

# 專利法條約

## Article 11

### Relief in Respect of Time Limits

#### 第十一條 有關期限之救濟

##### (1) [Extension of Time Limits]

〔期限之延長〕

A Contracting Party may provide for the extension, for the period prescribed in the Regulations, of a time limit fixed by the Office for an action in a procedure before the Office in respect of an application or a patent, if a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations, and the request is filed, at the option of the Contracting Party:

締約會員之局收到提出延長期限之請求時，該請求如符合施行細則規定之要件，且在下列規定時點提出（由締約會員選擇）者，該締約會員得依施行細則規定之期間，將該局所限定向其進行申請或專利相關之程式之期限延長：

(i) prior to the expiration of the time limit; or  
期限屆滿前提出；或

(ii) after the expiration of the time limit, and within the time limit prescribed in the Regulations.  
期限屆滿後，但在施行細則規定之期限前提出。

##### (2) [Continued Processing]

〔繼續之程式〕

Where an applicant or owner has failed to comply with a time limit fixed by the Office of a Contracting Party for an action in a procedure before the Office in respect of an application or a patent, and that Contracting Party does not provide for extension of a time limit under paragraph (1)(ii), the Contracting Party shall provide for continued processing with respect to the application or patent and, if necessary, reinstatement of the rights of the applicant or owner with respect to that application or patent, if:

申請人或專利權人不能於締約會員的局限定之期限內，向局完成進行申請或專利相關之程式，且締約會員未依第一項第 ii 目規定將期限延長，如符合下列事項者，締約會員應規定可繼續對申請或專利未完之程式進行處理，且在必要時，恢復有關該申請或專利之申請人或專利權人之權利：

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;

以符合施行細則規定之要件，向該局請求繼續未完之程式；

- (ii) the request is filed, and all of the requirements in respect of which the time limit for the action concerned applied are complied with, within the time limit prescribed in the Regulations.

於施行細則規定之期限內，該請求已提出，並符合該請求內所稱之作爲所適用期限之所有要件。

(3) [Exceptions]

〔例外〕

No Contracting Party shall be required to provide for the relief referred to in paragraph (1) or (2) with respect to the exceptions prescribed in the Regulations.

不得要求締約會員就施行細則規定之例外，規定有關第一項或第二項所稱之救濟。

(4) [Fees]

〔費用〕

A Contracting Party may require that a fee be paid in respect of a request under paragraph (1) or (2).

締約會員得要求繳納有關第一項或第二項規定請求之費用。

(5) [Prohibition of Other Requirements]

〔其他要件之禁止〕

No Contracting Party may require that requirements other than those referred to in paragraphs (1) to (4) be complied with in respect of the relief provided for under paragraph (1) or (2), except where otherwise provided for by this Treaty or prescribed in the Regulations.

除本條約或施行細則另有其他規定外，締約會員不得要求第一項或第二項所稱之救濟應符合第一項至第四項以外之其他要件。

- (6) [Opportunity to Make Observations in Case of Intended Refusal]  
〔在有意駁回案件時，給予表示意見之機會〕

A request under paragraph (1) or (2) may not be refused without the applicant or owner being given the opportunity to make observations on the intended refusal within a reasonable time limit.

依第一項或第二項規定提出之請求，如未給予申請人或專利權人於合理期限內，對該有意駁回之案件表示意見之機會者，不得予以駁回。

## **Article 12**

### **Reinstatement of Rights After a Finding of Due Care or Unintentionality by the Office**

#### **第十二條 經局裁定已盡到注意義務或非故意後之權利恢復**

- (1) [Request]  
〔請求〕

A Contracting Party shall provide that, where an applicant or owner has failed to comply with a time limit for an action in a procedure before the Office, and that failure has the direct consequence of causing a loss of rights with respect to an application or patent, the Office shall reinstate the rights of the applicant or owner with respect to the application or patent concerned, if:

締約會員應規定，如申請人或專利權人不能於該局所訂之期限內，對其完成進行申請或專利相關程式之行爲，且因不能符合期限之情事而直接導致申請或專利相關權利喪失之結果者，如有下列事項，該局應恢復申請人或專利權人有關申請或專利之權利：

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;  
以符合施行細則規定之要件，向該局請求恢復權利；
- (ii) the request is filed, and all of the requirements in respect of which the time limit for the said action applied are complied with, within

the time limit prescribed in the Regulations;

於施行細則規定之期限內，該請求已提出，並符合該作為所適用期限之所有要件；

- (iii) the request states the reasons for the failure to comply with the time limit; and

該請求應陳述不能符合期限之理由；及

- (iv) the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.

該局發現儘管已盡發生情況所要求之適當注意義務仍不能符合期限，或依締約會員之自由選擇，任何其認為遲延非屬故意。

## (2) [Exceptions]

〔例外規定〕

No Contracting Party shall be required to provide for the reinstatement of rights under paragraph (1) with respect to the exceptions prescribed in the Regulations.

不得要求締約會員就施行細則中規定之例外，給予第一項所稱之權利恢復。

## (3) [Fees]

〔費用〕

A Contracting Party may require that a fee be paid in respect of a request under paragraph (1).

