A REFERENCE GUIDE TO THE

AUSTRALIAN TRADE MARK SYSTEM

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Foreword

This text is intended to give the reader an overview of Australian Trade Mark Practice and Procedures.

The text initially provides quick tips for both Australian national applications and International Registrations designating Australia. The tips are intended to be a useful guide to the common practices and pitfalls of the Australian trade mark system. Links are provided to the relevant sections of the text for a more in-depth explanation of the practice of the Australian Trade Mark Office.

As a useful comparison, we have also highlighted some points of difference in the trade mark office practice between Australia and New Zealand. Whilst the practice is very similar for these two countries, there are some important variations which should be noted when a trade mark owner is looking to obtain protection in New Zealand. Please note that New Zealand trade mark law has some differences to Australian trade mark law. However a full examination of these differences is beyond the scope of this work.

The authors have attempted to keep the text as brief as possible so that the text can be used as a quick reference guide which outlines the substantive law, and then briefly explains what procedures are available to the applicant, or to third parties.

We hope that this text will be a useful reference guide for foreign attorneys, agents, paralegals, and IP managers.

Whilst all care has been taken in the preparation of this text, it does not constitute legal advice and it cannot give rise to a client-attorney relationship, nor any liability on the part of the author and/or Pizzeys for any decisions, actions, or inactions taken in reliance of this text.

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Quick Tips

These quick tips seek to highlight common practices and factors to consider when filing and prosecuting trade mark applications in Australia or when dealing with official correspondence received on applications which enter Australia via the Madrid Protocol. Many of these points are discussed in further detail in the main text of this book.

Filing a Trade Mark Application

Types of trade marks

Australia accepts applications for word, logo, shape, 3D, sound, scent and moving marks (**see Section 1**).

Series applications

Series applications are permitted in Australia under limited circumstances (**see Section 1.6**).

Use requirements

The Applicant must at least have an intention to use a trade mark at the date of filing an application. However, there is no requirement to prove use of a trade mark in Australia to mature an application to registration or for maintenance and renewal purposes (**see Sections 6.3 and 6.4**).

Specification of goods/services

Australia accepts broad specifications of goods and services including class headings. If a distinctiveness objection is expected it is recommended that broader or more general terms are included in the specification to allow for the possibility of filing a divisional application at a later date if necessary (**see Section 4.10** on divisional applications).

Colour claim

A trade mark depicted in colour on an Australian application will be interpreted as though it had been filed in black and white unless the Applicant specifically includes a claim to the colours represented in the trade mark.

Power of Attorney

Power of Attorney documents are not required to be submitted to the Trade Mark Office.

Expedited examination

It is possible to request expedition of the examination of an application. This will expedite the examination of the application only, reducing the time for receipt of the first report from approximately 4 months to 4 weeks; all other prosecution timescales remain the same (**see Section 3.6**).

Foreign word marks

All trade mark applications containing or comprised of a foreign word must expressly state the English translation of that word. If the trade mark is in characters which are not Roman letters then a transliteration into Roman letters must also be provided.

Priority

Convention priority claims may be partial priority claims or multiple priority claims and must be made at the time of filing or within 2 days of the filing. Documentation supporting the convention claim is not required unless specifically requested by the Trade Marks Office (**see Section 3.3 and 3.5**).

Examination

Examination grounds

Australia examines on absolute grounds and on relative grounds. Australia is fairly strict with the application of its absolute grounds of examination (**see Section 4.5** for absolute grounds and **Section 4.8** for relative grounds).

Australian address for service

An Australian address for service is required to be entered on applications filed via the Madrid Protocol, prior to a response being filed to any Examination Report.

Examination Report deadline

Where an Examination Report has issued, the Applicant is given a period of 15 months to overcome the issues raised in the report and gain acceptance of the application. The 15 month deadline is the deadline by which the application must be accepted, it is **NOT** the deadline to respond to the Report (**see Section 4.2**).

Extensions of time

It is possible to obtain an extension of time for the acceptance of an application. Extensions are usually obtained in blocks of 1–3 months. A total extension period of 6 months is readily available to all applicants (**see Section 4.3**).

Deferment

The time limit for acceptance of an application may be suspended in certain circumstances. The most common occasion is where a prior mark has been cited as a barrier to registration and where the cited mark is pending or its status on

the Register is being challenged. You may elect to continue with the prosecution of the application whilst examination is deferred. As deferment effectively places a stop on the time given to gain acceptance of an application, it is recommended that deferral is requested as soon as its availability is identified (**see Section 4.11**).

Letters of Consent

Letters of consent are considered by the Trade Mark Office but are of a persuasive not binding nature. It is **essential** that the letter of consent agrees to the use and registration of the relevant trade mark in Australia (**see Section 4.9**).

Divisional applications

It is possible at any time prior to registration of a national application (not an application filed via the Madrid Protocol) to request that the application be divided. The divisional application must contain only part of the goods or services claimed in the parent application. The divisional application is able to adopt the priority, including any convention priority, of the parent application and is fully re-examined once filed. A divisional application is a useful tool for perpetuating applications which are experiencing problems during examination (**see Section 4.10** on divisional applications).

Oppositions

Opposition period

The opposition period is **3 months** from the date of publication of acceptance.

Extension of opposition deadline

The opposition period may be extended ONCE for a period of 1, 2 or 3 months (**see Section 5.3**).

Opposition grounds

At present it is usual for all of the available grounds of opposition under the Trade Marks Act to be recited in the Notice of Opposition. The grounds of opposition which are actually argued at a hearing may be limited once all of the evidence has been served (**see Section 5.1**).

Defence

At present an applicant who receives a Notice of Opposition is not required to formally defend the opposition proceedings by the filing of a Defence or a Counter-Statement. The proceedings may continue on to a decision totally undefended. It is up to the Opponent to establish that the trade mark ought not to be registered.

Non-Use Actions

Non-use period

A registered trade mark becomes vulnerable to removal for non-use in Australia five years after the **filing date** of the application. Where a non-use application is lodged, the registration may be removed if the owner is not able to show use of the trade mark in good faith **in Australia** in the preceding three years (**see Section 6.4** on non-use actions).

Onus on owner

The onus is on the owner of the registration to oppose a non-use application. If no opposition is lodged, the registration will be removed. Where an opposition is lodged, the onus is on the owner to show use of the trade mark within the relevant period or to establish one of the defences available under the Trade Marks Act

Person aggrieved

It is no longer a requirement in Australia that a person filing a removal for non-use application also be able to establish themselves as a person aggrieved by the continued registration of the challenged trade mark.

National Applications v Madrid Protocol

The following highlights some differences between the Australian National filing system and the Madrid Protocol system which may assist you to choose which filing system to use for your particular circumstances (**see Sections 3.1 and 3.2**).

Potential restriction of statement of goods/services

The goods and services contained in a trade mark application filed in Australia by way of the Madrid Protocol must be identical to, or narrower than that covered by the basic trade mark. For basic trade marks filed in countries like the USA, this means that the protection available in Australia may be narrower than that which may be obtained via a national filing. If the basic application is for a particularly narrow range of goods or services, it may be worthwhile considering filing a national application to obtain broader protection for the trade mark in Australia.

Divisional applications not permitted

It is not possible to file a divisional application from an International Registration designating Australia. The ability to use the divisional process often provides a useful tool for overcoming objections raised by the Australian Trade Mark Office, particularly when there are issues of distinctiveness. Please note that Australia is fairly strict in applying its absolute grounds of examination. Therefore, we recommend using the National filing system for marks which are likely to be considered not inherently distinctive.

Cannot object to an extension of time to oppose

If an Australian designation on an International Registration has an Extension of Time to Oppose filed against it by a third party, the holder of the International Registration is not provided with an opportunity to object to the granting of the extension. However, an applicant for a national application is provided with the opportunity to object to the granting of the extension of time to oppose if it believes the grounds claimed in the extension are untrue or unjustified.

Statement of Protection

Australia does issue a Statement of Protection for International Registrations designating Australia. However a formal Certificate of Registration is not issued for these trade marks.

1

Types of Trade Marks

1.1 Types of Trade Marks

There are four types of trade marks provided for under the Trade Marks Act, 1995 (Cth) (hereafter referred to as the "**Act**"), namely:

(1) Standard Trade Marks

(2) Defensive Trade Marks

(3) Certification Trade Marks

(4) Collective Trade Marks

This guide primarily focuses upon the practice and procedure applicable to standard trade marks, although a short discussion of the alternative forms of trade marks is provided below. Many of the practices and procedures associated with standard trade marks are also applicable to the other trade mark types.

1.2 Standard Trade Mark

A standard trade mark is a:

> *"sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person."*[1]

This can include words, logos, devices, shapes, colours, sounds and even scents.

A standard trade mark is usually owned by individuals or companies for the purposes of distinguishing their goods and services from those of other traders.

1.3 Defensive Trade Marks

Australia is one of the few trade mark jurisdictions where it is possible to obtain a defensive trade mark registration. A defensive trade mark is enforceable in the same manner as a standard trade mark. However the defensive trade mark is actually a powerful asset as it is a trade mark which may cover goods and services for which the owner has no intention to use its trade mark.

The Act describes the prerequisite for a defensive trade mark as:

> *"If, because of the extent to which a registered trade mark has been used in relation to all or any of the goods or services in respect of which it is registered, it is likely that its use in relation to other goods or services will be taken to indicate that there is a connection between those other goods or services and the registered owner of the trade mark, the trade mark may, on the application of the registered owner, be registered as a defensive trade mark in respect of any or all of those other goods or services."*[2]

Defensive trade marks differ from standard trade marks as follows:

- they are not vulnerable to removal for non-use as there is no statutory requirement that a defensive trade mark be used in Australia or that the applicant even have an intention to use the trade mark in respect of the registered goods and services;
- the defensive trade mark must be akin to a "well known" mark in Australia. Evidence of reputation must be provided before a registration can be obtained;

1 Trade Marks Act, 1995 (Cth), s17
2 Trade Marks Act, 1995 (Cth), s185

- the applicant must already own a registration for its "well known" mark before applying for a defensive registration of the same mark.
- the goods or services covered by a defensive trade mark may include the goods and services contained on the standard registration for the same trade mark, as well as goods and services which the applicant does not use or intend to use the trade mark upon. However the goods and services upon which there has been no use or for which there is no intention to use the trade mark, are limited to those which would, if the trade mark were used upon them by another trader, be likely to be taken to indicate that there is a connection between those goods and services and the registered owner of the standard trade mark; and
- evidence of reputation and likelihood of connection between the goods and services of the defensive application and the owner of the standard trade mark must be filed at the time of applying for the defensive trade mark or very soon afterwards.

Accordingly, a defensive trade mark does not provide an owner of a well known mark with a registration for all possible goods or services; there must be some likelihood of connection between the owner of the standard trade mark registration for the well known mark and those claimed by the defensive trade mark application. The factors which the Australian Trade Marks Office indicates may establish that the relevant connection exists are:

- the level of inherent distinctiveness of the trade mark itself; an invented mark has a higher prospect of a connection occurring than a less distinctive trade mark;
- the number of trade mark registrations already held for the trade mark by other proprietors; there is a lower prospect of a connection occurring if many other traders are already using the same trade mark;
- the extent of use made of the registered trade mark by the applicant; both the intensity of marketing and duration of use are considered;
- the nature of the goods and services upon which the trade mark has been used by the applicant; highly specialised goods and services are less likely to lead to the requisite connection being made;

… a defensive trade mark does not provide an owner of a well known mark with a registration for all possible goods or services …

- the nature of the goods and services upon which the defensive registration is being sought and whether there is likely to be some connection made between those goods and services and the goods and services upon which the reputation currently resides, the connection may be a trade connection, an apparent sponsorship, endorsement or even may be that it appears that the applicant has entered into a strategic alliance with an entity that provides such goods or services; and
- provision of supportive industry declarations from independent third parties attesting to the likelihood of a connection occurring.

Please note that the examination process for defensive trade marks is extremely stringent and there is a heavy onus upon the applicant to show a significant reputation in Australia under its trade mark.

