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Bill 2001

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Trade Marks and Other Legislation Amendment Bill 2001

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26 June 2001

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# Trade Marks and Other Legislation Amendment Bill 2001

**Date Introduced:** 4 April 2001

**House:** House of Representatives

**Portfolio:** Industry, Science and Resources

**Commencement:** Generally 28 days after Royal Assent, except amendments which hinge on the commencement of 2 other Acts

## Purpose

The purpose of this Bill is to:

- make various technical amendments to the *Trade Marks Act 1995*, and
- minor corrections to the *Patents Amendment (Innovation Patents) Act 2000*.

## Background

### Context and History

The Constitution allocated jurisdiction over trade marks to the Commonwealth,<sup>1</sup> which means that from the outset Australian business has had the advantage of a single national scheme of registered trade marks. Commonwealth trade marks legislation was first enacted in 1905. A review of that legislation in 1954<sup>2</sup> led to the enactment of the *Trade Marks Act 1955*. In 1989 the then Minister, Barry Jones, established a working party with limited terms of reference but over time its brief expanded to become a full-scale review of trade marks law. The working party reported in 1992 and from that review process came the current *Trade Marks Act 1995*, which this Bill amends. Leading intellectual property law academic Professor Sam Ricketson has questioned whether that most recent overhaul of trade marks legislation got to the heart of the issues:

No criticism should be made of the expertise or efforts devoted to this task by members of the working party who were essentially part-time and unpaid (in the case of the non-Trade Marks Office members). Nonetheless, given the fundamental importance of trade marks to Australian business, this method of proceeding was

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seriously flawed, and provided little scope for wider investigation of the objects and functions of the trade marks system or for detailed research into some of the more complex legal issues involved. In this regard, the trade marks reform exercise can be contrasted unfavourably with the more extensive (and better resourced) reviews that were undertaken in respect of patents by IPAC (1980-1984) and of designs by the ALRC (1992 to 1995).<sup>3</sup>

The *Trade Marks Act 1995* (Principal Act) repealed the 1955 Act. It also repealed the *Trade Marks Act 1994*, which was enacted by Parliament the previous year to meet a deadline imposed under international law, but which never commenced. Both the 1994 and 1995 Acts were influenced by international developments, namely the 1994 World Trade Organisation Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). TRIPS was designed to boost internationally the protection of intellectual property rights.

The Howard Government initiated a review of the Principal Act within 9 months of the Act's commencement. The review was given relatively modest objectives:

to identify any errors or omissions in the legislation, identify difficulties in operating the new trade marks system and to recommend appropriate amendments to the legislation.<sup>4</sup>

These modest objectives are reflected in the Bill, which implements the findings of that review. The Bill is about 'fine-tuning' legislation rather than significant policy change, with perhaps one or two exceptions. Most of the Bill either clarifies ambiguities or removes anomalies.

Meanwhile some larger policy issues continue to brew, including:

- the push from the European Union for international trade marks law to go further in protecting the products of particular regions (as has already happened for example with Champagne, wine and spirits),<sup>5</sup>
- concerns about the overlap between trade marks, domain names used on the Internet and business or company names which are the subject of separate State and Territory regimes,<sup>6</sup> and
- the problems with enforcing trade marks and other intellectual property rights.

The first issue is currently the subject of vigorous international trade negotiations, as is that part of the second issue which deals with the overlap between trade marks and domain names. The third issue is reportedly the subject of a separate Commonwealth Government inquiry, being carried out by the Advisory Committee on Industrial Property.<sup>7</sup>

The Government has also had, since September last year, the recommendations of a report which considered the relationship between National Competition Policy and intellectual property legislation.<sup>8</sup> That review (the Ergas Report) recommended amendments to the

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Principal Act to deal with two topics: parallel importation and voluntary trade mark disclaimers, but they have not been included in this Bill.

