CONTENTS

1. Introduction .............................................................................................................................................. 6
  1.1 What is intellectual property? .................................................................................................................. 6
  1.2 Introduction to Trademarks and Rationales for Protection ................................................................. 7
    Wagamama v City Centre Restaurants [1995] FSR 713 ........................................................................... 8
  1.3 Application process for registration of a trade mark ................................................................................. 11
    1.3.1 Application (ss27-28) ....................................................................................................................... 11
    1.3.2 Publication (s30) .................................................................................................................................. 16
    1.3.3 Examination (ss31-37) ...................................................................................................................... 17
    Blount Inc v Registrar of Trade Marks (1998) 83 FCR 50; 40 IPR 498 ............................................. 18
    1.3.4 Acceptance (s33(2)) .......................................................................................................................... 24
    1.3.5 Opposition (ss52-56 Procedure) (ss57-62A grounds) ................................................................. 27
  1.4 Ownership of marks (sS27, 58) ................................................................................................................ 33
    E & J Gallo Winery v Lion Nathan Australia Pty Ltd (2010) 241 CLR 144 (Foreign owner) ............ 33
    Blackadder v The Good Roads Machinery Co Inc (1926) 38 CLR 332 (“winner”)............................ 33
    Aston v Harlee Manufacturing Co (1960) 103 CLR 391 (“tasty Freeze”) ........................................... 34
    Thunderbird Products Corporation v Thunderbird Marine Products Pty Ltd (1974) 131 CLR 592 (“POWER BOAT”) ................................................................. 34
    Lucas Finance Pty Ltd v Dig This Entertainment Pty Ltd [2007] ATMO 35 (Abandonment) ........... 34
    Ward Group v Brodie & Stone [2005] FCA 471 (“restoria”) .............................................................. 35
  1.5 Role of the specification .......................................................................................................................... 35
  1.6 Regulation of specification ..................................................................................................................... 35
  1.7 Classes of services .................................................................................................................................. 35
  1.8 Examination and Amendment ............................................................................................................... 37

2(A). Absolute Grounds of Refusal I .......................................................................................................... 38
  1. Does the mark satisfy the concept of a ‘sign’? (ss 6, 17 TMA) ............................................................. 38
    2. Relevant considerations regarding ‘non-traditional’/’new’ subject matter ........................................ 39
      2.1 Shapes................................................................................................................................................ 39
        Re James’ Trademark (1886) (Lindley LJ) ......................................................................................... 39
        Smith Kline & French Laboratories (Australia) Ltd v Registrar of Trade Marks (1967) 116 CLR 628 . 39
        Re Coca-Cola Trade Marks [1986] RPC 421 (HoL) ....................................................................... 39
        Philips v. Remington [2000] FCA 876 (SHAVEr) ............................................................................ 40
        Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks [2002] (BUG) ............................. 40
      2.2 Colours.............................................................................................................................................. 41
        Philmac Pty Ltd v Registrar of Trade Marks (2002) (Terracotta) ................................................. 43
      2.3 Sounds.............................................................................................................................................. 43

2.4 Scents .......................................................................................................................................................... 43
2.5 Other .......................................................................................................................................................... 43

3. Ground for rejection: cannot be represented graphically (s 40 TMA) .................................................. 45
   3.1 Australian approach .................................................................................................................................. 45
   3.2 Sieckmann factors (EU Approach) .......................................................................................................... 45

4. Ground for rejection: prohibited and prescribed signs (s 39 TMA) ......................................................... 46

5. Ground for rejection: scandalous (s 42(a) TMA) ....................................................................................... 47
   5.1 Meaning of ‘scandalous’ ............................................................................................................................. 47
   5.2 What standard should be applied? .............................................................................................................. 48
   5.3 Other considerations .................................................................................................................................. 48
   5.4 Examples .................................................................................................................................................. 48

6. Ground for rejection: contrary to law (s 42(b) TMA) ................................................................................ 52
   6.1 Contrary to specific provisions of legislation .......................................................................................... 52
   6.2 Special problem of s 18 Australian Consumer Law and passing-off ..................................................... 52

7. Ground for rejection: signs likely to deceive or cause confusion (s 43 TMA) ......................................... 53
   7.1 Standard for identifying confusion .......................................................................................................... 53
   7.2 Confusion as to certain characteristics or qualities .................................................................................. 53
   7.3 Confusion as to geographical origin ........................................................................................................ 54
   7.4 Marks falsely suggestion connection, affiliation, license or sponsorship ............................................. 56

