

EXPLANATORY STATEMENT

Select Legislative Instrument 2011 No. 62

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

*Patents Act 1990, Trade Marks Act 1995, Designs Act 2003,
Plant Breeder's Rights Act 1994, Olympic Insignia Protection Act 1987*

Intellectual Property Legislation Amendment Regulations 2011 (No. 1)

Subsection 228(1) of the *Patents Act 1990*, subsection 231(1) of the *Trade Marks Act 1995*, subsection 149(1) of the *Designs Act 2003*, subsection 80(1) of the *Plant Breeder's Rights Act 1994* and section 76 of the *Olympic Insignia Protection Act 1987* (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.

Subsection 228(5) of the *Patents Act* requires the Governor-General to make regulations setting out the English text of the Patent Cooperation Treaty (PCT) as in force for Australia on the commencing day of the *Patents Act*, and afterwards such regulations as are necessary to keep that English text up-to-date.

The Regulations make a number of amendments, including:

- amending the English text of the Regulations under the Patent Cooperation Treaty (PCT Rules) set out in Schedule 2A to the *Patents Regulations 1991* to reflect changes to the PCT Rules made in September 2010, commencing on 1 July 2011
- improving the administration of various matters prescribed under the Acts—particularly in relation to service of patents and designs documents
- correcting some incorrect references in the *Patents Regulations* and the *Trade Marks Regulations 1995*
- deleting some unnecessary provisions in the *Trade Marks Regulations*.

The objectives of the Regulations are further discussed in [Attachment A](#) and details of the Regulations are set out in [Attachment B](#).

The Acts specify no conditions that must be met before the power to make the Regulations may be exercised.

The Regulations are a legislative instrument for the purposes of the *Legislative Instruments Act 2003*. Prior to the making of these Regulations, key stakeholders were consulted. The Office of Best Practice Regulation in the Department of Finance and Deregulation has advised that no Regulation Impact Statement is required to be prepared for these amendments.

The Regulations commence on 1 July 2011.

Objectives of the *Intellectual Property Legislation Amendment Regulations 2011 (No. 1)*

The first purpose of the Regulations is to update the English text of the Regulations under the Patent Cooperation Treaty (PCT Rules) set out in Schedule 2A to the Patents Regulations to reflect changes made to the PCT Rules at the September 2010 meeting of the Assembly of the International Patent Cooperation Union.

A second purpose of the Regulations is to extend the range of senior Commonwealth employees who can declare days when the Patent Office, the Trade Marks Office, the Designs Office and the PBR Office, and their respective sub-offices are taken not to be open for business.

A third purpose of the Regulations is to amend the Patents Regulations and the *Designs Regulations 2004* to allow an Australian postal address to be an address for service of designs and patent documents. The amendments also clarify that an application to the Federal Court for a compulsory license is subject to the provisions of the Federal Court Rules governing service, rather than those in the Patents Regulations.

A fourth purpose of the Regulations is to amend the Patents Regulations to ensure that a person required to pay a fee for grant of leave to amend a complete specification, has *two* months to pay that fee following the notice of the grant of leave being published in the *Official Journal of Patents*. Currently, only one month is allowed.

A fifth purpose of the Regulations is to amend Part 17A of the Trade Marks Regulations to provide for addresses for service of documents on a range of persons engaging in proceedings under that Part. These proceedings relate to the extension of protection to international registrations designating Australia (IRDA), or to the ceasing of the protection extended to protected international trade marks.

A sixth purpose of the Regulations is to amend several of the formality requirements for documents relating to patent applications set out in Schedule 3 to the Patents Regulations to more closely align with those in Rule 11 of the PCT Rules. This is to ensure that Australia complies with its obligations under the Patent Law Treaty.

Finally, the Regulations correct some incorrect references in provisions in the Patents Regulations and the Trade Marks Regulations, as well as omitting some unnecessary provisions in Part 17A of the Trade Marks Regulations.

Attachment B

Details of the *Intellectual Property Legislation Amendment Regulations 2011 (No. 1)*

Regulation 1 identifies the Regulations as the *Intellectual Property Legislation Amendment Regulations 2011 (No. 1)*.

