

# REGISTRABILITY

A trade mark is a 'badge of origin' / 'an indicator of source' — 'distinguishes the goods from those of other traders'

- Gummow J, *Johnson and Johnson Australia Pty Ltd v Sterling Pharmaceuticals Pty Ltd*

- Trade marks are concerned with the marketing of goods and services
- Trade marks are signs or combinations of signs that indicate the origin of goods or services and thus promote the business of the the manufacturer/ provider and give information to the customer
- Considered as part of the goodwill of a company and may therefore be of very considerable value
- Registration provides statutory protection for the owner of the mark

## Registered and Unregistered Trade Marks

- Trade marks law concerns the relationship between marks that are protected and marks that are unprotected
- Unregistered marks are perfectly legitimate
- If person or company wants to continue using a mark that someone else is already using, they will have to use it as an unregistered mark

## The Trade Mark System

### APPLICATION

- Application may be made by a person who claims to be the owner of the mark and is using or intends to use the mark: [s 27](#)
- 'Person' includes both natural and legal persons, and even a body of persons, whether incorporated or not: [s 6](#)
- Joint ownership is also possible: [s 28](#)
- Upon application, must choose which class of goods you want the mark to be registered for— don't have to limit yourself to one class, but you can't apply for them all

### PUBLICATION

- The Registrar has to publish its particulars: [s 30](#)
- Mark cannot be rejected unless the applicant has been given an opportunity of being heard: [s 33\(4\)](#)
- Decision must be advertised in the Official Journal: [s 34](#)

### OPPOSITION

- A person may oppose the registration by filing a notice of opposition within 3 months of the notice of Acceptance being published : [s 52](#)
- The opponent and the applicant are then given the opportunity of having their cases for or against registration heard: [s 54\(1\)](#)
- Registrar must decide whether to refuse the mark or whether to go ahead and register it, with or without conditions and limitations: [s 55](#)

### AMENDMENT OF APPLICATION

- After the filing of the application, the goods or services cannot be extended
- Only very minor amendments are allowed to the trade mark

### REGISTRATION

- Registrar may register a trade mark subject to conditions or limitations, such as limitations to colour: [s 70](#)
- Will give the owner a certificate of registration: [s 71](#)
- Applicant can limit his or her own monopoly by expressly disclaiming some aspect of the mark: [s 74](#)
- Initial period of registration is 10 years: [s 72](#)

## RENEWAL

- Can apply to renew the mark so that you keep your registration indefinitely: [s 75](#)
- Registration is taken to have had effect from the filing date of the application, known as the **'PRIORITY DATE'**
- If no renewal occurs, the mark will be removed from the register 6 months after expiry: [s 78](#)

## AMENDMENT AND CANCELLATION OF REGISTRATION

- It is possible for the Registrar to correct the register either by amending or cancelling the registration by written request of the owner [[s 81](#)] or following a court order [[s 85](#)]

## ASSIGNMENT AND TRANSMISSION

- A registered trade mark is personal property: [s 21](#)
- The registered owner can deal with the mark as its absolute owner: [s 22](#)
- Trade marks can be assigned or transmitted either totally or partially
- Must be recorded by the Registry: [Pt 10](#)

## GROUNDLESS THREATS

- A person may not make groundless threats of legal proceedings for infringement of a trade mark: [s 129](#)

## Special Types of Marks

### COLLECTIVE TRADE MARK

- A sign used by members of an association to distinguish their goods and services from those of non-members: [s 162](#)
- Cannot be assigned and transmitted

### CERTIFICATION TRADE MARKS

- A sign which indicates that a person certifies the goods as being of a particular quality, accuracy, origin, material, mode of manufacture and so on and this distinguishable from other goods of the same type
- Registered owner of the mark has the exclusive right to use it but only in accordance with the rules governing its use: [Pt 16](#)

### DEFENSIVE TRADE MARK

- Covered by [Pt 17](#)
- Intended to provide partial protection for famous marks, allowing them to be registered for goods or services in respect of which they are not actually used, without becoming vulnerable to removal on the ground of non-use

## Concept of a Trade Mark

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 [[s 17 TMA](#)]

## 1. WHAT IS A 'SIGN'?

### SECTION 17 TRADE MARKS ACT 1995 (CTH)

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.