締約會員得要求繳納有關第一項規定請求之費用。

## (4) [Evidence]

〔證據〕

A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (1)(iii) be filed with the Office within a time limit fixed by the Office.

締約會員得要求於該局所定之期限內，向該局提出支援第一項第 iii 目所

定理由之聲明或其他證據。

(5) [Opportunity to Make Observations in Case of Intended Refusal]

〔在有意駁回案件時，給予表示意見之機會〕

A request under paragraph (1) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal within a reasonable time limit.

依第一項提出之請求，如未給予請求當事人於合理期限內，對該有意駁回之案件表示意見之機會者，不得予以全部或一部駁回。

## 商標法條約

### *Article 14*

#### *Relief Measures in Case of Failure to Comply with Time Limits*

(1) [*Relief Measure Before the Expiry of a Time Limit*] A Contracting Party may provide for the extension of a time limit for an action in a procedure before the Office in respect of an application or a registration, if a request to that effect is filed with the Office prior to the expiry of the time limit.

(2) [*Relief Measures After the Expiry of a Time Limit*] Where an applicant, holder or other interested person has failed to comply with a time limit (“the time limit concerned”) for an action in a procedure before the Office of a Contracting Party in respect of an application or a registration, the Contracting Party shall provide for one or more of the following relief measures, in accordance with the requirements prescribed in the Regulations, if a request to that effect is filed with the Office:

(i) extension of the time limit concerned for the period prescribed in the Regulations;

(ii) continued processing with respect to the application or registration;

(iii) reinstatement of the rights of the applicant, holder or other interested person with respect to the application or registration if the Office finds that the failure to comply with the time limit concerned occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that the failure was unintentional.

(3) [*Exceptions*] No Contracting Party shall be required to provide for any of the relief measures referred to in paragraph (2) with respect to the exceptions prescribed in the Regulations.

(4) [*Fees*] Any Contracting Party may require that a fee be paid in respect of any of the relief measures referred to in paragraphs (1) and (2).

(6) [*Prohibition of Other Requirements*] No Contracting Party may demand

that requirements other than those referred to in this Article and in Article 8 be complied with in respect of any of the relief measures referred to in paragraph (2).

## 第十四條

### 未遵守期限時的救濟措施

一、[期限屆滿前的救濟措施] 締約方可以規定，對於在商標主管機關辦理有關申請或註冊的程式中某一行動的期限，凡在期限屆滿前向商標主管機關提出申請要求延長該期限的，均可予以延長。

二、[期限屆滿後的救濟措施] 申請人、註冊持有人或其他利害關係人未能遵守在締約方的商標主管機關辦理有關申請或註冊的程式中某一行動的期限（“相關期限”）的，如果向商標主管機關提出申請要求提供救濟措施，該締約方應按《實施細則》的規定要求提供下列一種或多種救濟措施：

- (1) 將相關期限延長至《實施細則》規定的時間；
- (2) 繼續處理申請或註冊；

[第十四條第二款續]

(3) 商標主管機關認為儘管已作出在具體情況下應作的努力而仍未能遵守期限的，或者根據締約方的選擇，未能遵守期限並非出於故意的，恢復申請人、註冊持有人或其他利害關係人對申請或註冊的權利。

三、[例外] 對於《實施細則》中規定的例外情況，不得要求任何締約方提供本條第二款提及的任何救濟措施。

四、[費用] 任何締約方均可要求，申請本條第一款和第二款所提及的任何救濟措施均應繳納費用。

五、[禁止其他要求] 除本條和本條約第八條規定的要求外，任何締約方不得就本條第二款所提及的任何救濟措施另行規定其他要求

## 商標法條約施行細則

*Rule 9*  
*Relief Measures in Case of*  
*Failure to Comply with Time Limits*

(1) [*Requirements Concerning Extension of Time Limits Under Article 14(2)(i)*]

A Contracting Party that provides for the extension of a time limit under Article 14(2)(i) shall extend the time limit for a reasonable period of time from the date of filing the request for extension and may require that the request

(i) contain an identification of the requesting party and the time limit concerned,  
and

(ii) be filed within a time limit which shall not be less than two months from the date of expiry of the time limit concerned.



(2) [*Requirements Concerning Continued Processing Under Article 14(2)(ii)*]

A Contracting Party may require that the request for continued processing under Article 14(2)(ii)

(i) contain an identification of the requesting party and the time limit concerned, and

(ii) be filed within a time limit which shall not be less than two months from the date of expiry of the time limit concerned. The omitted act shall be completed within the same period or, where the Contracting Party so provides, together with the request.

(3) [*Requirements Concerning Reinstatement of Rights Under Article 14(2)(iii)*]

(a) A Contracting Party may require that the request for reinstatement of rights under Article 14(2)(iii)

(i) contain an identification of the requesting party and the time limit concerned, and

(ii) set out the facts and evidence in support of the reasons for the failure to comply with the time limit concerned.

(b) The request for reinstatement of rights shall be filed with the Office within a reasonable time limit, the duration of which shall be determined by the Contracting Party from the date of the removal of the cause of failure to comply with the time limit concerned. The omitted act shall be completed within the same period or, where the Contracting Party so provides, together with the request.