## A Basic Overview of Trade Marks Law

A trade mark is essentially about branding. While some forms of intellectual property (eg copyright, designs, patents) provide 'creative rights' which regulate and protect human creations and encourage innovation, other laws (such as passing-off and section 52 of the *Trade Practices Act 1974*) regulate misleading and confusing behaviour amongst marketplace competitors by conferring exclusive 'marketing rights'.<sup>9</sup> The law of trade marks falls into the latter category.

A trade mark is a 'sign' which signifies a connection to particular goods or services and which distinguishes it from similar goods or services. It can be a letter, number, word, phrase, shape, logo, picture, aspect of packaging, sound or even (on the as yet unproven assumption it can be graphically depicted) a smell. Some famous examples include 'Redhead matches, Mambo clothing label,...Bananas in Pyjamas, Arnott's biscuits and Rosella soup images'.<sup>10</sup> Obviously a mark can become a very valuable commercial asset and trade mark disputes are common. For example, the Swedish company which owns Redheads matches was reported in January 2001 as taking steps to oppose registration of the Dickheads trademark for foreign-made matches sold by Australian businessman Dick Smith.<sup>11</sup>

To obtain the property and other valuable rights on offer under the Principal Act, the owner of a trade mark must secure registration from the Trade Marks Office.<sup>12</sup> The owner of a registered trade mark has the exclusive right to use it for the nominated goods and services and can sue those who infringe his or her rights. Registration lasts 10 years but can be endlessly renewed if fees are paid on time and basic conditions about use of the trade mark are met. A registered trade mark is an item of property and the associated rights can be bought and sold.

The registration system is similar for patents, trade marks and designs. The applicant lodges details of the trade mark and specifies with which goods and services the mark is associated. The Trade Marks Office checks the application against statutory criteria and exclusions. If accepted, the application is advertised in the Official Journal of Trade Marks (the Official Journal). Opponents have three months to object to registration on specified grounds, but if there is no successful opposition the trade mark is registered from the date of filing the application.

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## The Purpose of Trade Marks Law

The Productivity Commission has suggested that the basic rationale for the state offering exclusive rights to a trade mark owner is 'the prevention of free-riding':

[Trade marks] are used to differentiate similar goods and services and to convey the message that the good bearing the mark possesses a certain quality...A firm that invested substantial resources in building up its reputation through quality control and advertising could lose much of this investment if free-riding competitors were not prevented by law from using its trade marks or very similar marks on their goods and services.<sup>13</sup>

Orthodox liberal economic theory suggests two economic advantages from trade marks. First they are said to 'reduce consumer search costs'<sup>14</sup> because the decision to buy is soundly based on a mark which identifies the product. In other words:

consumers use trade marks to predict quality and thereby reduce the costs which they have to incur in searching the product for the market they want. Reduction of search costs promotes efficient market functioning.<sup>15</sup>

Secondly it is claimed that to preserve this effect, the producer has an incentive to create and maintain a consistent quality of product, so that the product and the consumer perception associated with the mark continually reinforce each other.<sup>16</sup>

These economic claims are of course open to dispute. By granting monopoly or oligopolistic rights, the trade marks regime creates barriers to entry and may lower competition. Arguably it may also interfere with market efficiency by creating irrational brand loyalty, unrelated to product quality or price. Wasteful advertising and excessive distribution costs also reduce economic efficiency. Labelling and remedies against deceptive advertising under the Trade Practices Act offer alternative means of quality assurance and reducing search costs.<sup>17</sup>

One legal academic has implied that consumer protection or benefit is not really at the heart of recent trends in trade marks law:

it is arguable that trade marks do little more than promote brand loyalty and non-price competition, both of which are to the ultimate detriment of consumers. We consumers sometimes pay a hugely significant price premium for trade marked goods. I bet you'd pay three times more for a NIKE than you would for an identical running shoe marked NUKE or NOKE or NEKE. We are paying more than we need to, arguably more than we should.