2(B). Absolute Grounds of Refusal II ............................................................................................................... 58

1. The Requirement of Distinctiveness (s 41 TMA) .......................................................................................... 58
   1.1 Inherently adapted to distinguish: s 41 (1) ................................................................................................. 58
   1.2 Partial Inherent Distinctiveness: s 41 (4) .................................................................................................... 59
   1.3 Not at all Distinctive: s 41 (3) ..................................................................................................................... 60
   1.4 Overview of Types of marks and s41 ........................................................................................................ 61
      1.4.1 Descriptive Terms .................................................................................................................................. 61
      1.4.2 Geographical Terms ............................................................................................................................ 61
      1.4.3 Personal Names ................................................................................................................................... 62
      1.4.4 Losing Distinctiveness (s 24, 87) ......................................................................................................... 62

3. Relative grounds of refusal .......................................................................................................................... 63

1. Substantial Identity and Deceptive Similarity of Marks ............................................................................. 63
   1.1 Substantial Identity ..................................................................................................................................... 63
   1.2 Deceptive Similarity .................................................................................................................................. 63
   1.3 Families of Marks ..................................................................................................................................... 64

2. Similarity of Goods and Services ................................................................................................................ 64

3. Honest Concurrent Use ................................................................................................................................ 65

4. Prior Continuous Use ................................................................................................................................... 66

5. Reputation ..................................................................................................................................................... 66
6. Bad Faith .................................................................................................................................................. 66

4(A). Infringement ....................................................................................................................................... 68
1. Use ‘as a trade mark’ (s120(TMA)) ........................................................................................................ 68
   1.1 Mere descriptive or generic use (Kettle)............................................................................................ 68
   1.2 Communicative/Decorative Use (TOP HEAVY) ............................................................................... 69
   1.3 Nominative Use (YEAST) .................................................................................................................. 69
   1.4 Shapes................................................................................................................................................ 69
2. Substantial Identity/Deceptive similarity (MID) ..................................................................................... 70
3. Dilution and Well-known marks (s120(3)(4))......................................................................................... 70
4. DEFENCE: Consent of registered owner (s123) ..................................................................................... 71
5. DEFENCE: Prior continuous use of a common law mark (s124)............................................................ 71
6. DEFENCE: Good Faith Use (s122(1)) .................................................................................................... 71
   6.1 Use of own name or name of business (s122(1)(a)) ........................................................................... 71
   6.2 Descriptive use in good faith (s122(1)(b)).......................................................................................... 71
   6.3 Spare parts or accessories (s122(1)(c))............................................................................................... 71
   6.4 Comparative advertising (s122(1)(d))............................................................................................... 71
   6.5 Mantra Group v Tailly [2010] ............................................................................................................ 72
7. Remedies (s20, 126) .............................................................................................................................. 74

4(B). Maintenance/Loss of Registration .................................................................................................... 75
1. Grounds for rectification .......................................................................................................................... 75
   1.1 Removal by Registrar........................................................................................................................... 75
   1.2 Removal by Court ............................................................................................................................... 75
   1.3. Discretion not to rectify register ....................................................................................................... 76
2. The requirement of use ............................................................................................................................ 76
   2.1 Licensing of a trademark – a form of ‘use’ ....................................................................................... 77
3. Renewal .................................................................................................................................................... 78

5. Passing Off ............................................................................................................................................... 79
1. Section 18 ACL and the relationship with passing off........................................................................... 79
   1.1 Hornsby Building Information v Sydney Building Information (1978) .............................................. 79
   1.2 Parkdale Custom Built Furniture Pty Ltd v Puxu Pty Ltd (1982) (Read label!) ............................... 79
2. The basic test of passing off.................................................................................................................... 80
3. Goodwill/reputation ............................................................................................................................... 80
   3.1 Generally .......................................................................................................................................... 80
   3.2 The temporal element ....................................................................................................................... 81
   3.3 The geographic element (international reputation and the protection of well-known marks) ....... 81
4. Misrepresentation ..................................................................................................................................... 82
   4.1 Relevance of intention to deceive .................................................................................................. 83
   4.2 Common field of activity ............................................................................................................... 83
5. Damage .................................................................................................................................................. 85
6. Remedies and proof................................................................. 86
   6.1 Proving consumer deception.................................................. 86
   6.2 Remedies.................................................................................. 86
7 A tort of unfair competition?....................................................... 86