(c) A Contracting Party may provide for a maximum time limit for complying with the requirements under subparagraphs (a) and (b) of not less than six months from the date of expiry of the time limit concerned.

(4) [*Exceptions Under Article 14(3)*] The exceptions referred to in Article 14(3) are the cases of failure to comply with a time limit

(i) for which a relief measure has already been granted under Article 14(2),

(ii) for filing a request for a relief measure under Article 14,

(iii) for payment of a renewal fee,

(iv) for an action before a board of appeal or other review body constituted in the framework of the Office,

(v) for an action in *inter partes* proceedings,

[Rule 9(4), continued]

(vi) for filing the declaration referred to in Article 3(1)(a)(vii) or the declaration referred to in Article 3(1)(a)(viii),

(vii) for filing a declaration which, under the law of the Contracting Party, may establish a new filing date for a pending application, and

(viii) for the correction or addition of a priority claim.

## 第九條

### 未遵守期限時的救濟措施

一、[有關條約第十四條第二款第(1)目規定的延長期限的要求] 凡根據條約第十四條第

[第九條第一款續]

第二款第(1)目規定可延長期限的締約方，應自期限延長申請提交之日起將期限合理延長，並可要求該申請：

(1) 應含有關於申請方的身份及相關期限的說明，並

(2) 應在規定期限內遞交，該期限自相關期限屆滿之日起不少於兩個月。

二、*[有關條約第十四條第二款第(2)目規定的繼續處理的要求]* 締約方可以要求，根據條約第十四條第二款第(2)目規定提出的繼續處理的申請：

(1) 應含有關於申請方的身份及相關期限的說明，並

(2) 應在規定期限內遞交，該期限自相關期限屆滿之日起不少於兩個月。疏失行為應在該時期內完成，或者如果締約方有此規定的，在提交申請的同時完成。

三、*[有關條約第十四條第二款第(3)目規定的恢復權利的要求]*

(一) 締約方可以要求，根據條約第十四條第二款第(3)目提出的恢復權利的申請：

(1) 應含有關於申請方的身份及相關期限的說明，並

(2) 應提供事實和證據，說明未能遵守相關期限的原因。

(二) 恢復權利的申請應在合理期限內提交商標主管機關，該期限的長短應由締約方自未遵守有關期限的原因消除之日起確定。疏失行為應在該時期內完成，或者如果締約方有此規定的，在提交申請的同時完成。

(三) 締約方可以為符合本款第(一)項和第(二)項的要求規定最長期限，該期限應自相關期限到期之日起不少於六個月。

四、*[條約第十四條第三款規定的例外]* 條約第十四條第三款規定的例外是指未遵守下列期限的情況：

(1) 已根據條約第十四條第二款給予救濟措施的期限；

(2) 根據條約第十四條提出救濟措施申請的期限；

(3) 繳納續展費用的期限；

(4) 向上訴委員會或商標主管機關內的其他復審機構採取行動的期限；

(5) 採取當事人之間程式中行動的期限；

[第九條第四款續]

（6）提交條約第三條第一款第（一）項第（7）目所述聲明或條約第三條第一款第（一）項第（8）目所述聲明的期限；

（7）提交根據締約方法律有可能為待批申請確定新申請日的聲明的期限；以及

（8）對優先權主張作出修改或增加的期限。

## **224 Extension of time**

(1) The Registrar must extend the time for doing a relevant act that is required by this Act to be done within a certain time if the act is not, or cannot be, done within that time because of an error or omission by:

- (a) the Registrar or a Deputy Registrar; or
- (b) an employee; or
- (c) a person providing, or proposing to provide, services for the benefit of the Trade Marks Office.

## Miscellaneous **Part 21**

### General **Division 3**

#### Section 224

#### *Trade Marks Act 1995 137*

(2) If, because of:

- (a) an error or omission by the person concerned or by his or her agent; or
- (b) circumstances beyond the control of the person concerned; a relevant act that is required by this Act to be done within a certain time is not, or cannot be, done within that time, the Registrar may, on application made by the person concerned in accordance with the regulations, extend the time for doing the act.

(3) If:

- (a) a relevant act that a person is required by this Act to do within a certain time is not, or cannot be, done within that time; and
- (b) on application made by that person in accordance with the regulations, the Registrar is of the opinion that special circumstances exist that justify an extension of that time; the Registrar may extend the time for doing the act.

(4) The time allowed for doing a relevant act may be extended, whether before or after that time has expired.

(5) If an application is made under subsection (2) or (3) for an extension of time for more than 3 months, the Registrar must advertise the application in the *Official Journal*.

(6) A person may, as prescribed, oppose the granting of the application.

(7) An application may be made to the Administrative Appeals Tribunal for the review of a decision of the Registrar not to extend the time for the doing of an act.

(8) In this section:

***relevant act*** means:

- (a) any act (other than a prescribed act) done in relation to a trade mark; or
- (b) the filing of any document (other than a prescribed document); or
- (c) any proceedings (other than court proceedings).

## 澳洲商標法施行細則

### **21.25 Extension of time — application**

For the purposes of subsections 224 (2) and (3) of the Act (which deal with extensions of time), an application for an extension of time for doing a relevant act:

- (a) must be in an approved form; and
- (b) must be accompanied by a declaration stating:
  - (i) the facts on which the grounds specified in the application are based; and
  - (ii) if the period for doing the relevant act has ended — the reason why the application was not made before the period ended.