These arguments may be right but the time is not right for them to be listened to. Trade marks and trade mark protection are getting stronger not weaker, largely because big international corporate traders backed by their governments are in command of the global economy and increased trade mark protection is strongly in their interests....<sup>18</sup>

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The Government's position is that trade marks

allow traders to build and protect trade reputations, and this can increase their sales and the value of their investments. At the same time consumers benefit from the trade mark systems through increased confidence in the origin and quality of goods and services.<sup>19</sup>

## Main Provisions

Schedule 1—Amendment of the *Trade Marks Act 1995*

### Infringement Actions by Authorised Users

Registration of a trade mark gives the owner the exclusive right to use it in relation to the nominated goods and services. It also gives him or her the exclusive right to authorise others to use it.<sup>20</sup> The Act grants an *authorised user* a limited set of statutory rights in section 26, subject to any agreement with the trade mark owner. For example, like an owner, an authorised user can take court action over infringement of a trade mark. But at present an authorised user must first ask the owner to take action and allow them two months<sup>21</sup> to do so (the 'prescribed period'). **Item 3** alters this situation so that an authorised user need not wait for the two months to expire before they sue an infringer if:

- they have the consent of the registered owner, or
- a registered owner indicates during the 2 month period that they will not bring such an action.

The change will only apply where the prescribed period begins after the commencement of this amendment: **item 4**. **Item 37** is consequential on item 3.

### Divisional Applications by Assignees

**Item 6** removes an anomaly which hampers those who acquire an interest in a pre-existing trade mark. It relates to divisional applications. Divisional applications are later-in-time applications made from within the four corners of an earlier 'parent' application. Divisional applications can be made while the parent application is pending, either for part of the trade mark or in respect of some only of the originally nominated goods or services.

It is possible that a trade mark owner might assign his or her interest while an application for registration is pending. At present, if the assignee wanted to lodge a divisional application, the words of section 45 block their path. Only the person who originally lodged the application for registration can make a divisional application. **Item 6** will allow whoever is the actual applicant for registration at the time to make a divisional application, regardless of who filed the 'parent application'.

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**Items 7 and 8** further clarify the amendment made by **item 6**. The change of wording in section 45 will render section 46 of the Principal Act redundant and therefore **item 9** repeals the latter provision.

### Extensions of Time Where an Opponent Assigns Their Interest

An applicant for registration of a trade mark must survive a period of potential challenge, the 'opposition' phase. An opponent of registration has 3 months from notification in the Official Journal in which to file a notice of opposition.<sup>22</sup> The Registrar has the power to grant an extension of time, to file *after* 3 months have expired. **Item 11** corrects an anomaly which can emerge when extra time has been granted.

Sometimes an opponent may sell the interest which forms the basis for their opposition to registration (eg rights in a similar trade mark). If they do so *after* a notice of opposition has been filed, the new holder of the interest becomes the official opponent of registration.<sup>23</sup> But if the sale or transfer occurs *before* the notice of opposition is filed, then the new holder of the interest does not obtain an extension of time if one was previously granted. They lack authority under the Act to carry on the opposition proceedings (starting with the late lodgement of the notice of opposition). **Item 11** will give the new interest holder the benefit of any extra time granted to the original opponent and allow them to press on with opposition to registration of the trade mark.

**Item 10** is consequential on **item 11**. The new provision will only apply to sales or transfers which occur after commencement of the amendments: **item 12**.

### Amending an Application for Registration of a Trade Mark

The Principal Act permits applicants to amend their application for registration of a trade mark. In some circumstances the Registrar can amend an application *on his or her own initiative*. **Item 13** broadens this power to permit the Registrar to make such an amendment 'so as to ensure that the application is made in accordance with this Act'.

### Registration of a Trade Mark

The Act currently provides that a trade mark which meets the statutory requirements must be registered by the Registrar in either of two circumstances:

- the application is not opposed, or
- the application is opposed but the applicant obtains a favourable decision from the Register after the opposition proceedings have been heard (or from a court on appeal from the decision of the Registrar).<sup>24</sup>

There is a technical deficiency in this part of the Act. Opposition proceedings may fail or fall away for reasons other than a decision by the Registrar or a court—but the Act is silent about these scenarios, which disadvantages applicants for registration.