Regulation 2 specifies that the Regulations commence on 1 July 2011.

Regulation 3 specifies that Schedule 1 amends the *Patents Regulations 1991* and sets out the application of several amendments in Schedule 1. Subregulation 3 (2) provides certainty in the operation of the extended period for payment of a fee in item 7 of Schedule 1. It does this by ensuring that the amendment does not vary the final date for payment of the fee from that specified in a previously issued invitation to pay the fee. Subregulation 3 (3) relates to the amendments to the formality requirements for patents documents in items 8 to 10 of Schedule 1, ensuring that they only apply to documents filed on or after commencement.

Regulation 4 specifies that Schedule 2 amends the *Patents Regulations 1991*. The amendments made by Schedule 2 update the English text of the Regulations under the Patent Cooperation Treaty (PCT Rules) set out in Schedule 2A to the Patents Regulations. This update reflects the amendments made at the September 2010 meeting of the Assembly of the International Patent Cooperation Union (Assembly). Subregulations 4 (2) to 4 (4) reflect the application provisions agreed by the Assembly at that meeting.

Regulation 5 specifies that Schedule 3 amends the *Trade Marks Regulations 1995*.

Regulation 6 specifies that Schedule 4 amends the *Designs Regulations 2004*.

Regulation 7 specifies that Schedule 5 amends the *Plant Breeder's Rights Regulations 1994*.

Regulation 8 specifies that Schedule 6 amends the *Olympic Insignia Protection Regulations 1987*.

Schedule 1 Amendment of *Patents Regulations 1991* — general

Items 1 and 4 amend subregulations 12.1 (2) and 12.2 (2), respectively, to correct erroneous references to prescribed courts to refer to the Federal Court instead. Until 28 September 2006, sections 133 and 134 of the Patents Act allowed applications for compulsory licences, or revocation of a patent following grant of a licence, to be made to a *prescribed court*—the Federal Court or the Supreme Court of a State or Territory (including Norfolk Island). On that date, Schedule 8 to the *Intellectual Property Laws Amendment Act 2006* amended those sections to require applications to be made to the Federal Court.

Items 2 and 3 insert new subregulations 12.1 (2A) and 12.1 (4) respectively to clarify that the general amendment to the requirements for addresses for service in item 5 below does not extend inappropriately to service in judicial proceedings. The address for service included in an application for a compulsory licence (see above) must be an address mentioned in Rules made by the Federal Court for service of the application, as in force from time to time. The copy of the

application and accompanying declaration must be served in accordance with Rules made by the Federal Court governing service of those documents, as in force from time to time.

Item 5 substitutes subregulations 22.10 (1) and (2) to allow an Australian postal address to be an address for service for the purposes of the patents legislation. The regulations continue to allow a person to give an Australian address where a document can be given *personally* or to that person's specified representative. Alternatively, a person can now specify any address in Australia where it is practicable and reasonable for Australia Post, or a person acting on behalf of Australia Post, to deliver mail. For example, this can be a post-office box or a locked bag. It can also be some postal delivery point to which a contractor of Australia Post routinely delivers mail.

Item 6 substitutes subregulation 22.10AB (2) to extend the range of senior Commonwealth employees who can declare days when the Patent Office and its sub-offices are taken not to be open for business. A declaration made in respect of the Patent Office or a sub-office has the following effect. If the last day of a prescribed period for doing some act at an office falls on a day declared for *that* office, then the act may be done at that office on the day that it re-opens for business. Previously, only the Director General of IP Australia was able to declare such days. The amendment enables other Senior Executive Service (SES) employees of IP Australia to declare such days in the Director General's absence. The Director General and the Deputy Director General are each able to declare such days autonomously. Other SES employees need the agreement of the Director General, the Deputy Director General or another SES employee to declare such days.