*Note* Regulations 21.6 and 21.7 deal with making and filing declarations.

### **21.26 Extension of time — notice of opposition**

- (1) For the purposes of subsection 224 (6) of the Act (which deals with opposition to an extension), a person may oppose an application for an extension of time for more than 3 months by filing a notice of opposition with the Registrar.
- (2) A notice of opposition:
  - (a) must be in an approved form; and
  - (b) must be filed within 1 month after the application for an extension of time is advertised in the *Official Journal*.
- (3) The opponent must serve a copy of the notice on the applicant.

### **21.27 Extension of time — opposition proceedings**

For the purposes of subsection 224 (6) of the Act (which deals with opposition to an extension), regulations 5.7 to 5.17 (inclusive) apply to an opposition to an application for an extension of time.

## 21.28 Extension of time — prescribed acts and documents

- (1) For the purposes of paragraph (a) of the definition of *relevant act* in subsection 224 (8) of the Act, the following acts are prescribed:
  - (a) complying with the requirements of subregulation 4.2 (1);
  - (aa) filing notice of a claim to a right of priority under subsection 29 (1) of the Act;
  - (b) applying for the registration of a trade mark in the circumstances described in paragraph 29 (1) (b) of the Act;
  - (c) making a divisional application for the registration of a part of a trade mark under subsection 47 (2) of the Act;
  - (d) making a divisional application for the registration of a trade mark under subsection 49 (2) of the Act;
  - (e) making a divisional application for the registration of a trade mark under subsection 49 (4) of the Act;
  - (ea) requesting deferment of acceptance under subregulation 4.13 (1);
  - (f) serving a copy of the evidence under regulation 5.7, 5.9 or 5.12;
  - (g) serving a copy of a notice under regulation 5.8, 5.11 or 5.13;
  - (h) serving a copy of further evidence under regulation 5.15;
  - (ha) requesting an amendment of a notice of opposition under subregulation 5.19 (1);
  - (i) responding to a notice to which subregulation 8.1 (2) applies;
  - (j) requesting that an application for the registration of a trade mark be amended under paragraph 64 (b) of the Act;
  - (k) requesting renewal of the registration of a trade mark under sections 79, 80D or 80G of the Act;
  - (l) responding to a notice to which subregulation 10.5 (1) applies;
  - (m) responding to a notification of the Registrar under subregulation 11.3 (4);
  - (n) complying with the authorised user's request referred to in regulation 13.2;
  - (o) complying with a request for information referred to in regulation 13.3;
  - (p) responding to a notice under subregulation 16.3 (2);
  - (q) responding to an advertisement under subregulation 16.3 (3);
  - (r) making a claim for priority under section 29 of the Act for an application for the registration of a trade mark in the circumstances mentioned in section 244 of the Act;
  - (s) the filing of a document or the giving of advice to the Registrar under Part 3A.
- (2) For the purposes of paragraph (b) of the definition of *relevant act* in subsection 224 (8) of the Act, the following documents are prescribed:
  - (a) a notice of opposition to the registration of a trade mark under section 52 of the Act;
  - (b) a notice of opposition to which subregulation 21.26 (1) applies;
  - (c) any of the following documents required or permitted to be submitted under Part 3A:
    - (i) an AFS request;

- (ii) a submission;
- (iii) an attachment;
- (iv) accompanying material;
- (v) a written advice.

澳洲商標法審查手冊

## Part 15 General Extension of Time Provisions

### Part 15 Overview

Relevant Legislation

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2. When the general provisions do not apply
  - 2.1 Times, for the doing of prescribed acts and the filing of prescribed documents, that are extendible
  - 2.2 Times, for doing of prescribed acts and the filing of prescribed documents, that are not extendible
  - 2.3 Time for filing a convention application
3. Circumstances in which the Registrar must extend time
4. Confirmation of extension of time practice where a response is received within three (or less) weeks
5. Grounds on which the Registrar may grant an extension of time
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6. Form of the application
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### Part 15 Relevant Legislation

#### The Act

Section 6 Definitions employee

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Registrar to act as soon as possible

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Section

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Extension of time

## The Regulations

Reg 4.12 Periods after which applications lapse

Reg 5.15 Extension of period to serve evidence and service of further evidence

Reg 21.4 Filing of documents - treatment of non-complying documents

Reg 21.6 Declarations

Reg 21.12 Applications for costs

Reg 21.23 Notice of non-payment of fee

Reg 21.25 Extension of time - application

Reg 21.26 Extension of time - notice of opposition

Reg 21.27 Extension of time - opposition proceedings

Reg 21.28 Extension of time - prescribed acts and documents

Reg 21.33 Directions not otherwise prescribed

## 15.1 When the general provisions apply

The general provisions for extensions of time are set out in section 224 of the Act.

These extensions of time provisions apply to “relevant acts”, rather than to “prescribed acts”. “Relevant acts” are described in subsection 224(8) as being:

- any act (other than a prescribed act) done in relation to a trade mark; or
- the filing of any document (other than a prescribed document); or

Part 15 General Extension of Time Provisions

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any proceedings (other than court proceedings).

