

# Trade Marks Regulations 1995 No. 341

## EXPLANATORY STATEMENT

### STATUTORY RULES 1995 No. 341

Issued by the Authority of the Minister for Small Business, Customs and Construction

*Trade Marks Act 1995*

Trade Marks Regulations

Subsection 231 (1) of the *Trade Marks Act 1995* (the Act) (Act No 119, assented to 17 October 1995) allows the Governor-General to make regulations for the purposes of the Act and for the conduct of any business relating to the Trade Marks Office. Amongst other things the Regulations may make transitional or consequential provisions as necessary or convenient because of the repeal of the *Trade Marks Act 1955* (the 1955 Act) and may provide for Regulations made under the 1955 Act to continue for specified purposes of the Act.

The *Trade Marks Act 1994* (the 1994 Act) was enacted on 13 December 1994 to enable Australia to meet its obligations under the Agreement Establishing the World Trade Organization. The 1994 Act, which was to commence on 1 January 1996, was repealed by the Act on 17 October 1995. An exposure draft of proposed Regulations to be made under the 1994 Act was released for public comment on 10 September 1994. The attached Regulations incorporate the comments received on the exposure draft and take into account the differences between the 1994 Act and the Act.

The Regulations prescribe matters required to be prescribed for the purpose of the Act including: signs that may not be registered as trade marks; documents required for various applications, notices or requests; the periods in which various actions must be taken under the Act; the persons to whom part, or all, of the Registrar's powers and functions may be delegated; and, Convention countries.

The Regulations also provide administrative procedures in respect of a range of matters in the Act including: application for registration of a trade mark; opposition to registration of a trade mark; amendment of an application for registration of a trade mark; amendment and cancellation of the registration of a trade mark; removal of a trade mark from the Register for non-use; assignment and transmission of a trade mark; amendment or cancellation of records of claims to interests in, or rights in respect of, a trade mark; importation of goods infringing Australian trade marks; and registration of certification trade marks.

The Regulations also prescribe a new fee structure that is intended to raise no revenue additional to that already planned under the fee structure associated with the 1955 Act. Changes in the levels of fees, plus the inclusion of fees for actions which did not attract a fee under the repealed legislation, lower the current level of cross-subsidisation between fee items.

The Regulations also include transitional provisions for certain actions taken, fees payable, and delegations made under the 1955 Act.

The Regulations commence on 1 January 1996, the day that the Act commences.

The Attachment provides a summary of the contents of the Regulations.

## ATTACHMENT

### **Details of the Trade Marks Regulations**

#### Part 1 - Preliminary

Prescribes the formalities including a regulation that specifies that the Regulations commence on 1 January 1996.

#### Part 2 - Interpretation

Prescribes the definition of certain words and phrases in the Regulations.

#### Part 3 - Trade marks and trade marks rights

Prescribes that goods and services are divided into classes as described by Parts 1 and 2 (respectively) of Schedule 1. In addition, it prescribes the period after which an authorised user of a trade mark may bring an action for an infringement, having asked the registered owner to bring such an action.

#### Part 4 - Application for registration

Prescribes formalities and procedures in relation to preparing and processing an application to the acceptance stage including matters such as claiming priority for an application, publication of particulars of applications, examination procedures, lapsing of applications and deferment of acceptance.

#### Part 5 - Opposition to registration

Prescribes the necessary formalities and practices in relation to opposition proceedings including time allowed for filing notices of opposition, procedures for applying for an extension of time to file a notice of opposition, and the conduct of opposition proceedings.

#### Part 6 - Amendment of application for registration of a trade mark and other documents

Prescribes the procedures by which the Registrar of Trade Marks (the Registrar) may amend an application for a trade mark (whether initiated by the Registrar or by the applicant), and provides for notification of amendments of documents.

#### Part 7 - Registration of trade marks

Prescribes the formalities and procedures in relation to registering a trade mark including the period allowed for registration, particulars to be entered into the Register of Trade Marks and renewing a registration.

#### Part 8 - Amendment and cancellation of registration

Prescribes the procedures in relation to a request by an owner of a registered trade mark to cancel registration of the trade mark and prescribes a number of matters a court must take into account when making a decision on an application for rectification of the Register, if the grounds for rectification have arisen through no fault of the registered owner.

#### Part 9 - Removal of trade mark from Register for non-use

Prescribes the formalities and procedures in relation to an application for the removal of a trade mark from the Register for non-use including details required in applications for removal, the Registrar's obligation to notify all interested persons and to place an advertisement in the *Australian Official Journal of Trade Marks* (Official Journal), and opposition proceedings.

#### Part 10 - Assignment and transmission of trade marks

Prescribes the procedures in relation to assignment and transmission of both registered trade marks and trade marks for which registration is sought. This includes prescribing the documents that must accompany any notice of assignment or transmission, requiring that the particulars of the assignment or transmission be published in the Official Journal and requiring persons recorded as claiming an interest in, or a right in respect of, the trade mark be notified of the assignment or transmission.