Some defensive trade marks on the Register at present include:

- VIAGRA for a vast range of goods and services including alcoholic beverages (see Registration No. 894613)
- COCA-COLA for various goods in class 30 including coffee and cakes (see Registration No. 940056)
- VEGEMITE (an Australian iconic brand of sandwich spread) for a vast range of goods and services including side arms and buses (see Registration Nos. 938276 and 1034150).

In New Zealand, there is **no** provision of the registration of defensive trade marks

1.4 Certification Trade Marks

The Act describes certification marks as follows:

"A certification trade mark is a sign used, or intended to be used, to distinguish goods or services:

(a) *dealt with or provided in the course of trade; and*

(b) *certified by a person (owner of the certification trade mark), or by another person approved by that person, in relation to quality, accuracy or some other characteristic, including (in the case of goods) origin, material or mode of manufacture;*

from other goods or services dealt with or provided in the course of trade but not so certified."[3]

3 Trade Marks Act, 1995 (Cth), s169

Certification marks are used by traders to identify to the relevant consumer that their goods or services are of a certain quality, accuracy or that they meet some other standard or criteria.

Certification trade marks have a set of governing rules and criteria which the user of the trade mark must comply with. The rules of the certification trade mark are filed with the trade mark application and are accessible to the public. The rules must be approved by the Australian Competition and Consumer Commission as not being against the public interest before a certification trade mark may become registered.

The registered owner of a certification trade mark is permitted to use the certification trade mark in Australia.

Some certification trade marks on the Register at present include:

- owned by The Woolmark Company Pty Limited to certify goods where the fibre content of such goods is at least 95% pure new wool (see Registration No. 328924)
- owned by Australian Made Campaign Limited to certify goods manufactured in Australia (see Registration No. 451318)

1.5 Collective Trade Marks

A collective trade mark is described by the Act as:

> *"a sign used, or intended to be used, in relation to goods or services dealt with or provided in the course of trade by members of an association to distinguish those goods or services from goods or services so dealt with or provided by persons who are not members of the association."*[4]

A collective trade mark is used by traders to indicate that they belong to a particular association or professional body. It is not used as a standard trade mark would be, i.e. to show that the goods/products come from a particular source. A collective trade mark must be in the name of an association rather than in a member's name. Each member of the association has the right to use the trade mark in accordance with the rules of the association; a member does not have the right to prevent another member from using the mark.[5]

One major limitation of a collective trade mark is that they may not be assigned or transmitted.[6]

4 Trade Marks Act, 1995 (Cth), s162
5 Trade Marks Act, 1995 (Cth), S165
6 Trade Marks Act, 1995 (Cth), s166

Some collective trade marks on the Register at present include:

-

owned by International Alliance of Research Universities (see Registration No 1124464)
-

owned by International Accreditation Forum, Inc. (see Registration No. 1179932)

1.6 Series Trade Marks

A series trade mark is a form of standard trade mark described in the Act as being:

> *"… a single application under subsection 27(1) for the registration of 2 or more trade marks in respect of goods and/or services if the trade marks resemble each other in material particulars and differ only in respect of one or more of the following matters:*
>
> (a) *statements or representations as to the goods or services in relation to which the trade marks are used or are intended to be used;*
>
> (b) *statements or representations as to number, price, quality or names of places;*
>
> (c) *the colour of any part of the trade mark."*[7]

Therefore a series application permits a trade mark application to cover more than one trade mark provided that the trade marks claimed "resemble each other in material particulars" <u>and</u> differ only in respect to one or more of the listed features. Examples of how the marks may differ are as follows:

- Statements or representations as to the goods or services in relation to which the trade marks are to be used: it may be possible to obtain a series trade mark registration for

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  provided that the application claimed both trade mark and patent attorney services;
- Statements or representations as to number, price, quality or names of places: it may be possible to obtain a series registration for

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  PIZZEYS BRISBANE
  PIZZEYS CANBERRA

7 Trade Marks Act, 1995 (Cth), s51

- The colour of any part of the trade mark: this would effectively permit the following two marks as a series application:

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AUSTRALIA and NEW ZEALAND

Should the Trade Mark Office reject an application to register a series of trade marks, the applicant will be provided an opportunity to amend the series of marks so as to overcome the objection by deleting any trade marks which are not deemed to properly form a series.

Please note that if a mark is deleted from a series because it was an improper series, it is not possible to file a divisional application for the deleted mark. A fresh application must be filed, which may be afforded a later priority date. Therefore, it is important to obtain advice from a local Australian trade mark attorney before filing a series application.

In New Zealand, the criterion for a series application differs from that in Australia.

In New Zealand, a series of marks must:

(1) *Resemble each other in their material particulars; and,*

(2) *Differ from each other only in terms of:*

(a) *Statements of the goods or services for which the marks are used, or are proposed to be used; or*

(b) *Statements of number, price, quality or names of places; or*

(c) *Other matters of a non-distinctive character that do not substantially affect the identity of the trade mark; or*

(d) *Colour.*[8]

As in Australia, the trade marks must resemble each other in their "material particulars"; however, in New Zealand, the marks can differ in "other matters of a non-distinctive character that do not substantially affect the identity of the trade mark". Therefore, a series application for FASTFOTO and FAST-FOTO would be accepted in New Zealand but may not be accepted in Australia.

8 NZ Trade Mark Act, 2002, s5

2

Main Principles for Comparison of Marks in Australia

2.1 Introduction

A summary of some main principles of Australian trade mark law with respect to the comparison of trade marks is provided below as an easy reference guide. Where relevant, reference is made to the fundamental case law.

2.2 Comparison of Marks: substantial identity

Under s44 of the Act, an application will be rejected if the trade mark is "substantially identical with" a prior registration or application which has an earlier priority date in respect of similar or closely related goods or services.

If the marks are not identical, the Trade Marks Office will consider in the first instance whether the marks are "substantially identical".

The test for substantial identity was laid down by Windeyer J in *Shell Co. (Aust) Ltd v Esso Standard Oil (Aust) Ltd* (1963) 109 CLR 407 at 414–415:

> *In considering whether marks are substantially identical they should, I think, be compared side by side, their similarities and differences noted and the importance of these assessed having regard to the essential features of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison.*

In most cases, the issue of whether a mark is substantially identical is not critical. If the marks are not found to be substantially identical there may still be a risk of conflict due to the deceptive similarity of the marks.

However, in Australia, a finding of substantial identity must be found in certain circumstances such as if a trader is attempting to oppose a trade mark on the basis that the applicant is not the owner of the mark due to prior use made by the opponent. To succeed on such grounds the opponent's trade mark must be substantially identical with the applied for mark; deceptively similarity is not enough.

2.3 Comparison of Marks: deceptive similarity

Also under s44 of the Act, an application will be rejected if the trade mark is "deceptively similar to" a prior registration or application which has an earlier priority date in respect of similar or closely related goods or services.

Deceptive similarity is defined by s10 of the Act:

> *For the purposes of this Act, a trade mark is taken to be deceptively similar to another trade mark if it so nearly resembles that other trade mark that is likely to deceive or cause confusion.*

The issue of deceptively similarity was also considered by Windeyer J in *Shell Co. (Aust) Ltd v Esso Standard Oil (Aust) Ltd* (1963) 109 CLR 407 at 414–415:

> … *On the question of deceptive similarity, a different comparison must be made from that which is necessary when substantial identity is in question. The marks are not now to be looked at side by side. The issue is not abstract similarity, but deceptive similarity.*

Therefore the comparison is the familiar one of trade mark law. It is between, on the one hand, the impression based on recollection of the plaintiff's mark that persons of ordinary intelligence and memory would have; and, on the other hand, the impressions that such persons would get from the defendant's television exhibitions.

The rules of comparison for deceptive similarity in Australia from a number of cases have been summarised below:

- Whether a mark is "deceptively similar" is not to be determined by a side-by-side comparison, but rather by reference to whether there is a likelihood of deception or confusion from a recollection or impression of the registered mark: *Anheuser-Busch Inc v Budejovicky Budvar* (2002) 56 IPR 182;
- It is necessary to make an attempt to estimate the effect or impression produced on the mind of persons of ordinary intelligence and memory. It is the impression or recollection which is carried away and retained that is necessarily the basis of any mistaken belief that the challenged mark is the same: *Australian Woollen Mills Ltd v F S Walton & Co Ltd* (1937) 58 CLR 641;
- The "recollection" may be imperfect: *Crazy Ron's Communications Pty Ltd v Mobileworld Communications Pty Ltd* (2004) 209 ALR 1;
- To show that a trade mark is deceptively similar to another it is necessary to show a real tangible danger of deception or confusion occurring. A mere possibility is not sufficient. *Registrar of Trade Marks v Woolworths Ltd* (1999) 93 FCR 265;
- The question whether there is a likelihood of confusion is to be answered, not by reference to the manner in which the respondent has used its mark in the past but by reference to the use to which it can properly put the mark. The issue is whether the use would give rise to a real danger of confusion *Berlei Hestia Industries Ltd v Bali Co Inc* (1973) 129 CLR 353.

2.4 Comparison of Goods and Services

In addition to the testing of applications against prior marks on the Register for substantial identity and deceptive similarity, s44 of the Act also requires consideration of whether the goods and services claimed by the application are similar or closely related to those covered by the prior mark which has been found to be substantially identical or deceptively similar.

2.4.1 Similar Goods/Services

Section 14(1) of the Act defines "similar goods" and "similar services" as being goods or services which are the same as, or of the same description as, the other goods or services in question.

Unfortunately, the term "same description" is not defined under the Act.

When deciding whether goods or services are similar and thus of the same description, the Trade Mark Office will consider the various factors laid out by Romer J in the case of *Jellinek's Appn* (1946) 63 RPC 389:

- **The nature of the goods or services** – are the characteristics of the goods or services the same and are they usually produced by one manufacturer or provided by one provider;
- **The uses of the goods or services** – are they competitive and/or substitute goods or services; and,
- **The purpose of the goods or services** – are they sold through the same trade channels to the same class or classes of customers for the same usage?

Please note that whilst the phrase "of the same description" does not mean only those goods or services which are equivalent to each other, the interpretation of goods or services "of the same description" or "similar" is taken as being narrower than in other jurisdictions.

To illustrate this point, below is a summary of goods and services which have been found to be similar and those which have been found to be dissimilar:

Goods found to be similar/of same description	
watches	jewellery
brandy	rum
women's lingerie	hosiery
milk beverages	chocolate or coffee beverages in class 30

Goods found to be dissimilar/not of same description	
watches	clothing and footwear
beer	wine
clothing & footwear	sports equipment
olive oil	coffee

Services found to be similar/of same description	
retailing services	distribution services
alcoholic bar services	nightclub services
resale of computer hardware	computer software services
insurance services	travel services

Services found to be dissimilar/not of same description	
hotel management	property management
restaurant services	nightclub services
catering services	restaurant services
computer software design	computer software training

2.4.2 Closely Related Goods/Services

There are no particular tests afforded to the assessment of whether a good is closely related to a particular service or vice versa.

In *Caterpillar Loader Hire (Holdings) Pty Ltd v Caterpillar Tractor Co* (1983) 1 IPR 265, Lockart J commented:

> *Confusion is more likely to arise where services protected by service marks necessarily involve the use or sale of goods or where services (for example, consultancy services) involve goods but can be provided either with or without the sale or promotion of the goods.*

More recently in *Registrar of Trade Marks v Woolworths Ltd* (1999) 93 FCR 356, French J noted:

> *The relationship may, and perhaps in most cases will, be defined by the function of the service with respect to the goods. Services which provide for the installation, operation, maintenance or repair of goods are likely to be treated as closely related to them.*

In practice, the notion of closely related goods and services usually is of issue in relation to goods and retail services. In Australia, whilst there may be some level of overlap between retail services and goods sold via retail outlets, this is not usually held to be a case of closely related goods and services. However, where an application has been made for a trade mark covering Class 12, 14 and 25 goods (vehicles, jewellery and clothing), it will be held that retail services for those goods will be closely related services. Even if the retail services do not specify those goods and are of a broad nature, it may still be held that the retail services are closely related to the Class 12, 14 and 25 goods as there is a risk that consumers would assume the goods and services originate from the same source. For example, it is common for clothing manufacturers to also provide retail services for their goods.