Item 7 substitutes regulation 22.2EA and locates it after regulation 22.2E. This corrects an error in item 2 of Schedule 2 to the *Patents Amendment Regulations 2010 (No. 1)*, which inserted the previous regulation 22.2EA after non-existent regulation 2.22E. The substituted provision differs from the previous provision by allowing *two* months for payment of a fee for grant of leave to amend a complete specification. Previously, the fee had to be paid within *one* month from publication of the notice. Otherwise, the provisions of regulation 22.2EA are unchanged.

Items 8 to 10 amend several of the formality requirements for documents relating to patent applications set out in Schedule 3 to more closely align them with those in Rule 11 of the PCT Rules. Specifically, the amendments set out the usable surface of a sheet of drawings; require that a sheet of drawings must *not* contain a frame around the drawings or the useable surface; omit the requirement to number lines or paragraphs of specifications; and require that typewritten documents be 1½ spaced. This is to ensure that Australia complies with its obligations under Article 6 (1) (i) of the Patent Law Treaty: no Contracting Party shall require compliance with any requirement relating to the form or contents of an application different from or additional to those requirements provided in respect of international applications under the Patent Cooperation Treaty.

Schedule 2 Amendment of *Patents Regulations 1991* — Patent Cooperation Treaty

Items 1 and 2 amend subregulation 1.4(2) and Schedule 2A respectively, to state the date of commencement of the latest amendments to the PCT Rules, which were made at the September 2010 meeting of the Assembly of the International Patent Cooperation Union (Assembly).

Items 3 to 14 update the English text of the PCT Rules set out in Schedule 2A. The amendments to the text reflect changes to Rules 12.2, 48.2, 49.5, 53.9, 55.3, 62.1, 62.2, 66.9, 70.2, 70.16 and 92.2 of the PCT Rules, made at the September 2010 meeting of the Assembly. Those changes concern the rectification of obvious mistakes in international applications, amendment of international applications, and international preliminary examination.

Schedule 3 Amendments of *Trade Marks Regulations 1995*

Item 1 amends the definition of *Common Regulations* in regulation 17A.2 to correctly refer to the latest version of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol relating to that Agreement: those in force on 1 September 2009. The Common Regulations are an international instrument made by the Assembly of the Special Union for the International Registration of Marks operating under the Madrid Agreement and the Madrid Protocol.

Item 2 omits the unnecessary provision of paragraph 17A.25 (1) (b), which previously required the Registrar of Trade Marks ('Registrar') to notify the holder of an international registration designating Australia (IRDA) of the Registrar's decision to accept the IRDA. The Madrid Protocol and the Common Regulations do not require the Registrar to notify the holder of this decision.

Item 3 amends paragraph 17A.25 (2) (a) to omit an incorrect and unnecessary reference to Rule 17 of the Common Regulations. That reference appears in a provision requiring the Registrar to notify the International Bureau of the final decision on examination following a provisional refusal under regulation 17A.16. The reference to rule 17 has been incorrect since 1 September 2009, when the Common Regulations were last amended. It is unnecessary to include reference to a specific rule. It suffices that the Registrar's notification is *given* under the correct rule: rule 18*bis* (1) (b) for acceptance of the IRDA in whole or in part; or rule 18*ter* (3) for confirmation of total provisional refusal.

Item 4 substitutes subregulation 17A.33 (3), so as to require the holder of an IRDA to have a current address for service in Australia recorded in the Record of International Registrations (Record) *throughout* a proceeding opposing the extension of protection in Australia to the trade mark that is the subject of the IRDA ('opposition'). Previously, under subregulation 17A.33 (3) there was no requirement to serve a document on the holder in an opposition, or for the Registrar to give the holder an opportunity to make written representations or to be heard in an opposition—*until* the holder has notified the Registrar, in writing, of the holder's address for service in Australia. Previously, this allowed the holder to notify a local representative as an address for service in Australia (e.g. that of a firm of solicitors), and then to *withdraw* that address for service by withdrawing the local representative's authority to accept service. The first the opponent might hear of this is when the local representative refuses to accept service. The substituted provision ensures that any requirement to serve documents on, or to hear, the holder only applies *while* there is a current address for service on the holder recorded in the Record. The amendments made by item 7 below require that the address for service be an address in Australia, and require the Registrar to remove from the Record no-longer-current addresses for service.