### SECTION 6 TRADE MARKS ACT 1995 (CTH)

**"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.

- An application for registration will be rejected if the trade mark cannot be represented graphically: [s 40](#)

- A 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, sounds or scent.

- Try to register an image or logo in black and white because it will cover any colour.
- Try to register a name in plain font, because it will cover everything. People register in 'fancy font' if they can't register it across all fonts.

#### COLOUR MARKS

- Can register a colour alone, or in combination, or as part of the packaging
- Clear and concise description, pictorial representation, can use Pantone
- Very difficult to get

#### SOUND MARKS

- A sound mark can be anything auditory
- Verbal description (e.g., 'CLIP CLOP MOO')
- Graphical representation (e.g., musical notation)

#### SCENT MARKS

- Only one has been submitted
- Class: 28 Golf tees (eucalyptus scent)

#### SHAPE MARKS

- The shape must be original
- The shape is striking to the eye
- The unusual aspects of the shape are not dictated by any functional requirements but are rather purely ornamental

- **IMPORTANT** to distinguish between the trade mark and the goods themselves

### COCA-COLA COMPANY V ALL-FECT DISTRIBUTORS LTD (1999) 47 IPR 481

#### REGISTERING A SHAPE MARK

**Facts:** Coca Cola has various trade marks, including for the shape of the bottles they use. All Fect manufactured cola-flavoured candies in the shape of bottles. Coca-Cola said in its statement of claim that it had been using the contour bottle's 'distinctive shape and silhouette' since 1938 in Australia.

**Held:** Court asked are they even using this bottle shape as a trade mark, as a 'badge of origin'? Will consumers see this and think of a particular trader.

At first instance, it was found that the confectioner's use of the contour shape of the confectionary, was a use of the mark as a trade mark: '*...if the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered.*' Therefore, the court held decorative use, not trade mark use.

The primary judge's decision was overturned on appeal and Coca Cola was successful. The court held that the striking shape of the respondent's confectionary was apt to distinguish it from the goods of other traders and thus was used as a trade mark. Their Honours concluded '*The primary function performed by these features is to distinguish the goods from others. That is to use those features as a mark... But in the present case we are compelled to the conclusion that the non-descriptive features have been put there to make the goods more arresting of appearance and more attractive, and thus to distinguish them from the goods of other traders.*'

- A trade mark registered as a shape mark, would give a perpetual right of ownership in a shape (cf copyright).
- The release valve' however with trade marks is the consideration that if other traders acting reasonably and with proper motives, would be entitled to use the mark, it will lack distinctiveness under **s 41**
- This however, may be overridden by satisfactory evidence of use leading to the applicant's goods or services acquiring distinctiveness: **ss 41(5) and (6)**

**REGISTERING A SHAPE MARK**

**Facts:** The mark sought to be registered was a pharmaceutical capsule one half of which was coloured and the other half of which was colourless, containing pellets of two or more colours.

**Held:** The Registrar's refusal to register the mark was upheld by Windeyer J on the ground that a trade mark must be capable of being described and depicted as something apart from the goods to which it is to be applied or in relation to which it is to be used. A mere description of goods by shape, size or colour cannot be a trade mark in respect of those goods.

Windeyer J relied upon the observation of Lindley LJ *In re James's Trade Mark* (1886) that 'a mark must be something distinct from the thing marked. A thing cannot be a mark of itself.'

**KONINKLIJKE PHILIPS ELECTRONICS NV V REMINGTON PRODUCTS AUSTRALIA PTY LTD (2000) 48 IPR 257****REGISTERING A SHAPE MARK**

**Facts:** Philips had obtained trade mark registration under the 1955 Act for a drawing of its three headed shaver with the heads arranged in an equilateral triangle arrangement. After the 1995 Act came into force Philips also applied for registration of the shape itself.

