

EXPLANATORY STATEMENT

Select Legislative Instrument 2011 No. 217

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

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

Intellectual Property Legislation Amendment Regulations 2011 (No. 2)

Subsection 149(1) of the *Designs Act 2003*, section 76 of the *Olympic Insignia Protection Act 1987*, subsection 228(1) of the *Patents Act 1990*, subsection 80(1) of the *Plant Breeder's Rights Act 1994* and subsection 231(1) of the *Trade Marks Act 1995* (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 19(3) of the *Trade Marks Act* allows the *Trade Marks Regulations 1995* to set out the classes into which goods and services are to be divided for the registration of a trade mark.

The Regulations:

- update several references in the *Designs Regulations 2004*, the *Olympic Insignia Protection Regulations 1993*, the *Patents Regulations 1991*, the *Plant Breeder's Rights Regulations 1994* and the *Trade Marks Regulations* to provisions of the *Acts Interpretation Act 1901* (the AI Act) as amended by the *Acts Interpretation Amendment Act 2011* (the AI Amendment Act);
- amend the *Patents Regulations* to remove an exception to the existing general rule for determining when the Commissioner or the Patent Office is taken to have given someone a document;
- amend the *Patents Regulations* to allow applicants for standard patents to defer consideration of proposed amendments to their complete specifications until substantive examination of their applications has commenced; and
- update the classes of goods and services in Schedule 1 to the *Trade Marks Regulations* to reflect the revised International Classification of Goods and Services (the Nice Classification) commencing on 1 January 2012.

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, the Patents Consultation Group and the Trade Marks Consultation Group were consulted. The members of these consultation groups are drawn from the registered patent attorney profession, the registered trade marks attorney profession, the legal profession, academia and industry. Several peak bodies are represented in the membership of these consultation groups: the Institute of Patent and Trade Mark Attorneys of Australia, the International Federation of Intellectual Property Attorneys of Australia, the Law Council of Australia and the Australian Manufacturers' Patents, Industrial Designs, Copyright and Trade Mark Association.

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 amendments to update references to provisions in the AI Act commence on 27 December 2011—the general commencement of the AI Amendment Act. The remaining provisions commence on 1 January 2012.

Attachment A

Objectives of the *Intellectual Property Legislation Amendment Regulations 2011 (No. 2)*

The first purpose of the Regulations is to update references in the Designs Regulations, the Olympic Insignia Protection Regulations, the Patents Regulations, the Plant Breeder's Rights Regulations and the Trade Marks Regulations to provisions of the Acts Interpretation Act. This is consequential on the amendment of the Acts Interpretation Act by the Acts Interpretation Amendment Act, with effect from 27 December 2011.

A second purpose of the Regulations is to amend the Patents Regulations to remove an exception to the existing general rule specifying when the Commissioner or the Patent Office is taken to have given someone a document. As a result, the general rule—currently applying to documents sent by post—would also apply to documents given to someone electronically.

A third purpose of the proposed Regulations is to amend the Patents Regulations to allow an applicant for a standard patent to defer consideration of proposed amendments to the complete specification relating to the application until substantive examination of the application has commenced. An applicant requesting deferred consideration would not have to pay the fee currently prescribed for requesting an amendment. An applicant could still have a proposed amendment considered before substantive examination, by paying the prescribed fee.

Finally, the Regulations update the class headings listed in Schedule 1 to the Trade Marks Regulations to reflect those in the Tenth Edition of the International Classification of Goods and Services ('Nice Classification'), which comes into effect on 1 January 2012. This assists Australia to meet its obligations under the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks* ('Nice Agreement') which requires the Trade Marks Office to include in its official documents the classes of the goods or services of registered trade marks.

Attachment B

Details of the *Intellectual Property Legislation Amendment Regulations 2011 (No. 2)*

Regulation 1 identifies the Regulations as the *Intellectual Property Legislation Amendment Regulations 2011 (No. 2)*.

Regulation 2 specifies that regulations 1 to 3 and Schedule 1 commence on 27 December 2011—the general commencement date of the Acts Interpretation Amendment Act—and regulation 4 and Schedule 2 commence on 1 January 2012.