6. Introduction to Patents; The Registration Process ......................... 88
1. Introduction to Patents.................................................................. 88
   1.1 The incentive rationale ............................................................. 88
   1.2 The disclosure/social bargain rationale (the patent ‘quid pro quo’) .......................................................... 89
   1.4 Controversies: Cornish (2004) .................................................. 90
   1.5 Legislative Regime of Patents...................................................... 91
2. Registration Process..................................................................... 92
   2.1 Application and the First to File system (s29) ......................... 93
   2.2 Priority Date (s43) .................................................................... 93
   2.3 Publication (s53) ....................................................................... 94
   2.4 Request for Examination (s44) .................................................. 94
   2.5 Acceptance (s49) ....................................................................... 95
   2.6 Opposition (s59) ........................................................................ 95
   2.7 Sealing (s13) ............................................................................ 95
   2.8 Renewal and Extension (s67) ..................................................... 95
   2.9 Amendment.............................................................................. 96
   2.10 Re-examination and Revocation (s138) ..................................... 97
3. The Specification (s40)................................................................. 97
   3.1 Disclosure (formerly ‘Sufficiency of Description’) – s40(2)(a) .......................................................... 100
   3.2 Best Method of Performance – s40(2)(aa): .................................. 101
   3.3 Support (formerly ‘fair basing’), Clarity, Succinctness – s40(3) .......................................................... 102
   3.4 Claims: Role and Interpretation ............................................... 103

7. Patentable Subject Matter .......................................................... 106
1. Manner of manufacture .............................................................. 106
2. Medical treatment, human beings, genes and other biotechnological inventions .............................................. 106
   2.1 Medical treatment.................................................................. 107
   2.2 Genes....................................................................................... 107
   2.3 Micro-organisms .................................................................... 108
3. Computer Programs and Business Models .................................. 109
   3.1 Computer Programs................................................................. 109
   3.2 Business Models ..................................................................... 110
   3.3 US and European positions on Computer Programs and Business Methods ............................................. 111
4. Contrary to Law or Generally Inconvenient .................................. 112

8. Patentability Standards ............................................................... 113
1. Novelty (s18(1)(b)(i)) .................................................................. 113
1. What is the relevant ‘prior art’ base? (s7) ................................................................. 114
1.2 What level of disclosure is required – ‘Reverse Infringement Test’ (Meyers) .......... 115

2. Inventive step or ‘obviousness’ (s18(1)(b)(ii)) ................................................................. 116
2.1 Who is the PSA? (Elconnex) ...................................................................................... 117
2.2 Knowledge of the PSA s7(3) ...................................................................................... 117
2.3 Standard required in AUS: ‘scintilla of evidence’ ....................................................... 118
2.3.1 A higher US standard: ‘obvious to try’ defeats novelty: KSR ................................... 119

3. Utility (s18(1)(c)) .......................................................................................................... 120
3.1 The meaning of ‘useful’. ............................................................................................. 120

4. Secret Use (s18(1)(d)) ................................................................................................... 121
4.1 Secret use by third parties? ....................................................................................... 121
4.2 The meaning of ‘secret’ ............................................................................................. 121
4.3 The meaning of ‘use’ ................................................................................................. 121

9. Ownership and Exploitation ....................................................................................... 123
1. Ownership .................................................................................................................. 123
1.1 Patents Act 1990 (Cth), ss 13, 15, 16 .................................................................. 124
2. Exploitation ................................................................................................................ 127
3. Assignment .................................................................................................................. 128
   Patents Act 1990 (Cth), ss 14, 196 REG 19.1 ............................................................. 129
4. Licensing ..................................................................................................................... 129
5. Exhaustion of rights .................................................................................................... 131
6. Patent Strategy .......................................................................................................... 131

10. Infringement and Defences ....................................................................................... 133
1. Infringement ................................................................................................................ 133
1.1 Direct Infringement ................................................................................................. 133
1.2 Indirect Infringement ............................................................................................... 133
1.3 Authorisation .......................................................................................................... 133
1.4 Burden of Proof (s121A) ......................................................................................... 133
1.5 Remedies s 122 ....................................................................................................... 134
2. Exceptions to Patent Infringement ........................................................................... 135
2.1 Defence for Experimental Use (s119C) ................................................................. 135
1. INTRODUCTION