3

Filing an Application

3.1 National Application

An applicant may obtain registered trade mark protection in Australia by filing a national application.

This type of application provides benefits to the applicant which are not available to applications made under the Madrid Protocol system, including the ability to file divisional application(s) and to make broader claims for goods and services than those claimed under the applicant's basic application under the Madrid Protocol system.

An Australian address for service is required on all national applications.

3.2 International Applications via the Madrid Protocol

Australia is party to the Madrid Protocol.[9]

9 Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, 1989

The Madrid Protocol is a treaty for the international registration of trade marks. As Australia is party to the Madrid Protocol, an Australian trade mark owner can obtain a single registration to seek protection of its trade mark in multiple overseas markets. Alternatively, overseas individuals and companies who are domiciled in other States party to the Madrid Protocol, may designate Australia as a country under the international registration system and therefore obtain registered protection in Australia without filing a national application.

As per standard practice, an international application must be based upon an existing national application or registration (the basic application or registration). The owner and the trade mark claimed by the international application must be identical to the basic application and the goods or services claimed may not be broader than those contained in the basic application.

In Australia, relatively broad claims of goods and services are permitted. For nationals of countries which only allow very specific and narrow specifications of goods and services, such as the United States, it is important to note that the protection obtained in Australia via the Madrid Protocol system will potentially be more limited in scope than would be obtainable under a national application.

New Zealand is not currently party to the Madrid Protocol. Therefore, at the time of writing, to obtain protection for a trade mark in New Zealand it is necessary to file a national application via IPONZ. A New Zealand address for service is required for all national applications.

3.3 Convention Priority

Australia is party to the Paris Convention[10] and therefore provides for convention claims under Article 4 of the Convention[11].

Applications claiming convention priority in Australia must be filed in Australia strictly within six months of the filing of the priority application upon which the convention claim is made. No extensions of this deadline are available. However, as long as the Australian application is filed within the six month period, the convention claim on the application may be made within two days of filing the Australian application. This period is also **not** extendable.

10 The Paris Convention for the Protection of Industrial Property, 1883

11 Article 4 of the Convention provides that in the case of trade marks, any person who has duly filed an application for the registration of a trade mark, in one of the countries of the Union, shall enjoy for the purpose of filing in other countries, a right of priority of 6 months.

3.4 Filing Requirements

The minimum filing requirements for an Australian national, non-convention application are:

- a representation of the trade mark applied for;
- provision of the applicant's name and address (or contact information of an address for service); and,
- a statement of the goods and/or services for which registration is sought; although these do not need to be classified into Classes to meet the minimum requirements.

Payment of the official application fee must be made when filing the application for the Trade Marks Office to award a filing date.

A trade mark applicant must be an individual or an incorporated body. Australia does not permit Trusts or Partnerships to hold IP rights.

No power of attorney is required to be filed with a national application for registration of a trade mark in Australia.

3.5 Application Requirements for Claiming Priority

In addition to the above minimum requirements, should an applicant wish to claim convention priority, the following details must be submitted:

- a notice of intention to rely upon the convention claim **within 2 days** of filing a qualifying Australian national application;
- the date of lodgement of the priority application; and,
- details of the convention country in which the earlier application was filed.

If available, the application or registration number of the priority application should be provided; however, this can be filed with the Trade Marks Office during the examination stage of the application if it is not available at the time of filing.

Convention priority may be claimed from more than one priority application and partial convention claims may be made if the applicant wishes to include additional, non-convention goods and services in their Australian application.

There is no requirement that documents supporting convention claims be filed. However, on some limited occasions the Registrar may request that a certified copy of the priority application be provided to verify the convention claim made.

3.6 Prosecution Tool: expedited examination

In Australia, trade mark applications are normally examined in the order that they are filed (i.e. first come, first served). However, it is possible to request that the examination of an application be expedited provided that conditions warrant the expedition of the examination e.g. an applicant has located a potential infringer of their trade mark or has had a claim of infringement made against it, or there have been outlays made to promote the trade mark and the Applicant needs to protect their trade mark as soon as possible.[12]

Generally, the examination of a new trade mark application in Australia will be completed within 4 months after the filing of the application. An expedited application is likely to be examined within 3–4 weeks. Should a pending application which has not yet been examined be cited against the expedited application as a result of examination, examination of the cited application will also be expedited.

The examination of all convention applications is automatically expedited by the Office.

Please note that only the initial examination of an application is expedited under this process; the remaining official process for registration of a trade mark will be conducted as per normal timescales.

New Zealand does not provide an official system of expedited examination. However, it is IPONZ policy to examine new applications within 5 working days of receipt; with a Compliance Report being issued or the application accepted for publication, shortly thereafter.

12 Regulation 4.18 ,Trade Marks Regulations, 1995(Cth)

3.7 Prosecution Tool: amendments before publication

It is possible to make significant changes to a trade mark application, including substituting the applied for mark, provided that the amendments are requested prior the application being published electronically on the Register.

It usually takes the Trade Mark Office 2 days after the date of filing to publish the details on the Register; however, this timeframe can be reduced or increased depending upon the backlog at the Trade Mark Office or whether the filing is lodged just before the weekend.

This effectively provides an applicant a short but unrestricted opportunity to amend its application after filing. Thus, if an applicant accidentally opts to file for one version of its mark and realises immediately that the incorrect version has been applied for, such errors can be corrected (usually only within 2 days of filing the application) without losing the priority date or incurring further official cost. Please note that before the amendment is allowed the Registrar must be convinced that the amendment is being made to correct a clerical error or fix an obvious mistake.[13]

13 Trade Marks Act, 1995 (Cth), s64

4

Examination and Prosecution

4.1 Introduction

As with most trade mark registration systems, the Australian Trade Mark Office conducts substantive examination of all new trade mark applications prior to acceptance, irrespective of the type of trade mark (standard, collective, certification, defensive) or type of application (national or international registration designating Australia).

The discussion below focuses primarily upon standard trade marks, although similar factors may also be considered for the other available types of trade marks.

4.2 Deadline for Acceptance

Upon examination of any new trade mark application, if the Examiner is raising an objection to the acceptance of the application the Trade Mark Office will set a deadline for acceptance of the application. This deadline is 15 months from the issue date of the Examination Report for national applications or the Notification of Provisional Refusal for international registrations designating Australia[14].

14 Trade Marks Act 1995 (Cth), s37 and Trade Mark Regulations 1995 (Cth), R4.12

Please note that the above 15 month deadline is **not** the deadline to respond to the Examination Report or the Notification of Provisional Refusal. It is the deadline for **acceptance** of the application in question. Therefore, **prior to the expiry** of the 15 month deadline, the Trade Mark Office must have accepted the application for publication.

If steps are not taken to maintain an un-accepted application beyond the acceptance deadline a national application will lapse and be deemed abandoned. An international registration designating Australia that is not maintained will receive a total refusal of protection or only be accepted for those goods or services to which no objections were raised.

In New Zealand, applicants have a statutory period of 12 months from the filing date of the application to file a response to any issued Compliance Report (Examiner's Report). Unlike Australia this deadline is to file a response to the report and is not a date by which acceptance has to be achieved. If the applicant's response does not satisfy the Examiner, a further report will be issued. A new deadline will be set for the second report if the original deadline has expired. However the period provided for will only be a matter of months. Extensions of the response deadline are available at the discretion of the Examiner.

4.3 Extensions of Time for Acceptance

It is possible to request an extension of time to extend the 15 month period for acceptance of an application.[15]

Extensions are readily available upon payment of the official fee for periods of 1, 2 or 3 months up until a total of 6 months. If extensions are sought beyond 6 months, it is necessary to provide justification for the extension request, including a supporting Statutory Declaration outlining why the extension is sought and the reasons for the delay in addressing the issues raised in the Examination Report.

If the deadline for acceptance has recently passed, it may also be possible to file a late extension of time to resurrect the application.[16] This extension must include a supporting declaration, providing reasons why no action was taken within the prescribed period to request the extension, together with the reasons

15 Trade Marks Act 1995 (Cth), Section 224(1) and Trade Mark Regulations 1995, reg. 4.12

16 Trade Marks Act 1995 (Cth), Section 224(4) and Trade Mark Regulations 1995, reg. 21.25

for the delay in addressing the issues raised in the Examination Report. This type of late extension is usually only awarded in exceptional circumstances and the supporting declaration must state that the applicant had an intention to file an extension of time within the prescribed period, however, circumstances beyond its control prevented it from doing so, i.e. an error or omission on behalf of the applicant's attorneys.

4.4 Examination Grounds: classification

During the formality part of the examination process the Examiner will consider whether the goods and services in the application have been appropriately classified and sufficiently described.

If an item is determined as being classified in the incorrect class then the item may be moved to the appropriate class. If the appropriate class is not present in the application then upon payment of a fee the correct class may be added to the application and the item then moved[17]. However, if the application has been filed in Australia via the Madrid Protocol then it is not possible to add classes to the application or move items between classes.

If the Examiner believes that the description of a good or service is vague or ambiguous then the Examiner may ask for material to be provided which indicates the nature of the item so that its correct classification may be determined. The description of the item may be amended as long as the amendment does not extend the coverage of the application to items which were not previously claimed.

In New Zealand it is also possible to add classes to an application for misclassified goods and services. However the deadline to add a class to the application is one month from the filing date of the application. This deadline is not extendable and the misclassified item must be deleted if the appropriate class is not added within the appropriate time frame.

17 Trade Marks Act 1995 (Cth), s65

4.5 Examination Grounds: distinctiveness

As part of the examination process, the Trade Mark Office will assess an application's inherent capacity to distinguish the goods and services of the applicant from those of other traders. This effectively constitutes an assessment of the trade mark's core ability to function as a trade mark in the marketplace and thus act as a badge of origin for the owner's goods and services. Australia is fairly strict in the application of this ground of examination.

The Office will primarily make an assessment as to whether the mark applied for is "capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered from the goods and services of other persons".[18]

It is Office practice to reject trade mark applications which consist wholly of a sign that is ordinarily used to indicate the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods and services applied for.

The following is a summary of the Australian Office's current practice in respect of certain types of trade mark.

4.5.1 Word Marks

A word mark will be regarded as prima facie inherently registrable unless it describes the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods and services applied for. The more fanciful the word mark, the greater the likelihood it will not be rejected by the Trade Mark Office.

Laudatory, scandalous, obscene and/or offensive word marks are likely to be rejected.[19]

Certain word marks are also prohibited under Australian law specifically those which are declared as prohibited or prescribed signs[20]. There are currently no declared prohibited signs.

18 Trade Marks Act 1995 (Cth), s41(2)
19 Trade Marks Act 1995 (Cth), s42(a)
20 Trade Marks Act 1995 (Cth), s39

4.5.2 Slogans

The Trade Mark Office accepts that slogans have the ability to function as trade marks and does not apply a stricter examination process to slogans than standard word marks per se. However, promotional or motivational statements which are commonly used in the trade are likely to be rejected at the first instance.

Some slogan trade marks on the Register at present include:

- **HAVE A BREAK** owned by Societe des Produits Nestle S.A. for Class 30 goods (see Registration No. 1138447);
- **BECAUSE YOUR WORTH IT** owned by L'Oreal for Class 3 goods (see Registration No. 896313); and,
- **I'M LOVIN IT** owned by McDonalds Corporation for Classes 29, 30, 32 and 43 (see Registration No. 957064).

4.5.3 Geographic References

The Trade Mark Office will usually reject any application to register a geographical location or well known place name as a trade mark. The Office will consider when examining such a mark, whether or not the relevant Australian consumer would be aware of the location and thus associate the relevant goods or services with that location. The Office is often reluctant to immediately afford a monopoly over the use of a geographical location to any one trader without evidence that use of the trade mark has or is likely to cause consumers to associate the mark with the trader.