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**Item 14** recognises that opposition proceedings may be *withdrawn*, or they may be dismissed because an overseas opponent fails to provide security against legal costs when required to do so under section 222. In both instances, as a result of **item 14**, the Registrar must register the trade mark.

To avoid the anomaly in the past, the Registrar may have gone ahead and registered trade marks, despite the silences in the Act about his or her power to do so. In case these registrations were invalid, **item 15** validates them retrospectively.

### Renewal of Registration

Ordinarily registration lasts 10 years from the date the application for registration was lodged (the 'filing date').<sup>25</sup> Currently Part 7 Division 2 of the Act provides for renewal of registration and a trade mark can be renewed for an unlimited number of consecutive terms if the statutory requirements are met.

There is, however, a technical defect in the Act which applies in a particular situation. It is possible that an application for registration of a trade mark may not be finalised when 10 years have elapsed since the application was lodged. As the Explanatory Memorandum explains:

These applications are most often held up by opposition proceedings or legal actions. On very rare occasions, as a result of extremely protracted litigation, a trade mark may not be registered until after 20 or more years from its filing date. These provisions provide the necessary basis for renewal of the registration of such marks, and ensure that the owners of such trade marks have the same flexibility in renewing their registrations as the owners of trade marks that are registered within ten years from their filing dates.<sup>26</sup>

The defect applies to applications still pending after 10 years: essentially their renewal is not contemplated by the words in Part 7 Division 2. The Bill proposes two solutions:

1. *Validate* past renewals under Division 2 where more than 10 years elapsed before registration, and a purported renewal was made at some time before commencement of the **item 23**. This will overcome the problem that some renewals may have been made invalidly because of the Act's failure to cater for applications still pending after 10 years.
2. Provide a separate Division 2 and Division 3 dealing with renewals. Division 2 will deal with the standard renewal of a trade mark which is registered within 10 years of its filing date. It will also cater for *later* renewals of trade marks in the other category (original registration occurring *after* 10 years have elapsed). The *first* renewal of registration for trade marks in this other category will be governed by **proposed Division 3** of Part 7.

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### Division 2: Standard Renewals

The process for standard renewals under Division 2 will remain essentially unchanged. **Item 21**, however, corrects one anomaly in the current system. It will ensure that an arbitrary difference in dates (ie when a third party application for registration was made) does not prejudice the rights of a trade mark owner in the 12 month period of grace after their registration expires (nor prejudice the rights of other potential opponents to the third party application).

Also, **item 22** removes an ambiguity in Division 2 which threatens the viability of third party applications, where both the 10 year term and the subsequent 12 month period of grace of a rival trade mark have expired without renewal.

**Items 18-20** are consequential on the creation of a two-tiered approach to renewals in Divisions 2 and 3 of Part 7.

### Division 3: Renewals Where Registration is Delayed More than 10 Years

When registration is first granted for a trade mark, the start of the 10 year term is backdated to the filing date of the application.<sup>27</sup> Despite the abstract nature of the provision, for convenience the same principle will apply to an application which is not determined until after 10 years have elapsed: **new section 80B**.

If the Registrar registers a trade mark more than 10 years after the filing date, the initial term has thus already expired. **New section 80C** therefore requires the Registrar to notify the trade mark owner of their right to seek renewal as soon as possible after entering the trade mark on the Register.

The Regulations will specify a time limit which applies to a person seeking renewal in this situation (the 'prescribed period'). It will run from the day on which the Registrar enters details of the trade mark on the Register: **new section 80D and new subsection 80A(3)**.