**Note:** Refer to paragraph 2 of this Part for information about “prescribed acts” and extensions of time.

The relevant acts to which the general provisions apply are as follows:

a request to extend the time for acceptance of an application beyond 21 months from the date of issue of the first report;

a request to extend the time allowed for acceptance when the prescribed time, (15 months) or the time as extended, has expired, ie the provisions apply to late applications to extend the time for acceptance (reg 4.12);

Part 16 TIME LIMITS FOR ACCEPTANCE OF AN APPLICATION FOR

## REGISTRATION

a request to extend the time allowed for the Registrar to register a trade mark;

### Part 39 REGISTRATION OF A TRADE MARK

#### 4. Timing for Registration

a request to extend the time in which to file notice of opposition to an application for the removal of a registered trade mark on the grounds of nonuse; and

### Part 49 NON-USE PROCEDURES

#### 3. Processing an application for removal

1.1 The general provision of subsection 224(1) requires the Registrar to grant additional time for doing an act when the additional time is needed because of an error or omission on the part of a trade marks employee.

Section 204 provides for the Registrar to perform actions (which are not otherwise limited as to time) as soon as is practicable. In instances where this requirement is not met, or where the action occurs outside the period the Registrar has indicated will be Office practice, a free extension of time may be appropriate. In the case of an application to register a trade mark, it is the Registrar's practice to reply within four weeks to an applicant's response to an examiner's report. If a reply is not provided in that time the Registrar may grant, if required, a free extension of time for acceptance equivalent to the delay that occurred.\*

#### Part 15

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It is not the Registrar's practice to grant such extensions within the prescribed 15 month period but, if it is requested and/or required, to provide an appropriate extension of time once the 15 months has ended.

The Registrar may grant free extensions of time within the initial six month extension period under the provisions of s224. However, these free extensions of time will not extend the initial extension period past 21 months from the date of issue of the first report (or from the date of issue of a further adverse report raising new grounds for rejecting the application under paragraph 4.12(1)(a) of the Regulations). That is, once the 21 month date is reached, even if this happens because free extensions of time have been previously granted, the applicant must apply for any further extensions of time under the general provisions.

\*Note: The basic unit used for extending time is one calendar month. Therefore, if the Registrar decides to compensate for a delay of one week after the four weeks reply period allowed (see above), this would result in a free extension of one calendar month being given. However, see paragraph 4.1.

## 15.2 When the general provisions do not apply

Many of the acts done in relation to a trade mark are prescribed acts. A notice of opposition to registration and a notice of opposition to an extension of time of more than three months are prescribed documents (reg. 21.28). If an act or a document is prescribed, the time for the doing of the act or the filing of the document may be:

extendible, because the legislation contains alternative extension of time provisions; or

not extendible, because the legislation contains no alternative extension of time provisions.

### Part 15 General Extension of Time Provisions

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#### 2.1 Times, for doing of prescribed acts and the filing of prescribed documents, that are extendible

2.1.1 Times for serving evidence and further evidence (paragraphs 21.28(1)(f) and (h)) in opposition matters are extendible in a manner to be determined by the Registrar and at the Registrar's discretion. Applications to extend these periods are made under reg 5.15 whether or not the time to be extended has already expired.

### Part 51 GENERAL OPPOSITION PROCEEDINGS

#### 3. Applications for extension of time for serving evidence

2.1.2 Time for filing notice of opposition to the registration of a trade mark (paragraph 21.28(2)(a)) is extendible in the circumstances set out in regs 5.2, 5.3 and 5.4.

### Part 47 PROCEDURES FOR OPPOSING AN APPLICATION FOR REGISTRATION

#### 2. Application for an extension of time to lodge a notice of opposition

#### 2.2 Times, for doing of prescribed acts and the filing of prescribed documents, that are not extendible

2.2.1 The time allowed for meeting minimum filing requirements (reg 4.2) - this act is prescribed by paragraph 21.28(1)(a).

2.2.2 The time allowed (two working days), after the filing in Australia of an application, to claim priority based on the filing of an application in a Convention country (subsection 29(1), reg. 4.5) - this act is prescribed by paragraph 21.28(aa).

2.2.3 The six month period allowed from filing an application in a Convention country for filing in Australia in the circumstances described in paragraph 29(1)(b) of the Act - this act is prescribed by paragraph 21.28(1)(b).

2.2.4 The time allowed to file a divisional application for part of a trade mark (section 47, reg. 4.16) - this act is prescribed by paragraph 21.28(1)(c).

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2.2.5 The times allowed to file divisional applications for goods and/or services excluded from initial applications (subsections 49 (2) and (4), reg. 4.17) - these acts are prescribed by paragraphs 21.28(1)(d) and (e).

2.2.6 The time allowed for requesting deferment of acceptance (section 36 and reg 4.13) - this act is prescribed by paragraph 21.28(ea).

2.2.7 The times for serving a copy of a notice under regulation 5.8, 5.11 or 5.13.- these acts are prescribed by paragraph 21.28(1)(g).