1.1 WHAT IS INTELLECTUAL PROPERTY?

- Subject matter of IP rights
  - “Intellectual” refers to property over the products of the mind broadly conceived
  - Copyright – grants rights to authors/composers
  - Trademarks – rights to symbols used in trade
  - Patents – rights to inventions
  - Designs – rights to appearance of goods
  - Confidential information – prevents others using or revealing confidential information e.g. trade secrets.
  - Related rights – geographical indications, domain names, plant breeder’s rights.
  - Differences between the kinds of IP rights are important – delineate how a right is attained and how long it last
    - E.g. copyright you get instantly and it lasts for the life of the author plus 70 years after their death. Patents you have to apply for and they last for 20 years from the date that you apply for the patent

- The nature and implication of rights over intangibles
  - IP rights aren’t naturally, or easily property
  - Right over intangibles does not grant rights over the tangible objects which result, e.g. right to design of a chair does not give you property rights in every chair created according to that design

- What does it mean to have a ‘property right’?
  - A property right is ‘that sole and despotic dominion which one man claims and exercises over the external things of the world, in total exclusion of the right of any other individual in the universe.’ (Blackstone)
  - Property right is also ‘a legally enforceable power to exclude others from using a resource, without need to contract with them.’ (Landes & Posner)
  - Rights are granted as against the world (in rem)
  - It is a bundle of different rights which depends on the type of property that is being protected
  - Allows exclusion of others, sale or licensing of rights, ability to derive income

- Roles of IP law
  - Define the kinds of products of the mind in which our legal system will grant property rights – what are we going to protect?
  - Define the kinds of rights that will be granted in those things and the exceptions
  - Define how long those rights will last
  - Establish systems for conferring, managing, and enforcing those rights

- Registration and creation
  - Some IP rights arise only on registration, others are inherent
  - Those types of IP that require registration e.g. trade marks, patents, design, rely on the registration to create enforceable rights
  - Unregistered rights e.g. copyright and confidential information, are actionable from the beginning.

- Duration of protection
  - Trade marks last 10 years but are indefinitely renewable as long as you use them
• Patents last 20 years from date of application

• Importance of international conventions
  o Because these property rights aren’t natural as such, the treaty system is important
  o IP rights generally only enforceable in the country granting them: problem for people who wanted to trade across borders before there were international treaties
  o Treaties establishing minimum standards
    ▪ Paris Convention
    ▪ TRIPS (Trade Related Aspects of Intellectual Property Rights)
    ▪ AUSFTA (Aus-US Free Trade Agreement)
  o Treaties establishing minimum administrative standards
    ▪ Trademark Law Treaty 1994
  o Treaties that “grease the global application wheels”
    ▪ Madrid Protocol
    ▪ Patent Cooperation Treaty (PCT)
  o Australia has limited discretion in shaping its own IP system because the international treaties are very detailed and provide the basis for Australia’s obligations
  o If you want global protection of your trademark in other countries, you have to apply in those countries, but the Madrid Protocol and PCT allow you to make one application which is then sent to all the countries that you nominate where you want protection (apply to WIPO – World Intellectual Property Organisation - which is a UN body)
  o Different countries might take different views on the outcome of your WIPO application though

1.2 INTRODUCTION TO TRADEMARKS AND RATIONALES FOR PROTECTION

• What is a trade mark
  o TMA s17 - 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
  o TMA s6 – ”sign” includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent.
  o A trade mark is a sign that helps you recognize the source of a product. For example
    ▪ shape of packaging
    ▪ words in fancy script
    ▪ shape product
    ▪ colour
    ▪ slogan
  o Trade mark indicates consistency of source rather than identity of source i.e. that the person who made the product the first time is the one making it this time

• Why protect trade marks?
  o Trade mark law allows traders to register the signs and prevent other people from using them in relation to their goods
  o Trademarks are very valuable, in part because they can act as a focal point for persuasive advertising that seeks to attach emotions, images and status to a brand, and hence make products so marked more attractive.
  o Prevention of consumer confusion – this is the main justification. Trade marks prevent people buying things they did not intend to buy
The key goal of trade mark law is to protect the ability of trade marks to act as a badge of origin enabling consumers to identify the source of goods or services, or rather that goods marked in the same way come from the same source.