Item 5 inserts a new subregulation 17A.48 (6A)—modelled on substituted subregulation 17A.33 (3), see item 4 above—to require a person *opposing* an application for cessation of protection for non-use (‘opponent’) to have a current address for service in Australia recorded in the Record throughout those opposition proceedings. Existing subregulation 17A.48 (6) provides that the Registrar is not required to take any action in response to a notice of opposition to an application for cessation of protection *unless* the opponent has notified the Registrar, in writing, of the opponent’s address for service in Australia. The new subregulation ensures that any requirement to serve documents on, or to hear, the holder only applies *while* there is an address for service on the holder recorded in the Record. The amendments made by item 7 below require that the address for service be an address in Australia, and require the Registrar to remove from the Record no-longer-current addresses for service.

Item 6 inserts new paragraph 17A.66 (3) (ba) to provide that the particulars of every protected international trade mark in the Record must include an address for service for service of the holder. Under existing subregulation 17A.37 (3), every holder must notify the Registrar of the holder’s address for service in Australia—as soon as practicable after receiving notice that a trade mark has become a protected international trade mark. The amendments made by item 7 below require that the address for service be an address in Australia.

Item 7 inserts new regulation 17A.74 to provide for addresses for service of documents on a range of persons engaging in proceedings under Part 17A. These proceedings relate to the extension of protection to Australia of an IRDA, or to the ceasing of the protection extended to a protected international trade mark.

As permitted by subsection 189A (3) of the *Trade Marks Act 1995*, new regulation 17A.74 makes provision for addresses for service differing from, and prevailing over, the general provisions for addresses for service in section 215 of the Trade Marks Act. The new provision applies to:

- the holder of an IRDA or of a protected international trade mark (‘holder’)
- a person who applies under regulation 17A.61 to have the Registrar record the person’s claim to an interest in, or a right in respect, of a trade mark that is the subject of an IRDA, or is a protected international trade mark
- a person whose claim is recorded under regulation 17A.62
- a person who opposes under regulation 17A.29 the extension of protection in Australia to the trade mark that is the subject of an IRDA
- a person who applies under subregulation 17A.48 (1) for a trade mark that is, or may become, a protected international trade mark to cease to be protected
- a person who opposes an application under subregulation 17A.48 (1)—see item 5 above

The address for service of a person *not* listed above continues to be governed by section 215 of the Trade Marks Act: for example, a person applying for international registration of a trade mark through the intermediary of the Trade Marks Office.

As with addresses for service under subsection 215 (5) of the Trade Marks Act, an address for service must be an address in Australia. If one of the listed persons notifies the Registrar of an

address for service, the Registrar must enter it into the Record as the person's address for service. The person must notify the Registrar of changes to the person's address for service, including the person *ceasing* to have any address for service. The Registrar must amend the Record accordingly, including removing any previous address for service—even if this means there is no longer any address for service of the person in the Record. Similarly, if the Registrar is satisfied that the recorded address for service is no longer the person's address for service, the Registrar must remove it from the Record. The Registrar must notify the person of the removal, using the default means discussed below.

There are a number of requirements in the Trade Marks Act and the Trade Marks Regulations for documents to be served on, or given or sent to persons. The new regulation provides that such a requirement can be met by leaving the document at, or sending it by post to, the address for service of the person. This applies if there is an address for service recorded for the person in the Record. The operation of section 28A of the *Acts Interpretation Act 1901* is not affected, permitting personal service, or service at some *other* address of the person (if known to the server). Also, section 29 of the *Acts Interpretation Act 1901* and section 160 of the *Evidence Act 1995* may govern *when* service on an address in Australia is taken to be effected.

The new provision also provides for a *default* means of satisfying any requirement to serve a document on the person—if there is no address for service of the person in the Record. It suffices to post the document to, or to leave it at, a foreign address appearing in the Record for the person. This default is most useful for service on a holder, since the holder's foreign business or residential address is routinely provided by the International Bureau in notification of an IRDA, or in a subsequent notification of a change of the holder's address.