The Trade Mark Office will refuse to register any application for a trade mark that refers to a geographical location or place which is a well known point of origin for the relevant goods and services. For example, the Office is unlikely to register ISLAY for whisky but it may accept the mark for tropical fruits.

If the mark is a Geographic Indication for the goods then it will not be considered sufficiently distinctive for registration e.g. Barossa for wine. However if the Geographic Indication is in a mark together with other distinctive elements then it may form a mark which is sufficiently distinctive for registration.

4.5.4 Surnames

A common surname is unlikely to be regarded as inherently registrable in Australia by the Trade Mark Office.

As standard practice, the Office will check all applications to register a surname against the Australian Electoral Roll. Should a surname appear on the Electoral Roll more than 750 times, the Office will automatically refuse the application. The onus will then be on the applicant to provide evidence of use showing that the trade mark is capable of distinguishing its goods and services in Australia.

A forename and surname combination may be regarded as inherently registrable, as well as a combination of two surnames.

In New Zealand, IPONZ does not automatically raise distinctiveness objections to applications for common surnames. However, it will consider whether surnames are usually used as a "badge of origin" in the specific industry or trade of the goods and services applied for e.g. the use of the surname JONES for plumbing or electrical trade services is unlikely to be considered inherently distinctive as it is common for surnames to be used in the trade to distinguish one trader from another.

4.5.5 Letter/Number Combinations

Applications to register one letter or number will be refused by the Trade Mark Office unless the applicant is able to provide significant evidence showing the trade mark has acquired a capacity to distinguish through the applicant's use.

Two or more letter/number combinations are more likely to be accepted as inherently registrable, provided that it is not commonplace for traders to use such number/letter combinations to designate the goods or service in the marketplace. For example, the letter combination "XS" is more likely to be accepted for legal services than say, clothing goods or automotive goods, where such letter combinations are commonly used in the trade.

4.5.6 Non Traditional Marks

The Act provides for the registration of a wide variety of trade marks, including *inter alia* letter, word, name, signature, numeral, device, brand, label, ticket, aspect of packaging, shape, colour, sound or scent trade marks.

Whilst the non-traditional marks referred to above (i.e. shape, colour, sound or scent) are examined according to the same criteria as any other trade mark, the Office is often reluctant to afford protection to same without the provision of evidence of use showing the mark is capable of distinguishing.

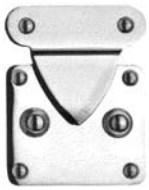
This is especially so for single colour trade marks or shape marks where the shape is lacks novelty or has some element of functionality for the goods claimed.

4.5.6.1 Shape/3D marks

For shape marks or 3D trade marks, there is no express requirement to provide multiple representations of the mark covering all possible views of the shape. However, the submission of multiple images covering multiple views is recommended as this will assist with the interpretation of the trade mark for both the Examiner and third parties.

It is necessary to also provide a written description of the shape mark which will be included as an endorsement on the Register.

Some shape/3D trade marks on the Register at present include:

- 
  owned by Louis Vuitton Malletier for Class 14 and 25 goods (see Registration No. 1025638 (IR No. 833274));
-
  owned by Chocoladefabriken Lindt & Sprungli AG for Class 30 goods (see Registration No. 1075157); and,
-
  owned by Chivas Brothers (Americas) Limited for Classes 33 goods (see Registration No. 1073938).

4.5.6.2 Colour trade marks

For single and multiple colour trade marks, in addition to a pictorial representation of the colour, a description of the colour as applied to the mark must also be provided. The relevant Pantone Number or international colour classification number, whilst helpful, is not required.

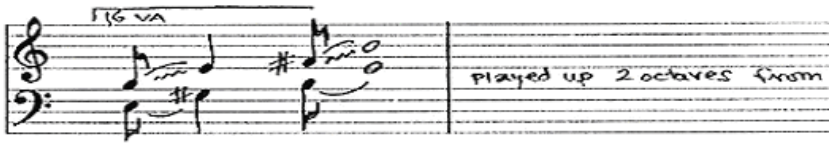
Some colour trade marks on the Register at present include:

- The colour orange (Pantone 1645U) owned by Kimberly-Clark Worldwide, Inc. in connection with "disposable face masks for medical purposes" (see Registration No. 1013426);
- The colour orange owned by Veuve Clicquot Ponsardin in connection with champagne (see Registration No. 704779); and,
- The colour yellow owned by Kodak (Australasia) Pty Ltd in connection with a variety of photographic equipment and services (see Registration No. 751852).

4.5.6.3 Scent/sound marks

Scent and sound marks may be regarded as inherently registrable. However, problems are encountered when applying for such marks given that the trade mark must be "represented graphically" on the Register. The Trade Mark Office will consider musical notation, diagrams and/or written descriptions as a representation of a scent or sound mark.

Some scent and sound trade marks that were accepted include:

- The strong scent of beer on the flight of darts owned by Unicorn Products Limited. (see accepted but lapsed Application No. 700019);
- 

owned by Microsoft Corporation in connection with "computer software" (see Registration No. 1172753); and,

4.6 Overcoming Objections: Section 41(5) some inherent adaptation to distinguish

The assessment of whether a mark should be accepted for registration on absolute grounds in Australia is often more complex than other trade mark jurisdictions.

As with most other jurisdictions, the Trade Mark Office may reject an application on the grounds that the mark applied for is not inherently capable of distinguishing the applicant's goods or services from those of other traders.

However, under Australian trade mark law and practice, the Examiner also has the option to hold that the trade mark has some "*limited inherent adaptation to distinguish*" but is not prima facie capable of distinguishing.[21] This decision will often be issued where the trade mark applied for is a borderline case and the Examiner requires further information or evidence of use before he can accept the trade mark for registration.

In such a case, the following may be submitted to effectively "convince" the Examiner of the trade mark's case for registration:

- Evidence showing the extent to which the trade mark is inherently adapted to distinguish the designated goods or services;
- Evidence of the applicant's use or intended use of the trade mark in Australia;
- Any other relevant information or circumstances.

The important point to note is that in such circumstances, the applicant is able to submit a wide range of information and evidence in support of the application. For example, the applicant does not need to show that the trade mark has acquired distinctiveness in Australia **prior** to the filing date of the application or that the trade mark has even been used in Australia. It can submit evidence of use overseas in a similar market e.g. United States, Canada, New Zealand, United Kingdom, which may indicate that

… the applicant does not need to show that the trade mark has acquired distinctiveness in Australia **prior** to the filing date of the application …

21 Trade Marks Act 1995 (Cth), s41(5)

the trade mark, should it be used to a similar extent in Australia, would acquire a sufficient capacity to distinguish.

In New Zealand, evidence of use must relate to use **prior to** the date of application. Any use after that date will not be taken into account. Moreover, the use must illustrate use in New Zealand only. Whilst evidence of use overseas may be of a certain persuasive value, without any actual evidence of use in New Zealand prior to the filing date of the application, the overseas use is unlikely to be considered.

Additionally, the evidence should show that the use of the mark has been continuous. If there have been gaps in the continuity of use, it will be necessary to provide reasons for why there have been gaps in the applicant's use.

4.7 Overcoming Objections: Section 41(6) no inherent adaptation to distinguish

If the trade mark has *no inherent adaptation to distinguish* then the applicant is required to provide evidence of use of the trade mark which indicates that the trade mark has become distinctive in fact.[22]

The evidence submitted in respect of a s41(6) objection differs to that submitted for a s41(5) objection in the following respects:

- The evidence must show the extent to which the trade mark has been used in respect of the relevant goods and services in Australia only;
- All use relied upon must have occurred prior to the filing date of the application;
- A number of years of use of the trade mark (at least 5 or more) in Australia are usually required for there to be a sufficient level of use or if the use has been over a shorter period then there must have been a very high level of use and promotion.

Whilst there is a presumption of registrability in the Act and the provisions of s41(6) for marks which have no inherent distinctiveness, there are trade marks which are unlikely to ever be registrable as no matter how the trader uses the

22 Trade Marks Act 1995 (Cth), s41(6)

trade mark, the consumer will always view the trade mark as a description of the product rather than an indication of origin e.g. CRANBERRY CLASSIC for cranberry juice[23].

4.8 Examination Ground: prior conflicting marks

In addition to conducting an assessment as to the inherent registrability of a trade mark, the Trade Mark Office will also conduct a search of the Register for prior registrations and/or pending applications which are identical or similar to the applied for mark.

An application to register a trade mark which "is substantially identical with or deceptively similar to" a prior registration or application and claims "similar goods or services or closely related goods or services" will be refused by the Office on relative grounds.[24] The law applying to the comparison tests is highlighted in chapter 2.

4.8.1 Similarity of Trade Marks

The test for similarity of trade marks in Australia is that of substantially identity and deceptively similarity.

Substantially identical trade marks are trade marks which differ only slightly in their visual representation but whereby the overall impression of the trade marks are identical or almost identical. Substantially identical trade marks often include the plural or possessive form of a prior trade mark or a misspelling which is unlikely to be easily perceived by the consumer.

Deceptively similar trade marks are trade marks which are visually, conceptually and/or phonetically similar and/or where the overall net impression of the two marks is so similar that use of the applied for mark is likely to lead to deception or confusion.

23 Ocean Spray Cranberries Inc v RTM (2000) 47 IPR 579
24 Trade Marks Act 1995 (Cth), s44

4.8.2 Comparison of Goods and Services

When assessing the likelihood of deception or confusion, the Trade Mark Office will consider the similarity of the goods and services claimed by the respective marks.

The term "similar goods and services" means goods and services of the same or similar description. For example, "computer software" and "computer programs" would be regarded as similar goods; however, "computer software" and "alcoholic beverages" would not.

In addition to the above, the Office will also consider whether the goods and services claimed by the application are "closely related" to those covered by the prior mark. Closely related services are those services likely to be used to provide or used in close association with the relevant goods. For example, "computer software design" is a closely related service of "computer software". Closely related goods are obviously those goods likely to be used in conjunction with or in association with a particular service.

4.9 Overcoming Objection: conflicting marks

The applicant has a number of possible options available should a prior mark be cited against its application in Australia. These include:

- Filing written submissions with the Examiner to highlight the differences between the respective marks and/or the goods and services of interest;
- Amending or deleting the goods or services claimed by the application to remove any conflict with the cited mark;
- Approaching the owner of the cited mark for a letter of consent to the use and registration of the applied for mark in Australia. Please note, the Examiner is not bound to accept the letter of consent but will often do so if the parties view no likelihood of confusion;
- Filing evidence of use of the applied for mark in Australia. This evidence can be in the form of evidence of use showing that the applied for mark was used in Australia **prior** to the filing date of the cited mark and the applied for mark has been **continuously used** in Australia since that time;

In New Zealand, the submission of evidence of prior use of a trade mark before the priority date of a cited application/ registration will **not** be considered or accepted by the Examiner;

- Filing evidence of use of the mark showing that there has been honest concurrent use of the respective marks in the marketplace without any known instances of confusion. Such evidence needs to at least include evidence of use prior to the filing date of the application, show that the trade mark was honestly adopted, that the use has been over a commercially reasonable period of time, that there have not been instances of confusion and the geographic area of the use. Any evidence filed must be in a sworn Statutory Declaration; or
- For cited marks over five years of age, there may be scope to file an application for removal of the prior mark on the basis of non-use. Should the non-use removal application be successful and remove the conflict with the prior mark, this will permit the Examiner to waive his citation in most cases. A discussion of non-use removal applications is provided in Chapter 6.

4.10 Prosecution Tool: divisional applications

Australian trade mark law and practice provides for a system of divisional applications[25].

A divisional application is part of the original application (parent application) which carries with it the priority date of the parent application including any convention priority. When a divisional application is filed the goods and services which are claimed in the divisional application are deleted from the parent application. For the divisional claim to be valid a parent application must be pending at the time of filing the divisional application and at least one good or service must remain in the parent application; all the other details in the application including the trade mark must be identical to the parent application[26]. Once a divisional application is filed it is re-examined and provided a further 15 month acceptance period. Divisional applications may only be filed in respect of parent applications which are national filings in Australia; they may not be claimed from applications which have been filed via the Madrid Protocol.