- Reduction of consumer search costs – takes less time (and time is money) to work out what to buy. Consumers use trade marks as mental shortcuts for what they want.
- Quality function – if you protect a trade mark you enable the trader to take advantage of the goodwill generated by the quality of their product to promote future sales. If someone can’t reliably identify goods then traders have less incentives to make quality goods symbolising the qualities associated by consumers with certain goods or services, and guaranteeing that the goods or services measure up to expectations.
- Accountability – can trace product back to the company that produces that particular good
- Protect investment traders make in their product and their brand –
  - Frank Schechter, ‘The Rational Basis of Trademark Protection’: “there is harm to the trade mark owner when there is a ‘gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competing goods. The more distinctive or unique the mark, the deeper is its impress upon the public consciousness, and the greater its need for protection against vitiation or dissociation from the particular product in connection with which it has been used”.
- It is important not to conflate the general justifications for providing legal protection for trade signs, with the justifications for having a registered trademark system. The principal justification for having a registered trade mark system is normally said to be that trade mark registers act as an important source of public information. More specifically, trademark registers are said to provide information as to the signs that are protected in a given commercial sphere thus saving other traders significant search costs when seeking to come up with new marks they can use.

**WAGAMAMA V CITY CENTRE RESTAURANTS** [1995] FSR 713

- Someone opened a restaurant called Rajamama (without any connection to Wagamama). Wagamama sued for infringement of trademarks
- The important factor to bear in mind is that what justifies the monopoly is not the monopoly itself but the extent to which it gives, or is hoped to give, a benefit to commerce which compensates for the temporary restraint on competition. The monopoly is an adjunct to, and is designed to promote, commerce.
- Protect traders:
  - Trade marks reward the manufacturer who consistently produces high-quality goods and they thus stimulate economic progress. Without trade mark protection there would be little incentive for manufacturers to develop new products or to maintain the quality of existing ones. Trade marks are able to achieve that effect because they act as a guarantee, to the consumer, that all goods bearing a particular mark have been produced by, or under the control of, the same manufacturer and are therefore likely to be of similar quality.
  - A trade mark can only fulfil that role if it is exclusive. Once the proprietor is forced to share the mark with a competitor, he loses control over the goodwill associated with the mark. The reputation of his own goods will be harmed if the competitor sells inferior goods.
  - The primary function of a trade mark, traditionally, has been to identify the commercial or trade origin of the goods (or services) to which it is applied. This, of course, is of central importance to a trader as the mark then indicates to the market...
that these goods are his, even if he is not personally identified, and it becomes the focus for his **growing goodwill or reputation in that market**.

- **Protect consumers:**
  - From the consumer's point of view, equally undesirable consequences will ensue, because the clarity of the signal transmitted by the trade mark will be impaired. The consumer will be **confused and misled**.
  - The essential function of a trade mark extends to **protection from association as to origin**.


- Constitutional case decided by HC on plain packaging legislation.
- Cigarette packaging can no longer distinguish brands from one another other than by just saying the name on it. This means trade mark owners in tobacco industry can use their names, but there are now lots of trade marks they can’t use anymore e.g. colours, pictures, packaging shape, etc.
- The law says the tobacco companies can keep their registered trademarks, they stay on the register. They can’t use them, but can still prevent other people using that trademark. BUT Tobacco companies tried to argue that they were **deprived of the substance of their rights**.
- Have to think about it in terms of what the trademarks are designed to prevent i.e. consumer confusion or encourage quality.
- While the prime concern of the TMA is with the capacity of a trade mark to distinguish the goods of the registered owner from those of another trader, trade marks undoubtedly perform other functions. For example, a trade mark can be an indicium of the quality of goods sold under or by reference to it and it may be accepted that distinctive marks can have a capacity to advertise, and therefore to promote, sales of products sold under or by reference to them. The advertising function of a trade mark is much more readily appreciated than it once was, and that function may be of great commercial value.
- Gummow J: trade mark legislation… represents an accommodation between the interests of traders, in the use of trade marks in developing the goodwill of their businesses and turning this to account by licensing arrangements, and the interests of consumers, in recognising trade marks as a badge of origin of goods or services and avoiding deception or confusion as to that origin.
- In **Mattel** Binnie J said that registered trade marks operated “as a kind of **shortcut** to get consumers to where they want to go, and in that way perform a key function in a market economy”.
- Certain valuable rights and interests of registered owners, authorised users and applicants for registration under the Trade Marks Act are not affected by the operation of the Packaging Act. For example, the right of a registered owner (or an authorised user) to seek relief for infringement of a registered trade mark pursuant to Pt 12 of the Trade Marks Act is not disturbed.
- Gummow J: the TMA, like other trade mark legislation, does not confer on registered owners or authorised users a liberty to use registered trade marks free from restraints found in other statutes.
- Gummow J: while the trade marks remain on the face of the register, their value and utility for assignment and licensing is very substantially impaired.
- Crennan J: used alone, albeit in the manner restricted by the Packaging Act, the brand names “Winfield”, “Dunhill”, “Camel” and “Old Holborn” are **capable of discharging the core**
function of a trade mark — distinguishing the registered owner’s goods from those of another, thereby attracting and maintaining goodwill.