A valid request for renewal in this situation must be granted: **new section 80E**. If a renewal is not made, the registration lapses as from the end of the relevant term. The Registrar must remove the trade mark from the Register once 10 months have elapsed since the prescribed period expired: **new section 80F**. As with standard renewals under Division 2, however, a period of grace allows registration to be revived as if it never lapsed. If a person validly seeks renewal within the period of grace (ie 10 months from the end of the prescribed period for a renewal application) then the Registrar must renew registration of the trade mark: **new section 80G**. An unrenewed trade mark covered by Division 3 remains a ground for opposing a rival trade mark until the 10 month period has expired: **new section 80H**.

**Item 16** is consequential on the insertion of **new section 80F**. **Items 29 and 30** are consequential on the insertion of **new section 80G** - they deal with the bar on plaintiffs taking infringement proceedings for acts done while the plaintiff had left a mark temporarily unregistered.

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### Asking a Court to Cancel Registration of a Trade Mark

An aggrieved person can ask a court to cancel the registration of a trade mark or alter an entry on the Register. Section 88 sets out some of the circumstances in which this can occur. **Item 25** removes one of the grounds specified. Paragraph 88(2)(d) says that an application for cancellation or amendment can be made where:

- the Registrar was satisfied at the time of application that the intended use of the trade mark and its inherent characteristics meant it would distinguish the nominated goods and services as being the applicant's
- at least 10 years have elapsed since the application was filed, and
- there has been insufficient use of the trade mark in the intervening period for it actually to distinguish the owner's goods and services.

**Item 25** repeals this ground. Apparently the main objection is that it mentions grounds which go beyond what are required to obtain registration in the first place. In his Second Reading Speech the Minister asserted:

Having different sets of criteria apply is clearly unsatisfactory—indeed there is the possibility that a person whose trademark was removed from the register by the court under this provision could immediately successfully re-apply for registration of the trademark. The repeal of this provision will therefore remove the uncertainty inherent in this provision.<sup>28</sup>

The upshot of this amendment appears to be that a trade mark owner retains their monopoly rights despite holding a trade mark which was perhaps borderline at the time of registration and which has not been used in the way the system is set up to encourage. If indeed a court cancelled registration on this ground it is difficult to see why the Registrar would be persuaded to re-register it on a fresh application. And there is surely a difference between seeking initial registration for a trade mark and seeking its de-registration more than 10 years later alleging non-use—why shouldn't different considerations apply to these different situations? Parliament may wish to test further whether the case for this amendment has been convincingly made.

**Items 42** and **44** are consequential on the repeal of paragraph 88(2)(d) by item 25.

The Principal Act also allows an aggrieved person to seek the removal of a trade mark from the Register on the basis that it has not been used in relation to the nominated goods and services.<sup>29</sup> A person can oppose such a 'non-use' application for removal. Someone who acquires the relevant interest from such an opponent will be permitted to carry on the opposition proceedings, as a result of **item 26**. This parallels the current situation on the other side of fence, where a successor-in-title to the aggrieved person alleging non-use can also continue the proceedings.

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### Infringement of a Trade Mark

The Principal Act allows a plaintiff to obtain an injunction, an account of profits or damages where their registered trade mark is infringed by 'free riders'.<sup>30</sup> Certain conduct will not amount to infringement, however, and a list is set out in section 122. **Item 27** makes a significant addition to the list: where the alleged infringer uses a trade mark 'substantially identical with, or deceptively similar'<sup>31</sup> to the plaintiff's trade mark, but a court believes that the alleged infringer would obtain registration if they applied for it (**new paragraph 122(1)(fa)**). This broadens the ground set out in the previous paragraph of the Principal Act: that a person will not infringe if they use the *same* mark but the court believes they would obtain registration if they applied for it.

Item 27 may have a significant effect, therefore it is surprising that more detail of its rationale is not provided in the Explanatory Memorandum. Users of an unregistered trade mark which is deceptively similar to a registered mark will not infringe, where the court thinks they could have obtained registration if they applied. The purpose of the monopoly right system is to prevent consumer confusion and distinguish goods and services. Parliament may wish to consider whether this amendment undercuts that policy objective, or at least ascertain why the amendment is perceived to be necessary.