25 Trade Marks Act 1995 (Cth), s45
26 Trade Marks Act 1995 (Cth), s46

An applicant may elect to file a divisional application at any time prior to the registration of the trade mark. Some instances when divisional applications are a useful tool include:

- Where some of the goods or services claimed by the application are in conflict with a prior mark or have been refused on inherent registrability grounds and the applicant wishes to "divide out" the conflicting goods and services so that the parent application can proceed to acceptance;
- Where the parent application has been refused on inherent registrability grounds and the applicant requires further time to develop their use of the trade mark to overcome the objection; or
- If an opposition is filed or threatened by a third party, the applicant may divide out the conflicting goods or services so that the undisputed portion may proceed to registration, if the opponent does not also oppose the new application.

An applicant may elect to file a divisional application at any time prior to the registration of the trade mark.

If the applicant ultimately succeeds in obtaining registration for its parent application and its divisional application then these will continue as two separate registrations they may not be merged back into one registration.

In New Zealand it is possible to divide applications to avoid citations or opposition objections etc. However the divided application is not re-examined as it is in Australia so the original deadlines for response would apply to both the original and the divided application. Also the goods or services which are divided into the new application must not be the ones which have any objection made against them. If the mark is being divided because it is opposed, then permission from the opponent must be provided to the division. Once the parent and divided mark register it is possible to merge them back together into one registration.

4.11 Prosecution Tool: deferment of acceptance

The 15 month period of acceptance provided in the Examiner's Report may be deferred or suspended by the Trade Mark Office in certain circumstances[27]. This prosecution tool is used to avoid incurring the expenses of maintaining an application with extension of time requests.

Some of the more common circumstances are:

- A mark is cited by the Examiner against the application during examination and the cited trade mark is pending;
- A non-use action or opposition is in progress against a cited mark;
- A cited mark has not been renewed before the deadline for renewal but is still within the 6 month grace period offered by the Office;
- Court proceedings are in progress against a cited mark which may result in the cited mark being removed or amended on the Register; or,
- The applicant is seeking to establish that it has made honest concurrent use or prior use of its trade mark over the cited mark (only a 6 month deferral is granted in this circumstance).

Deferment of acceptance can be requested at anytime and upon any and all grounds available at the time of the request. However if the request is made after the initial 15 month acceptance period the applicant is required to file a request for an extension of time to defer. The deferral period will continue for as long as the relevant circumstances are in place. When the deferral period ends, the acceptance deadline for the application is reset so that any acceptance period that was remaining at the time of the filing of the deferral request is provided to the applicant e.g. if the deferral request was filed 10 months before the acceptance deadline the applicant will be allowed 10 months once the deferral period ends.

An application may still be prosecuted to acceptance whilst it is deferred.

In New Zealand suspension of the response deadline (abeyance) is only available if a removal action, opposition, revocation or invalidity proceeding has been filed against the cited mark.

27 Trade Marks Act 1995 (Cth), s36

4.12 Prosecution Tool: removal for non-use

If a registered trade mark is preventing the acceptance of an application and the registered trade mark has not been used in the last three years then the registered trade mark may be vulnerable to a full or partial removal from the Register on the basis of non-use[28]. This topic and the requirements for a removal action are discussed further in chapter 6.

4.13 Amendments after Initial Publication

At any time prior to registration an application may be amended by the applicant[29]. The requirements that must be met for the amendment to be granted depend upon the nature of the amendment sought. However generally amendments may be sought to:

- Amend the representation of the trade mark provided that the requested amendment does not affect the substantial identity of the trade mark. An amendment which will affect the "substantial identity" of the mark is an amendment which will change or alter the distinctive content or features of a trade mark;
- The deletion of one or more trade marks from a series application;
- An amendment to correct the an error in the classification or description of goods or services claimed under the application;
- An amendment to add one or more Classes to the application as long as it does not broaden the scope of protection provided;
- Change of the type of registration to be awarded, i.e. collective to certification mark; and
- Amendment to other particulars of the application where there has been a clerical error or obvious mistake.

28 Trade Marks Act 1995 (Cth), s92

29 Section 65, Trade Marks Act, 1995 (Cth)

4.14 Hearings

In theory, an applicant is provided a non-exhaustive number of attempts to overcome any objections raised by the Examiner. However, the Examiner or indeed the applicant may eventually take that the view that no substantive progress has been made in obtaining acceptance of the application and an impasse may be reached. In these circumstances the Examiner may warn that they intend to formally reject the application[30].

Should this be the case, the applicant has the option of requesting a Hearing on the Examiner's decision. This request can be submitted at any time during the examination process by the applicant; although, if the Examiner has issued a formal intention to refuse the application, the request must be submitted within the specified time set by the Examiner.

A Hearing provides the applicant with an opportunity to have the matter reviewed by a senior delegate of the Trade Mark Office. This can be via an ex parte Hearing in person before the Hearing Officer, remotely via telephone or video conference and/or by written submissions only.

The Hearing Officer will conduct a review of the Examiner's decision, whilst giving due consideration to the applicant's oral or written submissions. The Hearing Officer has full authority to revoke, amend or uphold the Examiner's decision and the Hearing Officer's decision represents the last route of appeal via administrative action before the Trade Mark Office. It is possible for the applicant to file an appeal from a hearing decision before the Federal Court, although the costs associated with same are significantly greater than the administrative process available before the Trade Mark Office.

Ex parte Hearing judgements may be issued immediately following the oral hearing. However, the practice is normally for the Hearing Officer to withhold the decision until a later date (usually 3–4 months from the Hearing date).

30 Trade Marks Act 1995 (Cth), s33

5

Oppositions

5.1 Introduction

Australia provides a system to oppose accepted trade mark applications.

Any individual or company may oppose an accepted application within the relevant period. There is no requirement that the opponent be an "aggrieved person"[31] or to have any other special standing.

An application may be opposed on a number of grounds, including inter alia[32]:

- Absolute grounds – that the applied for trade mark is not capable of distinguishing the applicant's goods;
- Relative grounds – that the applied for trade mark conflicts with a prior registered trade mark or prior pending application;
- Use contrary to law – that registration of the trade mark would be contrary to law, e.g. it would be in breach of copyright laws or would amount to passing off;
- Bad Faith – that the applicant without bone fide intention applied to register the trade mark;
- Ownership – that the applicant is not the owner of the trade mark or that the opponent has prior use of a similar mark;

31 Trade Marks Act 1995 (Cth), s52

32 Trade Marks Act 1995 (Cth), Part 5 Division 2

- Lack of intention to use – that the applicant at the date of the opposition did not intend to use the trade mark, authorise its use or assign the mark to a body corporate;
- Confuse or Deceive – that as a result of a reputation established by the opponent use of the trade mark is likely to cause deception or confusion; and
- False Geographic Indications – for marks which contain a geographic indication and which are to be used on goods which are similar to goods covered by the geographic indication but which do not originate from the relevant region.

5.2 Opposition Deadline

The Australian opposition period is a period of **3 months** from the date of publication of acceptance of an application[33].

5.3 Extension of Time to Oppose

The time to oppose an application may be extended **once** usually by a period of up to 3 months. It is also possible in limited circumstances to make an application out of time to oppose[34].

The grounds for extending the period for opposition which is filed within time are:

(1) that there are genuine settlement negotiations occurring between the parties; and/or,

(2) that the applicant is undertaking genuine research to ascertain whether or not an opposition against the published trade mark is justified and/or what the relevant grounds of opposition would be.

33 Trade Mark Regulations 1995 (Cth) Reg 5.1

34 Trade Mark Regulations 1995 (Cth) Reg 5.2

The grounds for extending the period for opposition which is filed out of time are:

(1) that there was an error or omission by an employee, by a person applying for the extension of time or by the persons agent; and/or,

(2) there are circumstances which were beyond the control of the person applying for the extension of time which prevented the application being made within the relevant time.

The applicant must provide a Statutory Declaration attesting to one or both of the above grounds and provide sufficient detail to satisfy the Registrar that the ground is validly claimed.

5.4 Notice of Opposition

A Notice of Opposition is a statement of the grounds which are to be relied upon in the opposition proceedings by the opponent.

The Notice of Opposition must be lodged at the Trade Mark Office prior to the expiry of the allowed period of opposition.

The opponent is not required to submit any evidencing substantiating the grounds of opposition at this stage. Additionally, please note that the grounds specified in the Notice of Opposition may be narrowed later in the proceedings but cannot be broadened. Therefore, it is important to ensure that all potential grounds of opposition are initially claimed under the Notice of Opposition.

There is no requirement for the filing of any form of defence by the owner of a trade mark which is opposed. Therefore an opponent is required to make out its opposition case even if the trade mark owner elects not to defend the proceedings.

5.5 Evidence

After filing the Notice of Opposition, the Trade Mark Office provides a process by which the parties are able to serve evidence in the proceedings.

The evidence stages enable the parties to serve any factual evidence which is to be relied upon in the proceedings. The parties are not required to file any legal arguments at this stage. The evidence is served in the form of sworn Statutory Declarations.

5.5.1 Evidence in Support

Following the filing of a Notice of Opposition, the Trade Mark Office provides the opponent with an initial period of 3 months to serve its evidence in support on the applicant[35]. The evidence must be physically served on the applicant before the expiry of the 3 month deadline. The evidence should substantiate the grounds claimed in the Notice of Opposition.

5.5.2 Evidence in Answer

Upon receipt of the opponent's entire evidence in support, the applicant is thereafter provided a period of 3 months to serve its evidence in answer[36]. This evidence should be in answer to not only the opponent's evidence in support, but also the grounds raised in the Notice of Opposition.

5.5.3 Evidence in Reply

Upon receipt of the applicant's evidence in answer, the opponent is provided a further 3 months to serve any evidence in reply (if applicable)[37]. This evidence should be strictly in reply to the applicant's evidence in answer. Should the opponent wish to serve any additional, unrelated evidence in the proceedings, it must make an application to adduce further evidence in support. Therefore, it is important that the opponent serves all available evidence during the period afforded for evidence in support.

5.6 Extensions of Time to Serve Evidence

An extension of time may be requested by the opponent or the applicant to serve evidence in support, answer or reply[38]. In addition to the initial 3 month period, the Office will generally award up to 6 months of extensions for serving evidence and up to 12 months for serving evidence where the parties are engaged in negotiations to settle the matter. Any extensions sought thereafter

35 Trade Mark Regulations 1995 (Cth) Reg 5.7
36 Trade Mark Regulations 1995 (Cth) Reg 5.10
37 Trade Mark Regulations 1995 (Cth) Reg 5.12
38 Trade Mark Regulations 1995 (Cth) Reg 5.15

must be accompanied by a Statutory Declaration attesting to the reasons why there has been a delay in serving evidence. The maximum period the Office is likely to permit the opponent or applicant to serve its evidence in support or answer is 9 months, unless there are exceptional circumstances justifying the extension.

The Opponent can request an extension of 3 months to serve its evidence in reply or 6 months if settlement negotiations are occurring. Any additional extension of time requests thereafter must be accompanied by a Statutory Declaration attesting to the reasons why there has been a delay in serving evidence. The extension is unlikely to be award unless there are exceptional circumstances justifying the extension.

5.7 Suspension of Proceedings

In Australian trade mark opposition proceedings, there is no "cooling off" period for the parties. However, if the parties are genuinely negotiating settlement of the matter and wish to halt the opposition proceedings pending conclusion of negotiations, it is possible to have the matter suspended by the Trade Mark Office.

Suspension can be requested at any time during the opposition proceedings. The proceedings can be suspended for a minimum period of 6 months to a maximum period of 12 months. For suspension to be granted, written consent must be submitted to the Office by both parties to the dispute. The suspension can be terminated by either party at any time by filing a written request with the Office.

Please note that the onus is on the relevant party to maintain its deadline to serve evidence in the proceedings pending the grant of the suspension or should the suspension be terminated.