- Costs of having a trademark system
  - Makes it harder for other companies to market their products and compete.
  - Could prevent people making a functional product because there is a trademark on the only practical way of making the product
  - The bureaucracy is costly e.g. having trademark reviewers and judges and cases etc.
  - Could have potential implications for free speech e.g. if you want to protest against Nike and you put their logo on a poster protesting it you may be infringing their trade mark rights

- Registered and unregistered trade marks
  - Not all trade marks are registered
  - Only registered marks get the protection afforded by the TMA
  - Unregistered marks can be protected through passing off or misleading and deceptive conduct (cl 18 Australian Consumer Law)

- Advantages of registration
  - Instant national exclusivity with registration – don’t have to build up a reputation before you can say people are being misled.
  - Recognition is national, so it doesn’t matter if your market is small.
  - Exclusivity can exist before you even enter the market – can register mark before trading.
  - Advantages in litigation – because you don’t have to show that people are going to be misled or confused it is easier to sue, don’t have to prove reputation, reduced costs of litigation and stronger position to force a settlement.
  - Registration performs an information function (for new traders) – the register provides information on whether someone else is using a name or sign.
    - Problem is that a search of the register can only be a starting point, register is not conclusive because some marks are not registered

- Registration options
  - Domestic - Apply through IP Australia in Aus
  - International - Apply through WIPO and nominate Aus as a place you want protection
  - Just have to download an application form and send it in with a fee.
  - First have to search if anyone else is using the mark you’ve come up with – search the register, search the internet, speak to someone in the industry association, hire a marketing firm or someone to conduct the search, search business name register or domain name register

- Collective trade marks, certification marks and defensive trade marks
  - Collective marks – owned by an organisation and used to identify members of an organisation
  - Certification marks – do not indicate trade source by indicate a quality of the goods e.g. heart foundation tick of approval
    - Owner often will not use the mark
    - Mark will be used by many different firms and even competing goods/services will use the same mark
  - Defensive trade marks – can register a mark for goods that you are not intending to use it on (but have to have an ordinary mark first).
    - 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.

1.3 APPLICATION PROCESS FOR REGISTRATION OF A TRADE MARK

1.3.1 APPLICATION (SS27-28)

- WHO MAY APPLY?
  - TMA s27(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.
  - TMA s28 - If the relations between 2 or more persons interested in a trade mark are such that none of them is entitled to use the trade mark except:
    - (a) on behalf of all of them; or
    - (b) in relation to goods and/or services with which all of them are connected in the course of trade;
    the persons may together apply for its registration under subsection 27(1).
  - TMA s7 Use of trade mark
    - (1) …the Registrar or the court may decide that a person has used a trade mark if it is established that the person has used the trade mark with additions or alterations that do not substantially affect the identity of the trade mark.
    - (2) To avoid any doubt, it is stated that, if a trade mark consists of the following, or any combination of the following, namely, any letter, word, name or numeral, any aural representation of the trade mark is, for the purposes of this Act, a use of the trade mark.
    - (3) An authorised use of a trade mark by a person (see section 8) is taken, for the purposes of this Act, to be a use of the trade mark by the owner of the trade mark.
    - (4) In this Act:
      - "use of a trade mark in relation to goods " means use of the trade mark upon, or in physical or other relation to, the goods (including second-hand goods).
    - (5) In this Act:
      - "use of a trade mark in relation to services " means use of the trade mark in physical or other relation to the services.

- FORM OF THE APPLICATION
  - TMA s27 (2) The application must:
    - (a) be in accordance with the regulations; and
    - (b) be filed, together with any prescribed document, in accordance with the regulations;
- (c) be made by a person or persons having legal personality.

- TMA s27 (2A) Despite paragraph (2)(c), an application for registration of a collective trade mark need not be made by a person or persons having legal personality.

- TMA s27 (3) …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.