Section 127 of the Principal Act provides for a special case where damages are not payable for infringement during what is called the 'critical period'. If:

- a court finds a person has infringed a trade mark, but
- that person has applied to have the trade mark de-registered on the grounds of non-use, and
- the court finds that because of non-use in a critical period there are grounds for de-registration,

then damages are not payable for infringement during that critical period of non-use. The same goes for an account of profits. **Item 28** simply ensures that this rule applies where procedurally the matter came before the court by a slightly different path. In other words it removes an existing anomaly in the Principal Act.

### Importing Goods which Infringe an Australian Trade Mark

A registered trade mark owner can lodge an objection with Customs about the importation of goods that infringe their trade mark. An authorised user can also do so, provided they are not prevented by their contract with the owner and provided they have first asked the owner to lodge the objection and the latter has failed to do so within two months.<sup>32</sup> **Item 31** is similar to item 3: it expands the situations where the authorised user can lodge the objection, so that an authorised user need not wait for two months to expire if:

- they have the consent of the registered owner, or

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- a registered owner indicates during the 2 month period that they will not lodge an objection.

The change will only apply where the two month period begins after the commencement of this amendment: **item 32**.

When imported goods are brought to the notice of Customs in this way, Customs may proceed to seize them if satisfied they infringe the relevant trade mark. An objector may also launch infringement proceedings. If the objector does not obtain a court order within 3 weeks, Customs must then release the goods. **Items 34** extends this period to 20 working days 'to allow additional time for the objector to obtain the necessary court order'.<sup>33</sup> **Item 35** clears up a textual ambiguity and **item 36** corrects a minor error.

### Criminal Matters

Currently the Act forbids officials within the Trade Marks Office from assisting people filing documents or seeking information except where a court or the law directs them to do so. The offence is one of strict liability and the fine is 10 penalty units.<sup>34</sup> **Item 38** removes the provision in the name of better customer service for users of the Trade Marks Office.

Section 159 ensures that a forfeiture order under the *Proceeds of Crime Act 1987* can be sought where someone other than the Director of Public Prosecutions has taken criminal proceedings against a person under the Trade Marks Act. **Items 39-41** make technical amendments to ensure the section achieves its purpose.

### Certification Trade Marks

A certification trade mark shows that goods meet a particular standard or accuracy or have a particular origin or composition etc. For example, the Woolmark is a certification trade mark indicating that a garment uses 100% pure new wool.

Section 180 of the Principal Act requires the Australian Competition and Consumer Commission to consent, before a registered certification trade mark can be assigned. **New section 180A** imposes the same requirement before an *unregistered* trade mark is assigned, where an application for registration has been lodged.

### Security for Costs

As noted earlier, the Registrar may require an opponent party or someone seeking de-registration for non-use to give security for the costs of the proceedings, if the party neither resides in Australia nor carries on a business here.<sup>35</sup> At present this catches an opponent to an application for de-registration on the basis of non-use (ie someone who did not commence the proceedings). **Item 45** removes this anomaly by specifying the categories of opponent party to which section 222 is intended to apply.

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## Transitional Provisions

Part 22 of the Principal Act contains repeals and transitional provisions. **New section 254A** will protect certain parties from being held liable for infringement as a result of the transition between the 1955 Act and the 1995 Act. **New sections 254B** and **254C** extend protection to people who might technically be treated as infringers, even though they have engaged continuously in conduct which was lawful under the 1955 Act since before 1 January 1996.

## Concluding Comments

As noted already, this Bill is essentially a technical exercise in fine-tuning legislation which was enacted by Parliament in 1995. This Digest has raised questions, however, about **items 25** and **27**. Arguably in each case the amendment makes a significant policy change but it is questionable whether the Government has made a convincing case for that change in the Explanatory Memorandum and Second Reading Speech.