5.8 Production of Documents

The Australian Trade Mark Office is not empowered to order discovery of documents.

However, provision is made for the Office to order the production of documents, which have been identified to some extent. Therefore, whilst it is not possible for the Office to effectively conduct a "fishing" exercise and request the discovery of all documents pertaining to a dispute, the Office can request the production

of specified documents or a category of documents which have been narrowly described.

Either party can file a written request for such production of documents at any time. The Office will conduct a review of the request to ascertain whether the documents requested have been identified with sufficient particularity and that the request is reasonable in the case. If accepted, the Office will subsequently serve a Notice to Produce on the other party. The receiving party must comply with the Notice to Produce within the relevant period or provide a reasonable excuse why it has not complied (i.e. its reasonable expenses have not be covered by the requesting party or the documents requested were not sufficient specified). Failure to comply will result in the Trade Mark Office referring the matter to the Director of Public Prosecutions for action.

5.9 Decision on Opposition

Upon completion of the evidence stages, a decision will be made in the matter by a senior delegate of the Register[39].

Within one month of the conclusion of the evidence stages, both parties can independently:

- Request a hearing to present oral submissions to the Hearing Officer. The hearing can be conducted in person at the Trade Mark Office, via video conference or over the telephone; or,
- File written legal arguments in support of the evidence lodged to date; or,
- Take no further action and have the opposition decided on the evidence lodged to date.

If only one party requests a Hearing on the matter, the Hearing will go forth in the absence of the other party. However, the other party effectively has until the date of the Hearing to request representation at the Hearing and pay the official fee.

When a Hearing has been requested, both parties have until the date of the Hearing to file written legal arguments in support of the evidence lodged to date, irrespective of whether they have requested representation at the Hearing. Otherwise, any written submission must be lodged at the Office within the one month deadline.

39 Trade Mark Regulations 1995 (Cth) Reg 5.14

A final decision on the opposition is likely to be issued within 5–6 months after the Hearing date, or if no Hearing has been requested, within 3–4 months of the deadline to file written submissions.

5.10 Cost Orders

Cost orders are usually made once oppositions have been decided and are generally in favour of the successful party[40]. If oppositions conclude prior to the issuance of a decision, costs are only awarded in very limited circumstances.

The Regulations specify the amount of the costs which may be ordered and are fairly conservative in quantum.

5.11 Appeal

The Federal Court has jurisdiction to hear appeals on opposition decisions issued by the Office[41]. The appeal must be lodged within 21 days of the Office's decision.

An appeal to the Federal Court is not a simply review of the Hearing Officer's original decision. Rather, it is a complete re-hearing on the matter. As such, the parties to the appeal are permitted to admit further evidence, to examine and cross exam witnesses and/or to request disclosure of documents. There is no presumption in favour of the Hearing Officer's original decision during the appeal.

Therefore, should the Trade Mark Office find that there is a lack of evidence in support of a party's position, on appeal to the Federal Court, the relevant party has an opportunity to rectify this deficiency by admitting further evidence.

40 Trade Marks Act 1995 (Cth), s221
41 Trade Marks Act 1995 (Cth), s56

5.12 Opposition Flow Diagram

The opposition process is illustrated in the diagram below:

Notice of Opposition
↓ 3 months to serve evidence in support
↓ Up to 6 months of extension
Further extensions must be supported by declarations

Evidence in Support
↓ 3 months to serve evidence in answer
↓ Up to 6 months of extension
Further extensions must be supported by declarations

Evidence in Answer
↓ 3 months to serve evidence in reply
↓ Up to 3 months of extension
Further extensions must be supported by declarations

Evidence in Reply
↓

Hearing or Decision on the Written Record
↓

Appeal to the Federal Court

5.13 Revocation of Acceptance

Should an application be accepted for registration by the Trade Mark Office in Australia there may be an opportunity in limited cases for an interested party to bring matters to the Registrar's attention which may cause the Registrar to consider exercising their power to revoke acceptance of the application.

For revocation of acceptance to be considered by the Office, the following factors must exist[42]:

(1) The Examiner should not have accepted the application for publication, taking into account all the circumstances present at the time of acceptance; and,

(2) It is reasonable to revoke the acceptance, taking into account all the circumstances.

42 Trade Marks Act 1995 (Cth), s38

The information supplied to the Registrar by the party raising the question of revocation of acceptance needs to show that the Examiner had made an error or omission when examining the application. For example:

- The Examiner had not sufficiently conducted a search of the Register before accepting the application;
- There was an indexing error on the Register which lead to a prior mark not being cited by the Examiner; and/or,
- An international registration designating Australia with an earlier priority date of the application had not yet been recorded on the Register.

It would be considered reasonable to revoke acceptance in circumstances where the decision made by the Examiner is manifestly wrong or obviously disregards established authorities.

If acceptance is revoked the application is returned to an examination status and the Applicant is provided with the usual 15 month period to overcome the relevant objection to the application.

The opposition procedure and grounds in New Zealand are different to those in Australia. Whilst we do not explore the many differences here, one notable difference is the requirement in New Zealand for the owner of the opposed trade mark to file a counter-statement after the Notice of Opposition has been filed. If the counter-statement is not filed the opposed trade mark will be deemed abandoned.

6

Requirements of Use

6.1 Introduction

There is a statutory requirement in Australia that an applicant for a trade mark must at the time of filing a trade mark application have made use of the trade mark in Australia or have a bone fide intention to use the trade mark. Lack of an intention to use and/or subsequent non-use of the trade mark in Australia for the goods or services registered may result in the trade mark becoming vulnerable to challenge and subsequently struck off the Register.

6.2 What Constitutes "use as a trade mark"?

The criteria for "use as a trade mark" in Australia are defined by Sections 6, 7,8,17 and 228 of the Act, with Section 17 specifically mentioning two criteria for use:

> *"a sign... used **to distinguish** goods and services dealt with or provided **in the course of trade** by a person from goods and services so dealt with or provided by any other persons" (emphasis added).*

The important requirements of trade mark use are: (1) the use must distinguish the owner's goods or services, i.e. that the sign is capable of acting as a badge of origin; and, (2) that the goods and services be offered or provided in the course of trade or as commercial use.

The test is fundamentally whether consumers would understand that the sign indicates a connection in the course of trade between the goods and services being offered and that of the person using the trade mark (see case *Shell Co (Aust) Ltd v Esso Standard Oil (Aust) Ltd* (1963) 109 CLR 407). In terms of descriptive or non-traditional trademarks, often it is easy to show use of the sign or shape; however, this does not necessarily show use of same **as a trade mark**.

For example:

- Use of the words ROLLING STONES on an unauthorised recording of the Rolling Stones was held to be descriptive use of the content of the CD rather than use of a trade mark (*Musidor BV v Tansing* (1994) 52 FCR 363);
- Use of the word MOTHERCARE as part of the title of a book was held to describe the subject matter of the book rather than use of a trade mark (*Mothercare UK Ltd v Penguin Books* [1988] RPC 113); and,
- Use of the phrase "The Hunchback of Notre Dame" was taken as a reference to Victor Hugo's novel rather than any connection in the course of trade with Walt Disney's THE HUNCHBACK OF NOTRE DAME movie and trade mark (*Christodoulou v Disney Enterprises Inc* (2005) 66 IPR 595).

6.3 Lack of Intention to Use

At any time, a party may seek cancellation of a trade mark on the Register (both application and registration) on the basis that the owner had no bone fide intention to use the trade mark at the time of filing and the trade mark has not subsequently been used in Australia in relation to any of the goods or services claimed.[43] This type of cancellation action is often used to remove or partially remove a registration which has been filed to obtain protection for a broader range of goods or services than the owner is commercially able to provide.

43 Trade Marks Act, 1995(Cth), s.92(4)(a)

6.4 Non-use of Trade Mark

There are also provisions under Australian trade mark law for the removal of a trade mark from the Register, where the registered owner has not used the trade mark in good faith in Australia for the specified period in respect of some or all of the goods or services covered by the registration.[44]

6.4.1 Non-use Period

With respect to a non-use action, the Trade Mark Office provides a grace period of 5 years from the filing date of the registration before a trade mark registration may become vulnerable to removal action on the basis of non-use. After the five years period, the registration may be removed on the basis that, during the period of three years ending one month before the removal application is filed, the owner of the registration did not use the trade mark in Australia in good faith in relation to all or some of the goods and services claimed by the registration.

6.4.2 Application for Removal

An applicant does not need to be an aggrieved party to lodge a cancellation action. The Application must state which grounds of cancellation the applicant is relying upon and whether cancellation of the trade mark is sought in its entirety or is restricted to specific goods or services.

The application for removal is published in the *Australian Official Journal of Trade Marks* and a period of 3 months is given to the owner of the registration in question to oppose the action. If the removal application is not opposed the trade mark is automatically removed from the Register.

6.4.3 Opposition

The opposition proceedings in removal actions are of a similar structure and format to the opposition proceedings to registration of a trade mark discussed at Chapter 5.

For lack of bone fide intention to use oppositions, the trade mark owner only needs to file a statutory declaration supporting that it had a bone fide intention

44 Trade Marks Act, 1995(Cth), s.92(4)(b)

to use at the time of filing the trade mark for the onus of proof to be placed firmly on the removal applicant. The burden will then be on the removal applicant to evince that the trade mark owner had no intention to use the mark at the relevant date, which can be exceedingly difficult to prove.

To succeed in a non-use removal opposition, the trade mark owner simply has to evince good faith use of its trade mark within the relevant period. This use does not need to be for the whole period, nor does it need to be widespread throughout all States of Australia. The trade mark owner only need show at least one genuine commercial use of the trade mark for all of the goods and services that they intend to retain within the relevant 3 year period. Alternatively the trade mark owner may make out one of the defences to non-use[45] such as that there was some obstacle that prevented the use of the trade mark during the relevant period e.g. government approval was being sought to release the product on the market.

Notwithstanding the above, please note that the Registrar is empowered to exercise her discretion when determining removal actions. Thus, even where a trade mark owner is not able to show use of its mark within the relevant period, or make out one of the statutory defences, the Registrar may decide that it is in the public interest that the mark not be removed.[46]

6.4.5 Ceasing Effect

Once an application or registration is removed from the Register, the cancellation of same is effective from the date it is removed from the Register. Therefore the application or registration remains valid for the period it was on the Register.

This has possible implications for trade mark infringement claims. Although a party may successfully remove a registration via non-use proceedings and no longer infringe same as a result of its future use of an identical or deceptively similar trade mark, the rights of the respective parties are judged at the time the infringing action took place. Therefore, should the party have made use of an identical or deceptively similar trade mark before the registration was removed from the Register, its use may still represent an infringement of the registration for that period.

In New Zealand, the definition of "use as a trade mark" is similar to that in Australia.

45 Trade Marks Act, 1995 (Cth), s.100(3)(a) to (c)
46 Trade Marks Act, 1995 (Cth), s.101(3)

However, the practice before IPONZ in connection with requirements of use for the purposes of defending a non-use action differs from that of the Australian Trade Marks Office. It is possible to remove a registration in New Zealand where a continuous period of 3 years or more has elapsed following the date of registration of a trade mark and during which, the trade mark was not put to genuine use in the course of trade in New Zealand in relation to the goods or services registered.[47]

47 Trade Marks Act, 2002, Section 66(1)(a)

7

Revocation and Cancellation of Registrations

7.1 Introduction

In Australia, there is no procedure before the Trade Mark Office for an aggrieved party to apply to remove a registered trade mark from the Register on grounds other than non-use. Actions concerning the validity of a trade mark registration must be brought before the Federal Court. However, new provisions in the Act have empowered the Registrar to revoke the registration of a trade mark in limited circumstances.

7.2 Cancellation of a Registration

Only the Federal Court is empowered to hear applications made by an aggrieved party to cancel registrations on the Register on the basis of grounds other than non-use.