Regulation 3 specifies that Schedule 1 amends the *Designs Regulations 2004*, the *Olympic Insignia Protection Regulations 1993*, the *Patents Regulations 1991*, the *Plant Breeder's Rights Regulations 1994* and the *Trade Marks Regulations 1995*.

Regulation 4 specifies that Schedule 2 amends the Patents Regulations and the Trade Marks Regulations.

Schedule 1 Amendments commencing on 27 December 2011

Part 1 *Designs Regulations 2004*

Item 1.1 amends the note to subregulation 11.33 (2) to update the reference to the provision of the *Acts Interpretation Act 1901* defining the expression 'SES employee'. As a result of one of the amendments made with effect from 27 December 2011 by the Acts Interpretation Amendment Act, that definition is no longer be set out in section 17AA of the Acts Interpretation Act, but appears instead in section 2B of the Acts Interpretation Act.

Part 2 *Olympic Insignia Protection Regulations 1993*

Item 2.1 amends the note to subregulation 6B (2) to update a reference to the provision of the Acts Interpretation Act defining the expression 'SES employee'. Please refer to item 1.1 above for the reason for the amendment.

Part 3 *Patents Regulations 1991*

Item 3.1 amends the note to subregulation 22.10AB (2) to update a reference to the provision of the Acts Interpretation Act defining the expression 'SES employee'. Please refer to item 1.1 above for the reason for the amendment.

Part 4 *Plant Breeder's Rights Regulations 1994*

Item 4.1 amends the note to subregulation 3F (2) to update a reference to the provision of the Acts Interpretation Act defining the expression 'SES employee'. Please refer to item 1.1 above for the reason for the amendment.

Part 5 *Trade Marks Regulations 1995*

Items 5.1 and 5.2 amend the note to regulation 2.2 to indicate that the regulation provides an intention contrary to the application of the provisions of section 2G and subsection 36(1) of the Acts Interpretation Act. With effect from 27 December 2011, the Acts Interpretation Amendment

Act inserts a new section 2G into the Acts Interpretation Act for the measuring of periods of months, and substitutes a redrafted section 36 for calculating time generally. Owing to Australia's obligations under the *Protocol Relating to the Madrid Agreement concerning the International Registration of Marks* ('Madrid Protocol'), it remains appropriate that regulation 2.2 provides when periods of months prescribed in the Trade Marks Regulations end. The note had indicated that the regulation displaced previous section 36 of the Acts Interpretation Act.

Item 5.3 amends the note to subregulation 21.24B (2) of the Trade Marks Regulations to update a reference to the provision of the Acts Interpretation Act defining the expression 'SES employee'. Please refer to item 1.1 above for the reason for the amendment.

Schedule 2 Amendments commencing on 1 January 2012

Part 1 Patents Regulations 1991

Items 1.1 and 1.2 amend subregulation 1.3 (4) and substitute an amended subregulation 1.3(5) respectively, to remove an exception to the general rule set out in subregulation 1.3(4). The general rule is that the Commissioner or the Patent Office is taken to have given someone a document on the day that it is dated, not the day that it is actually received. The exception is where the document is made available electronically. In such circumstances the document is taken to be given to the person on the day that the Commissioner sends a notice to the person telling them the document is available electronically. The proposed change will apply the general rule to all documents, including those provided under subregulation 1.3 (5). Substitute subregulation 1.3 (5) would continue to allow this means of giving persons documents, but would not specify when the document is taken to be given to the person.

Item 1.3 inserts a new regulation 10.6A to allow an applicant for a standard patent to defer consideration of a proposed amendment to the complete specification relating to the application until substantive examination of the application has commenced. An applicant requesting deferred consideration would not have to pay the prescribed fee for proposing the amendment. In any event, an applicant could still have a proposed amendment considered before substantive examination, by paying the fee prescribed under item 222 (a) of Part 2 of Schedule 7. There is no fee prescribed for proposing amendments during examination.

Part 2 Trade Marks Regulations 1995

Items 2.1 to 2.9 amend the headings of several classes of goods or services listed in Schedule 1 to reflect those in the Nice Classification, which comes into effect on 1 January 2012. A trade mark may be registered for goods and services falling in one or more numbered classes. The class headings describe those classes so that goods and services can be correctly classified. This assists Australia to meet its obligations under the Nice Agreement which requires the Trade Marks Office to include in its official documents the class numbers of the goods and services of registered trade marks.