



SOME NOTES ON TRADE MARKS

Three acts – 1905, 1955 and 1995 – need to transliterate sections from old Acts to new Act.

Interpretation of 1955 Act has been applied in some cases to similar concepts in 1995 Act.

1955 Act had two parts of the register – Part A, (inherently distinctive) and Part B (capable of being distinctive)

Trade Mark defined in s 17:

“A 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.”

Trade Marks may be registered - s 19

If a trade mark is registered the registered owner gets certain rights in respect of that mark – s 20 (use, authorise use of mark in relation to goods and services in respect of which the mark is registered)

May apply for registration – s 27:

27 Application how made

(1) A person may apply for the registration of a trade mark in respect of goods and/or services if:

(a) the person claims to be the owner of the trade mark; and

(b) one of the following applies:

(i) the person is using or intends to use the trade mark in relation to the goods and/or services;

(ii) the person has authorised or intends to authorise another person to use the trade mark in relation to the goods and/or services;

(iii) the person intends to assign the trade mark to a body corporate that is about to be constituted with a view to the use by the body corporate of the trade mark in relation to the goods and/or services. Note: For use see section 7.

...

(3) Without limiting the particulars that may be included in an application, the application must: (a) include a representation of the trade mark; and (b) specify, in accordance with the regulations, the goods and/or services in respect of which it is sought to register the trade mark.

...

The Registrar must report on the application s 31

The Registrar must, in accordance with the regulations, examine and report on: (a) whether the application has been made in accordance with this Act; and (b) whether there are grounds under Division 2 for rejecting it.

Registrar must accept/reject application in certain circumstances s 33:

- (1) The Registrar must, after the examination, accept the application unless he or she is satisfied that:
 - (a) the application has not been made in accordance with this Act; or*
 - (b) there are grounds for rejecting it.**
- (2) The Registrar may accept the application subject to conditions or limitations.*
- (3) If the Registrar is satisfied that:
 - (a) the application has not been made in accordance with this Act; or*
 - (b) there are grounds for rejecting it;*the Registrar must reject the application.*
- (4) The Registrar may not reject an application without giving the applicant an opportunity of being heard.*

REJECTION OF A MARK (DIVISION 2)

Certain signs to be rejected – s 39

If can't be represented graphically – s 40

Does not distinguish applicant's goods or services – s 41:

41 Trade mark not distinguishing applicant's goods or services

(1) For the purposes of this section, the use of a trade mark by a predecessor in title of an applicant for the registration of the trade mark is taken to be a use of the trade mark by the applicant.

(2) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered (designated goods or services) from the goods or services of other persons.

(3) In deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons.

(4) Then, if the Registrar is still unable to decide the question, the following provisions apply.

(5) If the Registrar finds that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons but is unable to decide, on that basis alone, that the trade mark is capable of so distinguishing the designated goods or services:

- (a) the Registrar is to consider whether, because of the combined effect of the following:
 - (i) the extent to which the trade mark is inherently adapted to distinguish the designated goods or services;*
 - (ii) the use, or intended use, of the trade mark by the applicant;*
 - (iii) any other circumstances;**

the trade mark does or will distinguish the designated goods or services as being those of the applicant; and

(b) if the Registrar is then satisfied that the trade mark does or will so distinguish the designated goods or services—the trade mark is taken to be capable of distinguishing the applicant's goods or services from the goods or services of other persons; and

(c) if the Registrar is not satisfied that the trade mark does or will so distinguish the designated goods or services—the trade mark is taken not to be capable of distinguishing the applicant's goods or services from the goods or services of other persons.

(6) If the Registrar finds that the trade mark is not inherently adapted to distinguish the designated goods or services from the goods or services of other persons, the following provisions apply:

(a) if the applicant establishes that, because of the extent to which the applicant has used the trade mark before the filing date in respect of the application, it does distinguish the designated goods or services as being those of the applicant--the trade mark is taken to be capable of distinguishing the designated goods or services from the goods or services of other persons;

(b) in any other case--the trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons.

Note 1: Trade marks that are not inherently adapted to distinguish goods or services are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate:

(a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or

Note 2: Use of a trade mark by a predecessor in title of an applicant and an authorised use of a trade mark by another person are each taken to be use of the trade mark by the applicant (see subsections (1) and 7(3) and section 8).