Only a person aggrieved by a registration or the Registrar may apply to the Federal Court for the cancellation of a trade mark registration. The available grounds upon which to base an application for cancellation include:

(1) any of the grounds on which the registration of the trade mark could have been opposed under the Act;[48]

(2) if, after registration of the trade mark, the trade mark has become the generic name for the goods or services or the mark is the only commonly known way to describe or identify an article formerly provided as a patented process where the patent expired more than two years ago;[49]

(3) an amendment of the application for registration or entry on the Register was obtained as a result of fraud, false suggestion or misrepresentation;[50]

(4) because of circumstances applying at the time when the application for cancellation is filed, the use of the trade mark is likely to deceive or cause confusion[51]; or

(5) a condition or limitation entered in the Register in relation to the trade mark was contravened[52].

Only a person aggrieved by a registration or the Registrar may apply to the Federal Court for the cancellation of a trade mark registration.

If an action is made out the Court may decide to cancel the trade mark on the Register, remove or amend any entry in the Register, or enter a condition or limitation on the registration.

There is no time limit for a party to file an application to cancel a registration.

Unfortunately, as cancellation actions are dealt with by the Federal Court rather than as an administrative matter before the Trade Mark Office, the costs associated with pursuing same are significantly higher than trade mark opposition proceedings.

Please note that in terms of the grounds for cancellation discussed above at (2), (4) and (5), if the resulting generic nature of the trade mark, likelihood to deception or confusion, or contravention of condition or limitation entered on the Register has not arisen through any act or fault of the registered owner, the cancellation of the registration will not be granted.[53]

48 Trade Marks Act 1995 (Cth), s88
49 Trade Marks Act 1995 (Cth), s87
50 Trade Marks Act 1995 (Cth), s88
51 Trade Marks Act 1995 (Cth), s88
52 Trade Marks Act 1995 (Cth), s86
53 Trade Marks Act 1995 (Cth), s.89(1)

7.3 Revocation by the Registrar

New provisions in the Act permit the Registrar to revoke the registration of a trade mark in limited circumstances.

In exercising his/her discretion, the Registrar has the power to revoke the registration of a trade mark if the trade mark should not have been registered, taking account of all the circumstances that existed when the trade mark became registered (whether or not the Registrar knew then of their existence) and it is reasonable to revoke the registration, taking account of all the circumstances[54].

When considering whether a trade mark should not have been registered, the Registrar will consider the following:

- Any errors (including errors of judgement) or omissions that led directly or indirectly to the registration, i.e. if there where errors on the Register at the time of examining the application that precluded a prior mark being cited as an obstacle to the registration of the trade mark or if the examiner has made an error of judgement when examining the trade mark;
- Any relevant obligations of Australia under an international agreement, i.e. the examiner has failed to cite a relevant prior international registration designating Australia against an application due to the delay in recording same on the Register;
- Any special circumstances making it appropriate.

… the Registrar has the power to revoke the registration of a trade mark …

Revocation of registration can only occur if the Registrar gives notice of the proposed revocation within 12 months from the date the trade mark's registration was recorded.

The Registrar does not have a duty to revoke registration. He/ She is under no obligation to consider any third party request for revocation of registration. Revocation of the registration of a trade mark should not be considered as a "late opposition" to a trade mark application and it is important to note that the Registrar will often be reluctant to revoke the registration of a trade mark.

The Registrar must not revoke registration until notice has been given to the registered owner of the trade mark and they have been given the opportunity to be heard.

54 Trade Marks Act 1995 (Cth), s84A

8

Renewal

8.1 Renewal Period

The registration of a trade mark expires on the ten year anniversary of the filing date of the application to register the trade mark. A trade mark may be renewed for a further ten years and at ten year intervals thereafter. An application for renewal may be made at any time during the period 12 months before the expiry of the trade mark[55]. If the registration is a divisional registration then the date from which the renewal period runs will be the filing date of the first parent application.

In New Zealand the registration period runs from the earliest priority date of the trade mark rather than the filing date. Therefore, first renewal of the trade mark registration is due 10 years after the earliest priority date.

55 Trade Mark Act (Cth), 1995, s 77

8.2 Grace Period

A request for the renewal of a trade mark registration and the payment of the appropriate governmental fee must be lodged at the Trade Mark Office on or before the ten year anniversary of the filing date of the application to register the trade mark or the expiry of the last ten year renewal interval, whichever is appropriate.

However, the Trade Mark Office provides a six month grace period following the renewal due date whereby a trade mark owner can lodge a request to renew a trade mark registration and pay the renewal fee plus a late fee[56]. If no renewal request is filed and the appropriate fee paid within the six month grace period, the registration will be removed permanently from the Registrar with no process for it to be resurrected.

Apart from the payment of the appropriate fee, no additional documentation is required to renew a trade mark during the grace period.

An un-renewed registration which is within the grace period may not be enforced against third parties for the purposes of infringement for that period of time for which it remains un-renewed[57].

In New Zealand the grace period is 12 months.

56 Trade Mark Act (Cth), 1995, s 79
57 Trade Mark Act (Cth), 1995, s 80

9

Infringement of Trade Marks

9.1 Trade Mark Infringement in the Act

An Australian registered trade mark provides its owner with the exclusive right to use the trade mark in connection with the registered goods and services and to take action against infringement.

Infringement in Australia is defined as:

(i) *use of a sign as a trade mark that is substantially identical with, or deceptively similar to, a registered trade mark in relation to goods or services for which the trade mark is registered (i.e. identical goods or services); and/or,*

(ii) *use of a sign as a trade mark that is substantially identical with, or deceptively similar to, a registered trade mark in relation to similar goods or services or closely related goods or services to those registered and there exists a likelihood of deception or confusion; and/or,*

(iii) *use of a sign as a trade mark that is substantially identical with, or deceptively similar to, a registered trade mark that is well known in Australia in relation to unrelated goods or services to those registered and due to the well known nature of the registered trade mark, the sign is likely to be taken as indicating a connection between the unrelated goods or services and the registered owner of the trade mark and for that reason, the interests of the registered owner are likely to be adversely affected.* [58]

The Act further states that:

> *"In deciding.. whether a trade mark is well known in Australia, one must take account of the extent to which the trade mark is known within the relevant sector of the public, whether as a result of the promotion of the trade mark or for any other reason."*

These provisions may not be implemented if the registered trade mark which was infringed is within the grace period for renewal.

9.2 Enforcement Procedures: civil action

Actions for infringement are normally brought before the Federal Court in Australia. However in certain circumstances the proceedings may also be commenced in the State Supreme Courts.

The Court may grant the following relief in an action for infringement:

(a) an injunction, which may be granted subject to any condition that the Court deems fit; and,

(b) at the option of the plaintiff, damages or an account of profits; and

(c) delivery up for destruction of any infringing items.

58 Trade Marks Act (Cth), 1995, s120

9.3 Enforcement Procedures: criminal procedures

In Australia, there are also criminal provision which deal with the infringement of a trade mark. The criminal offences include:

(1) Falsifying a registered trade mark;

(2) Falsely applying a registered trade mark;

(3) Selling goods with false marks; and,

(4) Aiding and abetting any of the above.

The penalties if found guilty of the commission of the above offences are a fine, imprisonment of not more than 2 years , or both a fine and imprisonment.

These criminal provisions may only be enforced by the Federal Authorities and not individual trade mark owners.

9.4 Enforcement Procedures: customs provisions

Australian law also enables the Customs CEO to seize and deal with goods that are imported into Australia if the importation infringes, or appears to infringe, a registered trade mark.

A registered owner of a registered trade mark may give to the Customs CEO a notice in writing objecting to the importation of any goods that infringe the trade mark. The Customs CEO must seize the goods unless he or she is satisfied that there are no reasonable grounds for believing that the notified trade mark is infringed by the importation of the goods.

The goods will be released to the designated owner unless the objector brings an action for infringement of the notified trade mark in respect of the goods, and gives to the Customs CEO notice in writing of the action, within the period of 10 working days after the objector was advised of the seizure.

9.5 Defences to Infringement

The Act provides a number of circumstances which provide an "infringer" with a defence to claims for trade mark infringement[59] including:

- Use in good faith of a person's name or the name of the person's place of business;
- Use of a sign in good faith to indicate kind, quality, quantity, intended purpose (including as an accessory or spare part), value, geographic origin or some other characteristic of the goods or services;
- Use of the trade mark for the purpose of comparative advertising;
- Exercise of a right to use the trade mark given to the person under the Act e.g. use of their own registered trade mark;
- The person is able to convince the court that they would obtain registration of the trade mark in their own name if they were to apply for it;
- The trade mark was applied to the goods with the consent of the registered owner such as in parallel importation cases; or
- Because of a limitation or condition which is entered on the registered trade mark the manner in which the infringer used the trade mark was not an infringement of the exclusive right held in the trade mark.

9.6 Parallel Imports

The term "parallel imports" is used to refer to situations in which genuine goods bearing a trade mark are imported into a country by traders other than the appointed distributor. Clearly, the appointed distributor has a vested interest in closing these alternative importation channels.

The basic position in Australia has been that a trade mark registration cannot be used to prevent parallel imports. The rationale behind this position is that a trade mark is an indication of the origin of the goods, and the origin of the goods remains the same regardless of the trade channels through which the goods may pass.

59 Trade Marks Act (Cth), 1995 s 122–124

Section 123 of the Act states:

> *"...a person who uses a registered trade mark in relation to products that are similar to products in respect of which the trade mark is registered does not infringe the trade mark if the trade mark has been applied to, or in relation to, the products by, or with the consent of, the registered owner of the trade mark."*

Recent case law in Australia has held that the onus is on the parallel importer to establish that the trade mark was applied by or with the consent of the trade mark owner. It is not sufficient to demonstrate that a member of the trade mark owner's corporate group applied the trade mark or consented to the relevant application[60]. Notwithstanding the above, if the local distributor is the registered owner of the trade mark in Australia, then the use of s.123 as a defence may not be available. If the trade mark is registered by the overseas trade mark owner and subsequently assigned to the Australian distributor, the distributor may be able pursue the parallel importer for trade mark infringement[61].

9.6.1 Copyright and Parallel Imports

In the past claiming infringement in the copyright in indicia or trade marks on labels that were attached to goods was used as a mechanism to prevent parallel imports[62]. However, the *Copyright Act (Cth)* 1968 was amended to include s44C which has the effect of providing a defence to copyright infringement where the copyright work at issue is embodied in an accessory to the imported goods. At s10 of the Copyright Act accessory is defined as:

> *"accessory, in relation to an article, means one or more of the following:*
>
> (a) *a label affixed to, displayed on, incorporated into the surface of, or accompanying, the article;*
>
> (b) *the packaging or container in which the article is packaged or contained;*
>
> (c) *a label affixed to, displayed on, incorporated into the surface of, or accompanying, the packaging or container in which the article is packaged or contained;*
>
> (d) *a written instruction, warranty or other information provided with the article;*
>
> (e) *a record embodying an instructional sound recording, or a copy of an instructional cinematograph film, provided with the article;"*

60 *Brother Industries Ltd v Dynamic Supplies Pty Ltd* [2007] FCA 490

61 *Fender Australia Pty Ltd v Bevk t/as Guitar Crazy* (1989) 15 IPR 257 and *Transport Tyre Sales Pty Limited v Montana Tyres Rims & Tubes Pty Ltd* (1999) AIPC 91–467

62 *R.A. & A. Bailey & Co Ltd v Boccaccio Pty Ltd* (1986) 6 IPR. 279

As trade marks are often applied to goods in one or more of these forms, the opportunity to rely upon the copyright in that trade mark to try and defeat the parallel import is now virtually extinct. Further a recent decision (currently seeking leave to appeal to the High Court) concluded that the "Polo and horse rider trade mark" which was embroidered onto the front of a shirt, was an application of the trade mark to the goods as a "label". Therefore the parallel importation of the shirts bearing the copyright work fell under the "accessory defence" to copyright infringement. With respect to this form of use of the trade mark being defined as a "label" the Full Court said:

> *"In our view, the word "label" as it is used in the (copyright) Act is intended to connote something physical, although as we have said, a label need not be physically distinct from the object labelled. A trade mark, of course, is an intangible property right; for this reason, we do not think "label" in the statutory context simply means "trade mark" in the statutory sense. Nonetheless, where a trade mark is physically manifested and incorporated into an article, as the Logo is here, the trade mark is being used to identify the article with its source. Its purpose is to label the goods; it is a label.* [63]"

9.6.2 Passing off, Trade Practices Act and Parallel Imports

The elements of passing off and some provisions of the Trade Practices Act are discussed in Chapter 10. As trade mark infringement and copyright infringement actions are not likely to be effective at preventing parallel imports, there might be limited occasions when the laws of passing off or the Trade Practice Act may assist. These laws may be useful in situations where it may be established that there has been some misrepresentation made through the importation and sale of the parallel imported goods. The possible misrepresentations include:

- The standard, style or quality of the goods;
- The availability of after-sales support;
- The ability of the trader to fulfil large repeat orders; or
- The existence of some form of association between the seller and the manufacturer.