- Can only register for goods/services on which you will actually be using the mark, if the specification is too broad it threatens the validity of the mark.

**What goods/services you specify is important because of the way we analyse infringement:**

1. if someone uses your mark on **goods your mark is registered** for that will be **infringement**,  
2. if someone uses you mark on **similar goods** it can be an infringement unless the defendant can show the **consumers aren’t confused**,  
3. if someone uses your mark on totally **different goods** that can be infringement only if you are **well known** and have a huge market.

- TMA s27 (4) Regulations made for the purposes of paragraph (3)(b) may apply, adopt or incorporate any matter contained in any listing of goods and/or services published by the Registrar from time to time and made available for inspection by the public at the Trade Marks Office and its sub-offices.

- TM Regs 4.1 (1) For subsection 27 (2) of the Act (which deals with applications for registration), an application for the registration of a trade mark must be:
  - (a) in an approved form; or
  - (b) an AFS request mentioned in Part 3A, in respect of which all fees were paid within the prescribed time limits.

- TM Regs 4.1 (2) Any material that is intended by the applicant to form part of the application for registration of a trade mark:
  - (a) must be attached to the application; and
  - (b) is taken to be part of the application.

- TM Regs 4.2: Application in approved form -- requirements for filing
  - (1) To be taken to be filed, an application for registration of a trade mark that is in an approved form must:
    - (a) state that the application is for registration of the trade mark, or contain a clear indication to that effect; and
    - (b) include a representation of the trade mark that is sufficient to identify the trade mark; and
    - (c) specify the goods and/or services in relation to which the application is made; and
    - (d) include sufficient information to enable the Registrar to establish the identity of the applicant; and
    - (e) contain sufficient information to enable the Registrar to contact the applicant.
  - (2) If an application does not meet a requirement set out in paragraph (1) (a), (b), (c) or (d), the Registrar must give to the applicant written notice of the requirement.
(3) If the applicant meets the requirement within a period of 2 months from the date of the notice, the application is taken to be filed on the day on which the requirement is met.

(4) If the applicant does not meet the requirement within that period, the application is taken not to have been filed.

TM Regs 4.2AA: A divisional application must contain the following information:

(a) a statement that the application is a divisional application;

(b) a statement identifying the parent application.

TM Regs 4.2A: An AFS request that is submitted as an application for registration of a trade mark under this Part may be taken as having been filed only if the Registrar is satisfied that all fees have been paid in respect of the application within the period of 5 working days mentioned in subregulation 3A.5 (1).

TM Regs 4.3 – Representation of Trademarks

(1) If practicable, the representation of a trade mark included in an application for registration of the trade mark must not exceed 8 centimetres by 8 centimetres.

(2) In an application for the registration of 2 or more trade marks as a series, the representation of each trade mark in the series must, if practicable, not exceed 8 centimetres by 8 centimetres.

(3) In an application for the registration of a trade mark that contains, or consists of, a 3 dimensional shape:

(a) if practicable, the representation of the trade mark in the application must be illustrated in a perspective that shows each feature of the trade mark; and

(b) otherwise, the representation of the trade mark in the application must include views of the trade mark that are necessary to show each feature of the trade mark.

(4) If the Registrar reasonably believes that the views of a trade mark to which paragraph (3)(a) or (b) applies are not sufficient to allow all features of the trade mark to be properly examined, the Registrar may, by notice in writing, require the applicant to give to the Registrar up to 6 additional views of the trade mark that show the features sufficiently to permit proper examination of the trade mark.

(5) If the representation of a trade mark in an application for registration of the trade mark includes words of a language other than English, the applicant must file in support of the application a translation of the words into English, if required to do so by the Registrar at the time of application or later.

(6) If the representation of a trade mark in an application for registration of the trade mark includes characters constituting words, being characters that are not roman letters, the applicant must file in support of the application:

(a) a transliteration of the characters into roman letters, using the recognised system of romanisation of the characters (if any); and

(b) a translation of the words into English.

(7) If a trade mark for which registration is sought contains or consists of a sign that is a colour, scent, shape, sound or an aspect of packaging, or any combination of those features, the application for registration of the trade mark must include a concise and accurate description of the trade mark.

(8) If the Registrar reasonably believes that the description or representation of a trade mark in an application for registration of the trade mark does not:

(a) demonstrate the nature of the trade mark sufficiently; or
• (b) show each feature of the trade mark sufficiently;
    to permit proper examination of the trade mark, the Registrar may require the
    applicant to give to the Registrar:
    • (c) a description, or further description, of the trade mark; and
    • (d) a specimen of the trade mark.

