

**TRADE MARK** [Trade Mark Act]

Sign or symbol that is used to distinguish the goods or service of one trader from those of the another → tangible form that can be transferred, licensed and assigned.

**STEPS:**

1. Should get TM?
2. TM reg?
  - a. Yes: What type?
  - b. No: carry on
3. Requirement for registration
  - a. Application to IP Aus
  - b. Specify:
    - i. Mark Applied for
    - ii. Application details
    - iii. G/S marks will be used on or in connection to.
  - c. Renewal required every 10 years
  - d. Does C want TM to be in other countries?
    - Single application through Madrid Protocol
4. Does it satisfy TM elements?
  - a. Sign
  - b. Used/intended to be used
  - c. Distinguish G&S in commercial activity from goods and service of another trade.
5. Are there other grounds for rejection?

**SHOULD GET TM?**

Does what the client purports/what follows has TM

***characteristics:***

- Forms of property
- Owned by natural/artificial person engage in trade
- Appurtenant/incident to deal with good in course of that ppl's trade
- Distinguishing goods on connection with trader.

**TYPES OF TM**

**STANDARDS:** use to distinguish G&S of one trader from those of other [s 17]

**COLLECTIVE:** Distinguish G/S of member of an association from those of another [s 162]

**CERTIFICATION:** induce goods bearing particular characteristic as adjudged/certified by competent body [s 169]

**DEFENSIVE:** it is likely that its use in relation to other G/S will be taken to indicate that there is connection b/w those other G/S + regi owner of TM [s 185(1)]

**REGISTRATION**

**CL:** Proof of reputation → no need for application.

- TM **infringed** → COA: Passing off
  - Has there been a misrepresentation by D to the public?
  - Has that misrep lead the public to believe the g or s are the g or s of the P?
  - Has that then threatened D's business

**Who apply:** A person may apply for the registration of a TM in response to G&S if the person claims to be the owner of TM [s 27(1)(a)]

**SERIES MARKS:** one application cover # M closely resembling each o other. Such TM can only differ in [s 51]:

- Statements/representation as to claimed G/S
- Statements/representation as to #, price, quality/name of place; and/or
- Colour of any part of TM

**ELEMENTS** [s 17]

**1. TM is sign**

• Letter	• Label
• Word	• Ticket
• Name	• Aspect of packaging
• Signature	• Shape
• Numeral	• Colour
• Device	• Sound
• Brand	• Scent
• Heading	• Combinations of these

- **Shape:**
  - Three types:
    - Shapes of goods
    - Shape of container; or packaging holding good; and
    - 3D shape used in connection with goods.
  - It should be diff from the function of the product [Phillips]
  - The function of product should not determine the shape.
- **Sound:** must be able to be described in graphical form [s 40]
- **Scents:** it should be distinguishable from the product, unless product is perfume.
- 2. **TM intended to be used;** and
  - Must be actual use or actual intention to use the sign as a trademark – use the sign to distinguish the produce from other product to show the product's original [Johnson and Johnson]
  - TM can be challenged for removal from register for non-use T.
- 3. **TM must be distinguished good or service in commercial activity.**
  - **Categories**
    - a. Is the mark inherently adapted to distinguish:
      - TM Capable of distinguishing G&S if TM is to any extent inherently adapted to distinguish G&S.
      - ✓ **Tests** [Kandy]
        - **+ve test:** association with and suggestion of something in common use or existence = lack of inherent adaptations.
        - **-ve test:** Absence of association with and suggestion of thing, shape, and place = inherent distinguish.
      - M that are inherently distinctive = capable of distinguishing the applicants of G&S.
    - b. Is the mark somewhat inherently adapted, and can or will distinguish: s 41(4)
      - Whether TM with inherent distinctiveness have acquire distinctiveness through use?

- s 41(4)(a) TM is NOT capable of distinguishing G&S if it is, to some extent, but NOT sufficiently, inherently adapted to distinguish the designated G&S.
- s 41(4)(b) the applicant has not and will not distinguish the designated G&S as having regard to the combined effect of
  - (i) extent to which TM is inherently adapted to distinguish;
  - (ii) the use or intended use; and
  - (iii) any other circumstances.
- c. Is the mark not inherently adapted, but distinguished because of extensive prior use: s 41(3)
  - M may have been used but the use is not sufficient to generate that r'ship in consumers' mind b/w the mark, trade, and the trade's goods or service [s 41(3)(b)]
  - Became Generic: M doesn't represent the G&S rather comes to represent that type of G&S.
  - Presumption of restorability: unless registrar is satisfied on BOP that M doesn't possess inherent/acquire distinctiveness, it should be registered.

#### **OTHER GROUND OF REJECTING APPLICATION**

- M is **scandalous** or whose use would be contrary to law [s 42]
- Use of M would likely to **deceive or cause confusion** [s 43]
- M are substantially **identical with or deceptively like existing registration** in respect of similar goods/closely related service [s 44]