It might not be straightforward to ascertain when a posted document is delivered in the ordinary course of post to the foreign address. To avoid this uncertainty, the requirement is taken to be satisfied *on the day in Australia* on which the document is posted to, or left at, that foreign address. If the document is required to be served in some prescribed period—say 3 months ending on 15 March—then it suffices that the document is *posted* to the foreign address *on* 15 March as reckoned in Australia. It could be posted before then, but that is not necessary. It is also *not* necessary that the posted document *be received* at the foreign address on or before 15 March—whether as reckoned in Australia, or at the foreign address.

Item 8 substitutes subregulation 21.24B (2) to extend the range of senior Commonwealth employees who can declare days when the Trade Marks Office and its sub-offices are taken not to be open for business. A declaration made in respect of the Trade Marks Office or a sub-office has the following effect. If the last day of a prescribed period for doing some act at an office falls on a day declared for *that* office, then the act may be done at that office on the day that it re-opens for business. Previously, only the Director General of IP Australia was able to declare such days. The amendment enables other Senior Executive Service (SES) employees of IP Australia to declare such days in the Director General's absence. The Director General and the Deputy Director General are each able to declare such days autonomously. Other SES employees need the agreement of the Director General, the Deputy Director General or another SES employee to declare such days.

Schedule 4 Amendments of *Designs Regulations 2004*

Item 1 substitutes subregulations 11.19 (1) and (2) to allow an Australian postal address to be address for service for the purposes of the designs legislation. The regulations continue to allow a person to give an Australian address where a document can be given *personally* or to that person's specified representative. Alternatively, a person can now specify any address in Australia where it is practicable and reasonable for Australia Post, or a person acting on behalf of Australia Post, to deliver mail. For example, this could be a post-office box or a locked bag. It could also be some postal delivery point to which a contractor of Australia Post routinely delivers mail.

Item 2 substitutes subregulation 11.33 (2) to extend the range of senior Commonwealth employees who can declare days when the Designs Office and its sub-offices are taken not to be open for business. A declaration made in respect of the Designs Office or a sub-office has the following effect. If the last day of a prescribed period for doing some act at an office falls on a day declared for *that* office, then the act may be done at that office on the day that it re-opens for business. Previously, only the Director General of IP Australia was able to declare such days. The amendment enables other Senior Executive Service (SES) employees of IP Australia to declare such days in the Director General's absence. The Director General and the Deputy Director General are each able to declare such days autonomously. Other SES employees need the agreement of the Director General, the Deputy Director General or another SES employee to declare such days.

Schedule 5 Amendments of the *Plant Breeder's Rights Regulations 1994*

Item 1 substitutes subregulation 3F (2) to extend the range of senior Commonwealth employees who can declare days when the Plant Breeder's Rights Office (PBR Office) and its sub-offices are taken not to be open for business. A declaration made in respect of the PBR Office or a sub-office has the following effect. If the last day of a prescribed period for doing some act at an office falls on a day declared for *that* office, then the act may be done at that office on the day that it re-opens for business. Previously, only the Director General of IP Australia was able to declare such days. The amendment enables other Senior Executive Service (SES) employees of IP Australia to declare such days in the Director General's absence. The Director General and the Deputy Director General are each able to declare such days autonomously. Other SES employees need the agreement of the Director General, the Deputy Director General or another SES employee to declare such days.

Schedule 6 Amendments of the *Olympic Insignia Protection Regulations 1993*

Item 1 substitutes subregulation 6B (2) to extend the range of senior Commonwealth employees who can declare days when the Designs Office is taken not to be open for business. A declaration made in respect of the Designs Office has the following effect. If the last day of a prescribed period for doing some act falls on a declared day, the act may be done on the day that the Designs Office re-opens for business. Previously, only the Director General of IP Australia was able to declare such days. The amendment enables other Senior Executive Service (SES) employees of IP Australia to declare such days in the Director General's absence. The Director General and the Deputy Director General are each able to declare such days autonomously. Other SES employees need the agreement of the Director General, the Deputy Director General or another SES employee to declare such days.