(9) If a representation of a single trade mark exceeds, or the representations of the
trade marks in a series of trade marks together exceed, 8 centimetres by 8
centimetres, the representation or representations:
• (a) must be attached to the application for registration of the trade mark or
    trade marks; and
• (b) must be taken to be part of the application.

(10) The representation of a trade mark in an application for registration of the
trade mark must be of a kind and quality that:
• (a) ensures that the features of the trade mark will be preserved in the
    course of time; and
• (b) is suitable for reproduction.

o TM Regs 4.4 – Specification of goods or services

• (1) For the purposes of paragraph 27 (3) (b) of the Act, the following
    subregulations set out the manner of specifying, in an application for the registration
    of a trade mark, the goods and/or services in respect of which registration is sought.
• (2) The expression 'all goods', 'all services', 'all other goods', or 'all other services'
    must not be used in an application for registration of a trade mark to specify the
    goods and/or services in respect of which registration is sought.
• (3) The goods and/or services must be grouped according to the appropriate
    classes described in Schedule 1.
• (4) The applicant must nominate the class number that is appropriate to the goods
    or services in each group.
• (5) The groups must be listed in the order of their class numbers.
• (6) The goods and/or services must, as far as practicable, be specified in terms
    appearing in any listing of goods and services that is:
    • (a) published by the Registrar; and
    • (b) made available for inspection by the public at the Trade Marks Office
        and its sub-offices.
• (7) If any of the goods and/or services cannot be specified using terms referred to
    in subregulation (6), the applicant must provide sufficient information to enable the
    Registrar to decide the classification of the goods and/or services.

o TM Regs 21.1 Compliance with instructions on approved forms - If:

• (a) an application, notice, request or declaration under the Act or these regulations
    is required to be in an approved form; and
• (b) a blank form that may be used in making an application, request or declaration
    or giving notice:
    • (i) is supplied by the Registrar; and
    • (ii) contains directions about completing that form;
        the person who completes the form must comply with those directions.

• Claim for priority

o Filing date – date application is filed and is received by the office
Registration date – date your trade mark registration takes effect. Your rights date from then

- NB. Once registered the registration date gets backdated to the filing date

Priority date – concept used in assessing potential conflicts in marks. Person with earlier priority date tends to win the contest. Usually filing date is the priority date, except with divisional applications or where you have an earlier application made in a Convention country (under Paris Convention and TRIPS if you apply in a Convention country and apply in Aus within 6 months your priority date is the earlier date)

TMA s29 Application for registration of trade mark whose registration has been sought in a Convention country--claim for priority

1. If:
   - (a) a person has made an application for the registration of a trade mark in one or more than one Convention country; and
   - (b) within 6 months after the day on which that application, or the first of those applications, was made, that person or another person (successor in title) of whom that person is a predecessor in title applies to the Registrar for the registration of the trade mark in respect of some or all of the goods and/or services in respect of which registration was sought in that country or those countries;
   - that person or that person’s successor in title may, when filing the application, or within the prescribed period after filing the application but before the application is accepted, claim a right of priority for the registration of the trade mark in respect of any or all of those goods and/or services in accordance with the regulations.

2. The priority claimed is for the registration of the trade mark in respect of the goods or services:
   - (a) if an application to register the trade mark was made in only one Convention country--from (and including) the day on which the application was made in that country; or
   - (b) if applications to register the trade mark were made in more than one Convention country--from (and including) the day on which the earliest of those applications was made.

3. The regulations may provide for the filing of documents in support of a notice claiming priority and, in particular, for the filing of certified copies of any application for the registration of the trade mark made in a Convention country.

TM Regs 4.5 - For the purposes of subsection 29 (1) of the Act (which deals with claims for priority), the prescribed period in relation to a claim for a right of priority for an application is 2 working days after filing the application.

TM Regs 4.6 – How to claim priority

1. For the purposes of subsection 29 (1) of the Act (which deals with claims for priority), an applicant must claim a right of priority for an application by filing notice of the claim.

2. Any notice under subregulation (1) must specify, in respect of the earlier application or, if there is more than 1 earlier application, in respect of each earlier application:
   - (a) the Convention country in which the earlier application was filed at the trade marks office (or its equivalent) of that Convention country; and
   - (b) the date on which the earlier application was filed.