**Held:** It was decided that Remington, by producing producing an electric shaver with a triple head configuration, had not infringed Philips' registered trade marks for the two-dimensional representation of its shaver. The court said that Remington's emphasis of the head of its shaver in its advertising and packaging sent a message as to the product's quality, rather than its trade origin.

Burchett J commented, '*it is to be assumed that goods in the market are useful, and if they are useful, other traders may legitimately wish to produce similar goods (unless, of course, there are, for the time being subsisting patent, design or other rights to prevent them from doing so), and it follows that a mark consisting of nothing more than the goods themselves could not distinguish their commercial origin, which is the function of a mark:*' *Johnson & Johnson* (1991) 30 FCR 326) Burchett J concluded that merely to produce and deal in goods having the shape, being a functional shape, of something depicted by a trade mark is not to engage in a 'use' of the mark 'upon, or in physical or other relation tom the goods' within s 7(4), or to 'use' it 'in relation to the goods' within s 20(1).

This decision indicates that to produce or deal in goods having a configuration closely similar to a registered shape trade mark will not always amount to trade mark infringement.

**2. USED OR INTENDED TO BE USED**

**TEST:** whether a mark is used as a trade mark is an **objective** one, and requires asking whether, **in the context in which the trade mark appears**, it would have been understood by consumers as being used so as to indicate a connection in the course of trade between the goods or services and the person using it: *Shell Co (Aust) Ltd v Esso Standard Oil* (1963) 109 CLR 407

- Registration can be obtained before the mark has actually come into use as long as there is a real intention to use it: *Re Batt's Trade Mark* (1898) 15 RPC 534
- A court may decide that a trade mark has been used if it has been used with additions or alterations that do not substantially affect the identity of the trade mark: s 7(1)
- Use of a latter, word, name or numerical mark may consist of an aural representation of the mark: s 7(2)
- Use of the trade mark in relation to goods means use of the mark upon or in physical or other relation to the goods, and in relation to services it means in physical or other relation to them: ss 7(4) & (5)
- An authorised use a trade mark is taken to be use by the owner of the mark: ss 7(3) & 8

**LACK OF INTENTION TO USE**

- Lack of intention to use a mark is a ground on which the application for registration may be opposed: s 59
- Aggrieved person may apply to the Registrar for removal of a trade mark on the ground that '*on the day on which the application for the registration of the trade mark was filed, the applicant for registration had no intention in good faith*' to use the trade mark in Australia: s 92

**REGISTERING A GHOST MARK**

**Facts:** The plaintiffs tried to register a mark that was a ghost mark, that is, one that was never intended to be used in the course of trade. Such a mark is used to prevent the registration or use of another similar mark. Imperial Group tried to register NERIT in respect of their MERIT brand of cigarettes. They could not register MERIT as it was too descriptive so they wanted to prevent any use of the MERIT mark by competitors by registering NERIT.

**Held:** The court held that NERIT was not a trade mark and should not have been registered as at the date of registration, Imperial was not using the mark NERIT, nor did they intend to use it in the course of trading their cigarettes.

**WHERE TRADE MARK USE IS NOT 'USE AS A TRADE MARK'**

1. Artistic/ Expressive/ Decorative use (i.e., Andy Warhol, Campbell Soup Cans)
2. Use in comparative advertising
3. Ghost Marketing (MERIT for cigarettes not registered; tried to register NERIT for cigarettes to block other traders from registering MERIT': *Imperial v Philip Morris [1982]*)

**3. GOODS OR SERVICES**

- A trade mark can be registered in respect of goods, or services, or both goods and services: **s 19(1)**
- Registration may be in respect of goods or services of more than one class