2.2.8 The time allowed for a person claiming a right or interest in a trade mark to respond to a notification regarding cancellation of registration of the trade mark (section 84 and subregs 8.1(2) and (3)), assignment or transmission of the trade mark (section 111 and reg 10.5), or a request to cancel the recordal of the claimed interest (section 115 and subreg. 11.3(4)). These acts are prescribed by paragraphs 21.28(1)(i), (l) and (m).

2.2.9 The time allowed before publication of the particulars of an application to register a trade mark within which amendment of those particulars may be requested (section 64 and reg. 6.2) - this act is prescribed by paragraph 21.28(1)(j).

2.2.10 The time for renewal of a registration after the expiry of the period allowed by section 79 - this act is prescribed by paragraph 21.28(1)(k).

2.2.11 Times allowed by the Chief Executive Officer of Customs in Part 13 and by the Australian Competition and Consumer Commission in Part 16 - these acts are prescribed by paragraphs 21.28(1)(n), (o), (p) and (q) of the Regulations.

2.2.12 The time allowed for filing a notice of opposition to an extension of time of more than 3 months (subsections 224(5) and (6) and reg. 21.26) - this document is prescribed by paragraph 21.28(2)(b).

### Part 15 General Extension of Time Provisions

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## 2.3 Time for filing a convention application

The period of six months after the filing of an application in a convention country for filing an application in Australia claiming priority from the earlier application, is not extendible. This was clarified by an amendment to the Trade Mark Regulations in September 1999 (*Trade Mark Amendment Regulations 1999 (No 2) 1999 No 186*).

### Part 11 CONVENTION APPLICATIONS

## 15.3 Circumstances in which the Registrar must

## extend time

If a relevant act has to be done within a certain time and it is not or cannot be done in that time because of an error or omission on the part of a trade marks employee, the Registrar must extend the time for the doing of the act.

3.1 If error or omission on the part of a trade marks employee is established, the Registrar must extend the time. The Registrar has no discretion in this matter.

3.2 The error or omission may be discovered and acted upon by the Registrar.

3.3 The error or omission may be brought to the Registrar's attention by the applicant or the applicant's agent, or by a third party.

3.4 In cases where the matter is not clear cut, the Registrar may require the person to make application in writing for the extension of time, supported by a declaration setting out the circumstances of the case. Reg 21.33 empowers the Registrar to ask  
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for any documents not otherwise required by the Act or Regulations that are necessary to the proceedings.

3.5 Examples of error or omission by a trade marks employee could include:

- failure to send notification required by the legislation;

- failure to act on an application, notice or request;

- failure to act as soon as practicable (section 204) (late response to an applicant's reply to an examiner's report)

3.6 Some guidance on what has been considered by the courts to constitute error or omission in the context of paragraph 131(1)(b) of the 1955 Act can be found in *Lyons (trading as Mitty's Authorized Newsagency) v Registrar of Trade Marks* (1983) 1 IPR 416 at 429 (FC).

3.7 Even if an extension of time granted under subsection 224(1) is for a period of more than three months, it is not subject to advertisement for opposition since subsection 224(5) does not relate to subsection 224(1).

## 15.4 Confirmation of extension of time practice where a response is received within three (or less) weeks of the lapsing date

Many responses to examiner's reports are filed close to or at the end of the period allowed. The practice to be followed in these circumstances is set out below.

Under regulation 4.10 the Registrar must consider the response and either accept the application or issue an adverse report in writing. The report must include the lapsing date.

#### Part 15 General Extension of Time Provisions

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Although there is an obligation on the applicant to provide the Registrar with sufficient time to consider and report on an application before it lapses, every effort should be made by the examiner to respond to submissions as soon as practicable.

4.1 The examiner's ability to consider and report on an application before it lapses will be affected by a number of factors including:

- the time taken for the submission to reach the examiner;
- the nature of the submission (and whether it is accompanied by evidence);
- the examiner's immediate workload and priorities.

In view of this the Registrar will give due consideration to allowing a free extension of time (if required) where a response filed prior to the lapsing date places the application in order for acceptance. In such a case an extension of time will be allowed until the date on which the acceptance officer approves acceptance.

**Note:** This is contrary to the comment at 1.1 where it is stated that the basic unit of extension is one calendar month.

4.2 Where the response does NOT place the application in order for acceptance, the examiner will contact the applicant as soon as practicable before issuing the adverse report in writing. It should be noted that the date on which the application will or did lapse must be included in the report.

4.3 Where the response is filed after the application lapses, the examiner will contact the applicant urgently, by phone if possible, to advise that an extension of time is required. At such time it is appropriate to give the applicant some idea of whether the ground/s for rejection are likely to be maintained. If the applicant cannot be contacted via phone, the examiner will send a letter to the applicant, advising that the application must be revived before further examination can occur.

**Note:** When dealing with responses coming in very close to the final date, examiners should check the correspondence file to see whether the applicant has requested

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and paid for an extension of time. If the applicant has paid for an EOT, this should be actioned before any consideration of the submissions takes place.

### 15.5 Grounds on which the Registrar may grant an

## extension of time

Section 224 provides three grounds on which an application for an extension of time may be made. The grounds apply to applications made before or after the time for the doing of the relevant act has expired (section 224(4)). The ground(s) on which the application is being made should be indicated in the application, with the facts on which the ground/s are based set out in an accompanying declaration (reg. 21.25).