#### Part 11 - Voluntary recording of claims to interests in and rights in respect of trade marks

Prescribes the formalities and procedures in relation to amending or cancelling a record of a claim to an interest in, or a right in respect of, a registered trade mark or a trade mark for which registration is sought.

#### Part 13 - Importation of goods infringing Australian trade marks

Prescribes the formalities and the procedures in relation to dealing with the importation of goods infringing Australian trade marks and includes such matters as:

- a prescription of the documents to be provided to the Comptroller-General of the Australian Customs Service (the Comptroller) to accompany a notice of objection given by the registered owner or authorised user of a trade mark;
- the period after which an authorised user of a trade mark may give a notice objecting to the importation of goods infringing Australian trade marks, following a request to the registered owner to give such a notice;
- the period in which an importer, or his or her agent, must comply with a request made by the Comptroller to produce documents or give information; and
- prescribes that Part 13 of the Act will be modified in its application to Norfolk Island, Christmas Island and Cocos (Keeling) Islands by Schedules 3, 4 and 5 respectively.

#### Part 16 - Certification trade marks

Prescribes the formalities and the procedures in relation to the registration of certification trade marks and includes such matters as:

- the requirement that a copy of the rules governing the use of a certification trade mark must be filed with the application for registration or as soon as practicable thereafter;
- documents to be provided to the Trade Practices Commission (the Commission) by the Registrar;
- the procedure the Commission is to follow in deciding whether to certify the rules for governing the use of a certification trade mark, and what actions the Registrar must perform;
- the procedure for approval of a variation of the rules governing the use of a certification trade mark; and

- the procedure the Commission must follow when considering an application for its consent to an assignment of a registered certification trade mark.

#### Part 17 - Defensive trade marks

Prescribes that evidence to support a defensive trade mark application must be filed with the application for registration or as soon as practicable thereafter.

#### Part 19 - Administration

Prescribes the hours during which business may be done at the Trade Marks Office and each sub-office. It also provides that the Registrar may delegate all, or part, of the Registrar's functions to the persons holding, or performing the duties of, the offices set out in Schedule 6.

#### Part 21 - Miscellaneous

The following matters are prescribed:

- the formalities and the procedures in relation to completing and filing documents with the Trade Marks Office including making declarations, withdrawing applications, and notifying changes of address;
- the formalities and the procedures in relation to proceedings before the Registrar including applications for costs, determination of costs, conduct of proceedings, hearings, provision of evidence to, and statements of reasons for decisions of, the Registrar;
- fees;
- the formalities and the procedures in relation to extension of time including making an application for an extension of time, opposing an application for an extension of time, and detailing prescribed acts and documents; and
- other matters such as Convention countries, the rights of patent attorneys, destruction of documents, the Registrar's power to require persons to perform certain acts for the proper conduct of proceedings and to dispense with the need for a person to perform certain acts required under the Regulations.

#### Part 22 - Transitional Provisions

Prescribes the transitional arrangements following the repeal of the *Trade Marks Act 1955* (the repealed Act) and the commencement of the Act. It provides for certain actions taken under the repealed Act to be taken to be made under the Act, transitional arrangements for certain fees and the continuation of certain delegations, deferments and extensions of time made under the repealed Act.

#### Schedule 1 - Classification of goods and services

Prescribes the different classifications of goods and services consistent with the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks*.

#### Schedule 2 - Signs that may not be registered as trade marks

Prescribes a number of signs that may not be registered as trade marks.

### Schedule 3 - Modification of Part, 13 of the Act-Norfolk Island

Prescribes the modifications to be made to Part 13 of the Act when it is applied to Norfolk Island.

### Schedule 4 - Modification of Part 13 of the Act-Christmas Island

Prescribes the modifications to be made to Part 13 of the Act when it is applied to Christmas Island.

### Schedule 5 - Modification of Part 13 of the Act-Cocos (Keeling) Islands

Prescribes the modifications to be made to Part 13 of the Act when it is applied to the Cocos (Keeling) Islands.

### Schedule 6 - Prescribed offices

Prescribes an exhaustive list of the offices to whose occupants the Registrar may delegate part, or all, of the Registrar's powers and functions.

### Schedule 7 - Requirements for documents in paper form

Prescribes the requirements for paper documents filed at the Trade Marks Office.

### Schedule 8 - Costs, Expenses and Allowances

Prescribes the scale of costs, expenses and allowances that may be taxed, and allowed and certified under the Act.

### Schedule 9 - Fees

Prescribes the fees payable for the purposes of the Act and Regulations.

### Schedule 10 - Convention Countries for the purposes of the Act

Prescribes the Convention countries for the purposes of the Act.