## Endnotes

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- 1 Section 51(xviii).
- 2 *Report of the Committee Appointed by the Attorney-General of the Commonwealth to Consider What Alterations are Desirable in the Trade Marks Law of the Commonwealth*, Government Printing Office, Canberra, 1954.
- 3 Sam Ricketson, *Intellectual Property Administration and Policy in Australia. An Examination of the Australian Situation, Past and Present, and Recommendations for Future Change*, Melbourne, 2000, <http://www.isr.gov.au/industry/summit/reference/submissions/71-Ricketson.pdf> (16 May 2001) at p. 45.
- 4 IP Australia, *Improving the legislation*, [http://www.ipaustralia.gov.au/about/A\\_leg1.htm](http://www.ipaustralia.gov.au/about/A_leg1.htm) (16 May 2001).
- 5 John Revesz, *Trade-Related Aspects of Intellectual Property Rights*, Productivity Commission Staff Research Paper, May 1999, at 3.7 and Appendix A6, <http://www.pc.gov.au/research/staffres/trips> (16 May 2001).
- 6 See Department of Industry, Science and Resources, *Submission to the Intellectual Property and Competition Review*, November 1999, p. 18, <http://www.ipaustralia.gov.au/library/PDFS/general/review.pdf> (16 May 2001). See also Intellectual Property and Competition Review Committee, *Review of Intellectual Property Legislation under the Competition Principles Agreement*, September 2000, <http://www.law.gov.au/ipcr/finalreport1dec/welcome.html> (16 May 2001).

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- 7 Department of Industry, Science and Resources, *Annual Report 1999-2000*, [http://www.isr.gov.au/departement/annualreport99\\_00/html/Untitled/ip.html](http://www.isr.gov.au/departement/annualreport99_00/html/Untitled/ip.html) (16 May 2001).
- 8 Intellectual Property and Competition Review Committee, *Review of Intellectual Property Legislation under the Competition Principles Agreement*, September 2000, <http://www.law.gov.au/ipcr/finalreport1dec/welcome.html> (16 May 2001).
- 9 See Patricia Loughlan, *Intellectual Property: Creative and Marketing Rights*, LBC, Sydney, 1998.
- 10 IP Australia, *2001 Corporate Profile*, Canberra, 2000, p. 4, <http://www.ipaustralia.gov.au/library/PDFS/general/2001CorporateProfile.pdf> (16 May 2001).
- 11 Allison Jackson, 'Dick Smith's match war heating up', *Sydney Morning Herald*, 20 January 2001.
- 12 This is located within IP Australia, which is a division of the Department of Industry, Science and Resources.
- 13 Revesz, *op cit*, p. 42.
- 14 *ibid*.
- 15 Loughlan, *op cit*, pp. 162–163.
- 16 See *ibid*, p 163 and Revesz, *op cit*, p. 43.
- 17 *ibid*.
- 18 Loughlan, *op cit*, p. 163.
- 19 IP Australia, *Our Corporate Plan. Strategic Directions 1999-2003*, Canberra, 1999, p. 1, which can be found at <http://www.ipaustralia.gov.au/library/PDFS/general/sdir99.pdf> (21 June 2001).
- 20 *Trade Marks Act 1995*, subsection 20(1).
- 21 The 'prescribed period' defined in Regulation 3.2 of the Trade Marks Regulations 1995.
- 22 Regulation 5.4 of the Trade Marks Regulations 1995.
- 23 Section 53.
- 24 Section 68.
- 25 Subsection 72(3).
- 26 Page 7.
- 27 Subsection 72(1).
- 28 The Hon Warren Entsch, House of Representatives, *Debates*, 4 April 2001, p. 26349.
- 29 Section 92.
- 30 Part 12.

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- 31 Section 10 says that 'a trade mark is taken to be deceptively similar to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion'.
- 32 Section 132 and Regulation 13.2.
- 33 Explanatory Memorandum, p. 11.
- 34 Section 158.
- 35 Section 222.

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