The grounds are:

- error or omission by the person concerned or by his or her agent;
- circumstances beyond the control of the person concerned; and
- special circumstances exist to justify the extension.

### 5.1 Error or omission by the person concerned or by his or her agent

The grant of an extension of time on these grounds is discretionary and will depend on the circumstances of the case. Under the 1955 Act, the special circumstances provision of reg. 69 has been interpreted to encompass error or omission by the applicant or agent. The case law attaching to this provision may provide some guidance on what constitutes error or omission on the part of the applicant or agent - see *Genentech Inc. v Wellcome Foundation Ltd* (1988) 11 IPR 401 (Comm), applied in *D'Urban Inc v. Canpio Pty Ltd* (1990) AIPC 90-658 (Reg).

Acceptance by the Registrar of a particular instance being classified as an error or omission by the applicant or agent will depend upon the individual circumstances and Part 15 General Extension of Time Provisions

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background of the case. Any submissions regarding an extension sought on this ground would need to satisfy the Registrar that the need for the extra time was caused by a **genuine** error or omission on the part of the person concerned, or his or her agent. Given the impact that the extension sought might have on other parties, the Registrar would be unlikely to grant the extension because someone merely "forgot" to carry out an action.

### 5.2 Circumstances beyond the control of the person concerned

This is a force majeure provision and the grant of an extension of time on these grounds is discretionary.

5.2.1 This provision is equivalent to paragraph 131(1)(a) of the 1955 Act. The scope of that provision was considered in *Atomic Skifabrik Alois Rohrmoser v Registrar of Trade Marks* (1987) 7 IPR 551 at 558 (FC), the case providing guidance on interpretation of "circumstances beyond the control of the person concerned".

5.2.2 The situations encompassed by this provision would cover circumstances

which neither the person nor his or her agent could prevent, including occurrences such as the following

- wars and terrorism
- industrial action (strikes, lockouts),
- machinery breakdowns
- arson and vandalism, and
- the forces of nature such as storms, earthquakes and floods.

### **5.3 Special circumstances exist to justify the extension**

The grant of an extension of time on these grounds is discretionary and will depend on the circumstances of the case.

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The particulars of each extension of time application will determine whether special circumstances exist that justify the extension of time. Examples of factors that could amount to "special circumstances" include:

- pending non-use actions
- pending hearings
- sickness
- death
- bankruptcy
- particular difficulty in finalising the collection of evidence
- particular difficulty in finalising negotiations.

The provision of timetables setting down estimated completion dates will generally be of assistance. If the applicant can show that real endeavours to finalise the application are being made, this may also be of assistance. This could include the lodgement of:

- evidence of use
- a letter of consent
- advice or request relating to amendment of a statement of goods/services.

However, it is extremely unlikely that the Registrar would consider the extension of time application favourably if the applicant relied on the same set of circumstances as those used to support an earlier extension of time application.

If the Registrar does not consider that the extension of time is adequately supported and justified, the applicant may be invited to provide such extra information (in declaratory form) as may satisfy the Registrar that allowance of the extension of time is justified. In such cases, the applicant will be given 14 days in which to provide more information.



The applicant may, in accordance with section 203 of the Act, apply to be heard on the matter of an extension of time application.

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### 15.6 Form of the application

Reg 21.25 states that an application for an extension of time for doing a relevant act must be in an approved form and must be accompanied by a declaration.

6.1 To be in an approved form, the application should include:

- the relevant trade mark number(s),
- name, address and address for service of the person applying for the extension,
- length of the extension,
- period to be extended, eg period in which to register the trade mark,
- the grounds on which the application is based.

6.2 The declaration should be in accordance with reg 21.6. The declaration should support the grounds for the application by setting out the facts on which the grounds for requiring the extension are based. If the application is made after the period has expired, the declaration should also set out why the application is late.

### 15.7 Review of the Registrar's decision

Review of a Registrar's decision not to extend time for the doing of a relevant act may be sought from the Administrative Appeals Tribunal (AAT) (subsection 224(7)).

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7.1 If the Registrar makes a decision not to extend the time, either on the basis of consideration of the application for an extension of time, or as a result of an opposition to that extension, as described above, the applicant for the extension may apply to the AAT to have the decision reviewed.

7.2 If there has been opposition and the Registrar allows the extension of time, the unsuccessful opponent to an extension of time of more than three months does not have a statutory right of appeal under the *Trade Marks Act 1995* but may seek a review of the decision in the Federal Court under the *Administrative Decisions (Judicial Review) Act 1977* (the AD(JR) Act).

## 英國商標法

**78.** - (1) The Secretary of State may make rules-

(a) for the purposes of any provision of this Act authorising the making of rules with respect to any matter, and

(b) for prescribing anything unauthorised or required by any provision of this Act to be prescribed, and generally for regulating practice and procedure under this Act.

(2) Provision may, in particular, be made-

(a) as to the manner of filing of applications and other documents;

(b) requiring and regulating the translation of documents and the filing and authentication of any translation;

(c) as to the service of documents;

(d) authorising the rectification of irregularities of procedure;

(e) prescribing time limits for anything required to be done in connection with any proceedings under this Act;

(f) providing for the extension of any time limit so prescribed, or specified by the registrar, whether or not it has already expired.

