



Law Council  
OF AUSTRALIA

*Business Law Section*

IP Australia  
P O Box 200  
Woden ACT 2602

10 April 2013

Attention: Mr Michael Arblaster  
Via email: [michael.arblaster@ipaaustralia.gov.au](mailto:michael.arblaster@ipaaustralia.gov.au)

Ms Claudia Murray  
Via email: [claudia.murray@ipaaustralia.gov.au](mailto:claudia.murray@ipaaustralia.gov.au)

Dear Mr Arblaster and Ms Murray,

**Regulation 22.9 of the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013***

Members of the Intellectual Property Committee of the Business Law Section of the Law Council of Australia ('IPC') share the concerns which have been expressed by the Institute of Patent and Trade Mark Attorneys of Australia in relation to the transitional provisions in regulation 22.9 of the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013* (the Regulations).

In particular, the IPC believes that the provisions dealing with extensions of time for filing/serving evidence in opposition proceedings are so unclear that they are likely to cause serious problems when the Regulations come into force.

The IPC therefore submits that the Trade Marks Office should, as a matter of extreme urgency, issue a practice note explaining how the Office proposes to deal with the application of the transitional provisions.

The IPC identifies the following issues as being of particular concern:

- (1) The Explanatory Statement suggests that if a request for an extension of time for filing evidence is made before 15 April 2013 the old regulations will apply and any subsequent extension of that evidentiary period will also be assessed by reference to the old regulations. Is this interpretation correct?
- (2) If evidence in support has been served and filed before 15 April 2013 and the evidence in answer is due to be filed after 15 April 2013, will a request

GPO Box 1989, Canberra  
ACT 2601, DX 5719 Canberra  
19 Torrens St Braddon ACT 2612

Telephone +61 2 6246 3788  
Facsimile +61 2 6248 0639

Law Council of Australia Limited  
ABN 85 005 260 622  
[www.lawcouncil.asn.au](http://www.lawcouncil.asn.au)

**BLS**

for an extension of time to file the evidence in answer be assessed by reference to the old or the new regulations? What will be the situation in relation to evidence in reply?

- (3) The explanatory notes posted by IP Australia on 2 April state that if an extension of time is requested for *an evidentiary period* that commences on or after 15 April 2013 the new provisions are applicable. However regulation 22.9(5) refers to “an extension of time for *a period* that commences on or after 15 April 2013”. Three questions arise:
- (a) Is there a difference between *an evidentiary period* and *a period* and, if there is, what is that difference?
  - (b) Does ‘evidentiary period’ refer to a category of evidence, for example evidence in answer, or does it refer to the period in which a variety of evidence, for example, evidence in support must be filed, for example three months?
  - (c) Does the answer affect the application of regulation 22.9(5)?

If the reference is to all of the evidence in support, evidence in answer or evidence in reply, then (1) above appears to be correct, but if the reference is to the period within which evidence must be filed, for example 3 months, then presumably only the first application for an extension of time would be assessed under the old regulations.

For further discussions or clarification of the foregoing please contact the Chair of the IPC, Richard Hamer on (03) 9613 8705 or via email:

[Richard.Hamer@allens.com.au](mailto:Richard.Hamer@allens.com.au) or the Convenor of the Trade Marks Subcommittee, Ann Dufty via email: [aduffy@mansfield.net.au](mailto:aduffy@mansfield.net.au).

Yours sincerely,



**Frank O'Loughlin**