The trader could overcome these possible misrepresentations by taking positive steps to inform the purchasers of the situation regarding the goods i.e. that the goods are parallel imports and do not receive warranty support. However the trader may not always take such steps and may become exposed to an action under these laws.

63 *Polo/Lauren Company L.P. v Ziliani Holdings Pty Ltd* [2008] FCAFC 195

Further if the goods are made to a certain standard for a particular country which is below the standard experienced in Australia for the "legitimate" goods e.g. toothpaste[64], then it would be harder for a trader which does not provide full disclosure at the time of sale to claim that no misrepresentation as to quality has occurred.

9.7 Unjustified Threats

A person aggrieved by a threat of an infringement proceeding may apply for a declaration that the threat is unjustified, an injunction against the continuance of the threat and the recovery of damages sustained as a result of the threat.

The mere notification of the existence of a trade mark registration or application does not constitute a threat.

64 *Colgate-Palmolive Ltd v Markwell Finance Ltd* (1989) RPC 497

10

Passing Off & Trade Practices Act

10.1 Introduction

Australia is a common law country and recognises that intellectual property rights may be generated through use of a trade mark as an alternative to, or in addition to, registered rights. Australia is a "first to use" country, therefore it is important that any common law trade mark rights are considered before use of a new trade mark commences in Australia.

Apart from trade mark infringement proceedings under the Act, there are two other causes of action which are often raised in, or as an alternative to, infringement proceedings. These areas of law are complex and so are only briefly explained in the following paragraphs.

10.2 Passing Off

The Australian common law includes the tort of passing off, whereby civil proceedings may be used to restrain a trader from the use of a trade dress and/or trade marks in a manner which causes, or is likely to cause, a misrepresentation that there is some commercial connection between the trader and the owner of the goodwill or reputation in a trade mark or trade dress.

The principal elements which need to be established in a passing off case are:

(1) that the complainant has an established reputation or goodwill, at the time of the commencement of the activity complained of, and that goodwill is associated with the trade dress (or indicia) of the goods or services;

(2) there is a misrepresentation made by the defendant in the course of trade which causes confusion or deception, or is likely to confuse or deceive consumers into believing that the product of the defendant is the product of the complainant or that there is some commercial connection between the defendant and the complainant; and

(3) as a result of the misrepresentation there is actual damage or there is likely to be damage to the business or goodwill of the complainant.[65]

An action for passing off is often difficult and costly to substantiate due to the onus being placed on the complainant in establishing a sufficient reputation or goodwill in the particular indicia so as to lead to the likelihood of a misrepresentation occurring.

The relevant time at which the level of reputation of the complainant is considered is the time when the activity complained of commenced.

Often passing off claims are made concurrently with trade mark infringement claims in enforcement proceedings.

65 *Reckitt & Colman Products Ltd v Borden* (1990) 17 IPR 1

10.3 Trade Practices Act 1974

In addition to common law rights, Australia also has statutory consumer protection laws which offer avenues for dealing with disagreements about the unauthorised use of registered or unregistered trade marks and/or trade dress. Corporations are subject to the laws contained in the *Trade Practices Act, 1974 (Cth)*, individuals are subjected to the mirrored provisions found in the various State Fair Trading Acts.

Section 52 of the *Trade Practices Act, 1974 (Cth)* prescribes that it is unlawful for a corporation to engage in conduct in trade or commerce which is misleading or deceptive or which is likely to mislead and deceive.

As this is a provision which is to protect consumers from being misled rather than to protect the goodwill of a particular trader, there is no requirement under this provision that there be damage to a trader's goodwill. Therefore, the level of reputation required to be established by the complainant is much lower. Obviously there would need to be some form of reputation in the indicia for the particular conduct to become misleading. However the level of reputation required is much lower.

The relevant point in time at which the complainant's established reputation is considered is not when the activity complained of is commenced; it is when the activity becomes misleading.

Section 53 of the *Trade Practices Act, 1974 (Cth)* also prescribes a standard of conduct, prohibiting representation by a corporation that it has an affiliation, sponsorship or approval that it does not have, and/or that their goods and services have an affiliation, sponsorship or approval that they do not have. There are also offences in this section relating to making various false and misleading statements about goods and services.

An action under Section 52/53 of the *Trade Practices Act* is often jointly raised with an action for passing off. However as s53 has criminal penalties attached to it, findings in favour of the complainant are more often made under s52 than s53.

11 Licensing

11.1 Authorised User

Australia allows for a trade mark owner to licence the authorised use of a trade mark.

> *"A person is an "authorised user" of a trade mark if the person uses the trade mark in relation to goods or services under the control of the owner of the trade mark."*[66]

The use of a trade mark by an authorised user of the trade mark is an "authorised use" of the trade mark to the extent only that the user uses the trade mark under the control of the owner of the trade mark. Such control may be in the nature of quality control, financial control or some other form of control.

Please note that a mere contractual licence agreement between the parties is not sufficient to show that the licensee is or has made authorised use of the trade mark. The registered owner must show that it has actually exercised control over the use of the trade mark. This is important for registered owners who do not have a place of business in Australia but are seeking to maintain a registration by virtue of authorised use by a licensee.

66 Trade Marks Act (Cth), 1995, s8(1)

11.2 Recordation of Licences

There is no requirement for the recordation of licences in Australia, nor does the Trade Mark Office maintain a register of recorded licensees or "authorised users".

However, the Act does allow for the recordation of rights and interests in trade mark registrations[67]. The recordation of such right does not prove that the right exists. However it does provide the holder of the recorded interest the right to be advised of certain transactions which occur in respect of the trade mark e.g. applications to record assignment. Upon receiving such notice the interest holder may commence court proceedings to prevent the trade mark being affected by the request.

Applications to record rights or interests must be made by both the registered owner and the interest holder.

11.3 Rights of Authorised User

Authorised Users are afforded the following rights under Australian trade mark law[68]:

- an authorised user can commence infringement proceedings at any time with the consent of the registered owner, or where the registered owner refuses to bring such proceedings.
- authorised users can give customs notices to the Australian Customs Service. The authorised user can object to the importation of goods infringing the registered owner's trade mark, with the consent of the registered owner or where the registered owner indicates that it will not lodge an objection.
- authorised users may give permission to any person to alter, deface, make any addition to, remove, erase or obliterate a registered trade mark that is applied to any goods or services, in respect of which the trade mark is registered;
- authorised users may give permission to any person to apply the trade mark to goods or services in respect of which the trade mark is registered.

Trade mark owners who do not want an authorised user to commence infringement proceedings, lodge a customs notice or have any of the other powers provided to them by the Act must be sure to explicitly contract out of this right in an agreement with the authorised user.

67 Trade Marks Act (Cth), 1995, s117
68 Trade Marks Act, (1995) s26

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Assignments

12.1 Goodwill

In Australia, both a pending application and a trade mark registration can be assigned or transmitted with or without the accompanying goodwill. The validity of an assignment cannot be challenged on the basis that it was assigned or transmitted without the goodwill.

If the goodwill is not part of the assignment then without some other transmission of rights, the common law rights to the trade mark i.e. the trade mark rights generated by virtue of use alone, will not inure to the benefit of the Assignee. The acquisition of these common law rights may become important if passing off proceedings or a "first user" dispute needs to be resolved.

12.2 Minimum Requirements to Prove Assignment

For the purposes of recordation, the documents which may be presented to prove the assignment include:

- a deed of assignment;
- an official merger document;
- a simple letter of assignment;
- a probate document in the case of a deceased owner, or death certificate and copy of last will and testament;
- a legislative instrument of transmission; or
- a declaration.

The minimum details required in these documents are:

- the full name and address of both parties,
- the trade mark being transferred by specific identification or some all encompassing term;
- a signature of the current owner; and
- an execution date or effective date.

An assignment may be partial, in the sense that it may relate to some of the goods or services covered by the registration, but it is not possible to limit an assignment geographically to only part of Australia.

Collective trade marks may not be assigned[69] and assignments of Certification trade marks require the consent of the Australian Competition and Consumer Commission[70].

12.3 Financial Implications

We strongly recommend that before assigning or receiving the assignment of a trade mark right in Australia, financial advice is obtained on the tax implications attached to the transaction. It is possible that the transaction results in a liability for the payment of Australian State based stamp duty and/or Federal Capital Gains Tax.

69 Trade Marks Act (Cth) 1995 s166
70 Trade Marks Act (Cth) 1995 s180

12.4 Timing of Recordation of Assignments

There is no requirement for the recordation of the assignment or transmission of a trade mark in Australia. However amendments to the Act in 2007 mean that an unrecorded assignment is no longer enforceable against a purchaser of the trade mark in good faith and for value who had no notice of the unrecorded assignment[71].

However, recordation of the assignment or transmission of a trade mark is important as it determines the rights of the assignee under the Act. For example, only the entity recorded on the Register may obtain relief for infringement under the Act. Additionally, the mark may be vulnerable for removal for non-use if the use is no longer being controlled by the registered owner.

12.5 Death of a Joint Owner of a Trade Mark

If a trade mark is held in the name of joint owners then the holding is as *tenants in common*. Upon the death of one joint owner the trade mark will become part of the assets contained in that person's estate and will not automatically vest in the surviving joint owner.

71 Trade Marks Act, (1995), s22

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Miscellaneous

13.1 Access to Documents Filed

There have been amendments to the Act which make it easier to obtain copies of documents which have been filed in respect of trade mark applications. These new provisions apply to trade mark applications filed after 27 March 2007. Applications filed prior to this date remain under the *Freedom of Information Act* provisions.

Under the new provisions most documents that are filed in respect of a trade mark application are publicly accessible. All that is required to obtain a copy of these documents is the filing of a request with the Registrar and the payment of any applicable fee.

If a document contains confidential information then it is not able to be accessed by the mere filing of a request for a copy, a *Freedom of Information* request must be filed to access this type of document.

Under the *Freedom of Information Act (1982)*, upon the submission of a request and payment of a fee, documents held by the Trade Mark Office which contain confidential information will be assessed for release. The party that has filed the relevant document is given an opportunity to object to the release.

The Trade Mark Office practice indicates that only the following filed documents will now be considered to contain confidential information:

- documents that solely contain evidence of the use or proposed use of a trade mark;
- declarations stating the reasons for a request for expedited examination;
- documents stating the reasons for requesting certain categories of extension of time; and
- documents filed in the course of opposition proceedings, other than notices of opposition.

It is important to note that any documents or information supplied to the Trade Mark Office may be regarded as public information unless a specific request is made for the documents or information to be held confidential.

13.2 Useful Links

Please see below some useful links to governmental websites and websites containing trade mark related information pertaining to Australia:

Australian Trade Mark Act and Regulations
http://www.ipaustralia.gov.au/resources/legislation_index.shtml

Australian Trade Mark Examiner's Manual
http://www.ipaustralia.gov.au/pdfs/trademarkmanual/trade_marks_examiners_manual.htm

Australian Trade Mark Office Register Database (ATMOSS)
http://pericles.ipaustralia.gov.au/atmoss/Falcon_Users_Cookies.Define_User

New Zealand Trade Mark Office Website
http://www.iponz.govt.nz

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