## 英國商標法施行細則

### ***Alteration of time limits (Form TM9)***

**68.** - (1) The time or periods-

(a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (3) below, or

(b) specified by the registrar for doing any act or taking any proceedings, subject to paragraph (2) below, may, at the written request of the person or party concerned, or on the initiative of the registrar, be extended by the registrar as she thinks fit and upon such terms as she may direct.

(2) Where a request for the extension of a time or periods prescribed by these Rules-

(a) is sought in respect of a time or periods prescribed by rules 13 to 13C, 18, 23, 25, 31, 31A, 32, 32A, 33, 33A or 34, the party seeking the extension shall send a copy of the request to each person party to the proceedings;

(b) is filed after the application has been published under rule 12 above the request shall be on Form TM9 and shall in any other case be on that form if the registrar so directs.

(3) The rules excepted from paragraph (1) above are rule 10(6) (failure to file address for service), rule 11 (deficiencies in application), rule 13(1) (time for filing opposition), rule 13A(1) (time for filing counter-statement), rule 23(4) (time for filing opposition), rule 25(3) (time for filing opposition), rule 29 (delayed renewal), rule 30 (restoration of registration), rule 31(3) (time for filing counter-statement and evidence of use or reasons for non-use), rule 32(3) (time for filing counter-statement), rule 33(6) (time for filing counter-statement), and rule 47 (time for filing opposition).

(4) Subject to paragraph (5) below, a request for extension under paragraph (1) above shall be made before the time or period in question has expired.

(5) Where the request for extension is made after the time or period has expired, the registrar may, at her discretion, extend the period or time if she is satisfied with the explanation for the delay in requesting the extension and it appears to her to be just and equitable to do so.

(6) Where the period within which any party to any proceedings before the registrar may file evidence under these Rules is to begin upon the expiry of any period in which any other party may file evidence and that other party notifies the registrar that he does not wish to file any, or any further, evidence the registrar may direct that the period within which the first mentioned party may file evidence shall begin on such date as may be specified in the direction and shall notify all parties to the dispute of that date.

(7) without prejudice to the above, in the case of any irregularity or prospective irregularity in or before the Office or the registrar which-

(a) consists of a failure to comply with any limitation as to times or periods specified in the Act or these Rules or the old law as that law continues to apply and which has occurred or appears to the registrar as likely to occur in the absence of a direction under this rule, and

(b) is attributable wholly or in part to an error, default or omission on the part of the Office or the registrar and which it appears to her should be rectified, she may direct that the time or period in question shall be altered in such manner as she may specify upon such terms as she may direct.

## 歐盟共同體商標條例

### 第78條 權利的恢復

1·共同體商標申請人或所有人或者申訴案的任何當事人，儘管根據情況需要作了一切努力但仍未能按時到達協調局的，由此根據本條例的規定而造成喪失權利或喪失補救措施的直接後果的，經申請，應重新確立其權利。2·申請應自消除不能履行時效的原因之後兩個月內以書面形式提交。未履行的行為應在此期間完成。書面申請須在未遵守時限期滿之日起一年內提出。未提交續展註冊申請的，或者未繳納續展費的，第47條第3款第3句規定的六個月延展期應從一年期限減去。

3·申請書必須說明申請所依據的理由，而且必須闡述所依據的事實。在繳納重新確立權利的費用之前，申請不視為已經提交。

4·對未履行的行為作出決定的主管部門應對申請作出決定。

5·本條各項規定不應適用於本條第2款，第29條第1款和第42條第1款所指的時效。

6·共同體商標申請人或所有人已重新確立其權利的，他不可以援用其權利反對在共同體商標申請權或商標權喪失和所提權利重新確立公告期間已善意地將帶有相同或近似的共同體商標的商品投放市場或提供了服務的第三方。

7·第三方可根據第6款的規定，對所提重新確立的那些權利公告之日起兩個月內對共同體商標申請人或所有人重新確立權利的決定提起訴訟。

8·本條例不應限制成員國就本條例規定的及對成員國當局應予遵守的時效給予回復原狀的權利。

## 德國商標法

### 第九十一條 回復原狀之申請

(1) 任何人因不可歸責於己之事由，至無法遵守專利局或專利法庭所訂之期限，從而

依法導致其權利受損者，得申請復權。此項不適用於提出異議及繳納異議費用之期限。

(2) 復權申請應於其原因消滅後二個月內為之。

(3) 申請狀應記載復權依據之事實。此等事實應於申請時或於處理該項申請之程序時提出表面證據證明之。

(4)

- (4) 任何缺漏之行爲應於申請之期限內補正。如已經補正者，得毋庸提出申請而逕行准爲復權。
- (5) 違法補正期間已逾一年者，不得再申請復權，其缺失之行爲亦不得補正。
- (6) 此項復權申請應由主管該行爲之機關裁判之。
- (7) 復權之裁判不得上訴。
- (8) 如商標專用權人被獲准復權，且於商標註冊權利喪失及回復之期間內，第三人以相同或類似其商標之標誌善意行銷商品或善意提供服務者，該商標之專用權人不得對該第三人就其行爲主張任何權利。