Trade Mark Scandalous or contrary to law – s 42

Trade Mark likely to deceive or cause confusion – s 43 (cf s 28(a) of Campomar Sociedad case)

An application for the registration of a trade mark in respect of particular goods or services must be rejected if, because of some connotation that the trade mark or a sign contained in the trade mark has, the use of the trade mark in relation to those goods or services would be likely to deceive or cause confusion.

Trade Mark substantially identical or deceptively similar to a registered trade mark of another person s 44

(1) Subject to subsections (3) and (4), an application for the registration of a trade mark (applicant's trade mark) in respect of goods (applicant's goods) must be rejected if:

(a) the applicant's trade mark is substantially identical with, or deceptively similar to:

- (i) a trade mark registered by another person in respect of similar goods or closely related services; or*
- (ii) a trade mark whose registration in respect of similar goods or closely related services is being sought by another person; and ...*

OPPOSITION

May oppose the grant of a trade mark. Must only be on a ground in division 2 of Part 5 – s 52

Grounds for opposition:

- Any ground which would have based a rejection – s 57
- Applicant not owner of mark – s 58
- Applicant not intending to use the mark – s59
- Trade mark similar to trade mark which has acquired reputation in Australia – s 60
- False geographical indication – s 61
- Application defective – s 62

REMOVAL OF MARKS FROM THE REGISTER – PART 8

In particular – see section 88 – removal by the Court

- (1) Subject to subsection (2) and section 89, a prescribed court may, on the application of an aggrieved person, order that the Register be rectified by:*
 - (a) cancelling the registration of a trade mark; or*
 - (b) removing or amending an entry wrongly made or remaining on the Register; or*
 - (c) entering any condition or limitation affecting the registration of a trade mark that ought to be entered.*
- (2) An application may be made on any of the following grounds, and on no other grounds:*
 - (a) any of the grounds on which the registration of the trade mark could have been opposed under Division 2 of Part 5;*
 - (b) an amendment of the application for the registration of the trade mark was obtained as a result of fraud, false suggestion or misrepresentation;*
 - (c) because of the circumstances applying at the time when the application for rectification is filed, the use of the trade mark is likely to deceive or cause confusion for a reason other than one for which:*
 - (i) the application for the registration of the trade mark could have been rejected under section 43 or 44; or*
 - (ii) the registration of the trade mark could have been*

opposed under section 60;
(e) if the application is in respect of an entry in the Register--the entry was made, or has been previously amended, as a result of fraud, false suggestion or misrepresentation.

Note 1: For prescribed court see section 190.

Note 2: For file, filing date and registered owner see section 6.

INFRINGEMENT – s 120

120 When is a registered trade mark infringed?

(1) A person infringes a registered trade mark if the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered.

Note 1: For registered trade mark see section 6.

Note 2: For deceptively similar see section 10.

Note 3: In addition, the regulations may provide for the effect of a protected international trade mark: see Part 17A.

(2) A person infringes a registered trade mark if the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to:

(a) goods of the same description as that of goods (registered goods) in respect of which the trade mark is registered; or

(b) services that are closely related to registered goods; or

(c) services of the same description as that of services (registered services) in respect of which the trade mark is registered; or

(d) goods that are closely related to registered services.

However, the person is not taken to have infringed the trade mark if the person establishes that using the sign as the person did is not likely to deceive or cause confusion.

Note 1: For registered trade mark see section 6.

Note 2: For deceptively similar see section 10.

Note 3: In addition, the regulations may provide for the effect of a protected international trade mark: see Part 17A.

(3) A person infringes a registered trade mark if:

(a) the trade mark is well known in Australia; and

(b) the person uses as a trade mark a sign that is substantially

identical with, or deceptively similar to, the trade mark in relation to:

- (i) goods (unrelated goods) that are not of the same description as that of the goods in respect of which the trade mark is registered (registered goods) or are not closely related to services in respect of which the trade mark is registered (registered services); or*
- (ii) services (unrelated services) that are not of the same description as that of the registered services or are not closely related to registered goods; and*
- (c) because the trade mark is well known, the sign would be likely to be taken as indicating a connection between the unrelated goods or services and the registered owner of the trade mark; and*
- (d) for that reason, the interests of the registered owner are likely to be adversely affected.*

Note 1: For registered trade mark see section 6.

Note 2: For deceptively similar see section 10.

Note 3: For well known in Australia see subsection (4).

Note 4: In addition, the regulations may provide for the effect of a protected international trade mark: see Part 17A.

- (4) In deciding, for the purposes of paragraph (3)(a), 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.*

Specific prohibited acts – 121

Exceptions to infringement: 122, 123, 124