provisions, as necessary.

This Part will clarify exactly how the transition from the existing legislative scheme to the new legislative scheme will occur. This will include where the amendments affect any IP applications or rights that were applied for or granted/registered under the old legislative scheme, but to which the new legislative scheme will apply after commencement.

Designs Regulations 2004

Items 231 and 232: Application, saving and transitional provisions

[Chapter 12]

These items repeal and substitute the heading for Chapter 12 and insert a new Part 3 in Chapter 12 of the Designs Regulations, which provides for the transitional arrangements for the amendments to the Designs Regulations in Schedule 2 to the Amendment Regulations.

These items provide a breakdown of the transitional arrangements by clarifying the application of the amendments and providing for the saving of any repealed provisions that may be required to operate after commencement.

The transitional arrangements are included to ensure that a person who had undertaken an action, for example submitting an application or providing a notice, under the regulations that were in force directly before commencement is not unfairly disadvantaged or advantaged by the amendment. This is also applicable to parties who undertake an action after commencement. Where necessary to finalise existing applications or other actions, the operation of repealed provisions is saved.

Patents Regulations 1991

Items 233 and 234: Application, saving and transitional provisions

[Chapter 23]

These items repeal and substitute the heading for Chapter 23 and insert a new Part 4 in Chapter 23 in the Patents Regulations, which provides for the transitional arrangements for the amendments to the Patents Regulations in Schedule 2 to the Amendment Regulation.

These items provide a breakdown of the transitional arrangements by clarifying the application of the amendments and providing for the saving of any repealed provisions that may be required to operate after commencement.

The transitional arrangements are included to ensure that a person who had undertaken an action, for example submitting an application or providing a notice, under the regulations that were in force directly before commencement, is not unfairly disadvantaged or advantaged by the amendment. This is also applicable to parties who undertake an action after commencement. Where necessary to finalise existing

applications or other actions, the operation of repealed provisions is saved.

Plant Breeder's Rights Regulations 1994

Item 235: Application, saving and transitional provisions

[reg 6]

This item inserts a new regulation 6, which provides for the transitional arrangements for the amendments to the Plant Breeder's Rights Regulations in Schedule 2 to the Amendment Regulations.

This item provides a breakdown of the transitional arrangements by clarifying the application of the amendments and providing for the saving of any repealed provisions that may be required to operate after commencement.

The transitional arrangements are included to ensure that a person who had undertaken an action, for example, payment of fees, under the regulations that were in force directly before commencement, is not unfairly disadvantaged or advantaged by the amendment. This is also applicable to parties who undertake an action after commencement. Where necessary to finalise existing applications or other actions, the operation of repealed provisions is saved.

Trade Marks Regulations 1995

Items 236 and 237: Application, saving and transitional provisions

[Part 22]

These items repeal and substitute a new heading and insert a new Division 4 in Part 22 of the Trade Marks Regulations, which provides for the transitional arrangements for Schedule 2 to the Amendment Regulation.

These items provide a breakdown of the transitional arrangements by clarifying the application of the amendments and providing for the saving of any repealed provisions that may be required to operate after commencement.

The transitional arrangements are included to ensure that a person who had undertaken an action, for example filing an application or providing a notice, under the regulations that were in force directly before commencement, is not unfairly disadvantaged or advantaged by the amendment. This is also applicable to parties who undertake an action after commencement. Where necessary to finalise existing applications or other actions, the operation of repealed provisions is saved.