- Must be used 'to distinguish goods or services dealt with or provided **IN THE COURSE OF TRADE**'
- The use of a mark in an advertisement of goods is a use in the course of trade: *The Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd (1963) 109 CLR 407*
- The use of a mark on goods in activities preparatory to the commencement of a course of trade is not considered to be in the course of trade: *Settef SpA v Riv-Oland Marble Co (Vic) Pty Ltd (1987) 10 IPR 402*
- Marked goods that are supplied free of charge can be considered to be in the course of trade: *Settef SpA v Riv-Oland Marble Co (Vic) Pty Ltd (1987) 10 IPR 402*

**4. DISTINCTIVENESS****TWO STEP PROCESS:**

1. Is the mark inherently adapted to distinguish — thus prima facie distinctive (i.e., Apple for computers)
2. If not, is there evidence of factual distinctiveness due to the way the mark has been used such that it operates as a 'badge of origin' / has secondary meaning

- A trade mark must be a sign that **DISTINGUISHES** goods and services from those of other traders.
- The Registrar must accept the application for a trade mark unless there are grounds for rejecting it: **s 33**
  - One of these grounds for rejecting is **s 41**

**SECTION 41 TRADE MARKS ACT 1995 (CTH)**

- (1) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered (the **designated goods or services**) from the goods or services of other persons.
- (2) A trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons only if either subsection (3) or (4) applies to the trade mark.
- (3) This subsection applies to a trade mark if:
  - (a) the trade mark is not to any extent **inherently adapted to distinguish** the designated goods or services from the goods or services of other persons; and
  - (b) the applicant has not used the trade mark before the filing date in respect of the application to such an extent that the trade mark **does in fact distinguish** the designated goods or services as being those of the applicant.

There are **TWO** types of distinctiveness: [s 41 (3)]

1. Inherent adaptability to distinguish; and
2. Factual distinctiveness

**\*\*If a mark does not have either of these types of distinctiveness, it will probably not be capable of distinguishing\*\***

#### EXAMPLES OF DISTINCTIVE MARKS:

1. Uncommon names (e.g., ADIDAS)
2. Meaningless words (e.g., EXXON, KODAK)
3. Most coined words (e.g., SURELOCK, CLICKFAST)
4. Expressions not commonly used locally in the industry (e.g., OFF THE WALL)
5. Unlikely grammatical construction, especially misspellings (e.g., SHOPRITE)
6. Slogans — with only indirect references (e.g., COLOUR ME SOFTLY)
7. Combined World or City Marks – SPEED WORLD, COMFORT CITY

#### Partially Distinctive

- If the mark is **TO SOME EXTENT** inherently adapted adapted to distinguish but still not capable of distinguishing the goods or services, then the Registrar must take two more factors into account:
  1. Must look at the use or intended use of the trade mark by the applicant and 'any other circumstances'
  2. Must then decide whether or not the mark is capable of distinguishing the goods or services

#### SECTION 41(4) TRADE MARKS ACT 1995 (CTH)

(4) This subsection applies to a trade mark if:

- (a) the trade mark is, **to some extent, but not sufficiently**, inherently adapted to distinguish the designated goods or services from the goods or services of other persons; and
- (b) the trade mark **does not and will not distinguish** the designated goods or services as being those of the applicant having regard to the combined effect of the following:
  - (i) the **extent** to which the trade mark is inherently adapted to distinguish the goods or services from the goods or services of other persons;
  - (ii) the **use, or intended use**, of the trade mark by the applicant;
  - (iii) any other circumstances.

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

- (a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or
- (b) the time of production of goods or of the rendering of services.

'**OTHER CIRCUMSTANCES**': the extent to which it is inherently adapted to distinguish; the use, on intended use, of the mark; it can be shown that the trade mark does or will distinguish the applicant's goods or services (**AS AT DATE OF APPLICATION**)

#### Inherently Adapted to Distinguish

**QUESTION TO ASK:** Whether the mark is inherently adapted to distinguish the goods? Is the mark unique or unusual for the goods?

#### EXAMPLE:

ROSELLA for tomato sauce is inherently adapted to distinguish the goods because there is no particular reason to connect rosellas with tomato sauce