

INTELLECTUAL PROPERTY

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TRADE MARKS

TM APPLICATION PROCESS

1. Application filed: s 27

- An application for registration of a mark may be made by, inter alia, a person who claims to be the owner of the mark and is using or intends to use the mark: s 27
- The word 'person' includes both natural and legal persons and even a body of persons, whether incorporated or not: s 6. This allows unincorporated associations to be trade mark owners.
- Joint ownership is also possible under s 28

2. TM App examination + Examiner's report issued: s 31, 33

S 31 Registrar to examine, and report on, application

The Registrar must, in accordance with the regulations, examine and report on:

- (a) whether the application has been made in accordance with this Act; and
- (b) whether there are grounds under this Act for rejecting it.

S 33 Application accepted or rejected

- (1) The Registrar must, after the examination, accept the application, unless he or she is satisfied that:
 - the application has not been made in accordance with this Act; or
 - there are grounds under this Act for rejecting it.

3. 15 months to respond to examiner's report / objections (6 month extension available)

4. Acceptance of TM published in Official Journal: s 34. Rejection can be appealed: s 35

5. Opposition Period of 3 months. Anyone can oppose under ss 39-44

- If the Registrar has accepted an application for the registration of a trade mark, a person may oppose the registration by filing a notice of opposition: s 52.
- Both the opponent and the applicant then have to be given the opportunity of having their cases for or against registration heard: s 54(1).
- In the end the Registrar has to decide, in light of the opposition case, whether to refuse the mark or whether to go ahead and register it, with or without conditions and limitations: s 55.

NOTE: Under s 129 a person may not make groundless threats of legal proceedings for infringement of a trade mark.

6. Hearing / Delegate decision

7. If Opposition fails, TM registered

REGISTRATION OF TRADE MARK

STEP 1: Is it a TRADE MARK / Capable of being registered?: s 6, s 17

IF YES – go to STEP 2. If NO – reevaluate the exam question bc it's probably not a TM question

Do this within 1-2 sentences:

As [TM] is a [combination/colour/sound/scent/shape mark], it is a SIGN for the purposes of s 6.

As [SIGN] is being USED by [user] (s 27) as a badge of origin with regards to [user's] [goods/services – explain] (s 19), it is being used to DISTINGUISH those GOODS/SERVICES from other goods/services dealt with/provided in the course of trade: s 17.

Therefore, it is a TRADE MARK capable of being registered: s 17

STEPS – Elaborated

PRELIMINARY: Definition of a trademark: s 17

Section 17 TMA: 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.

STEP 1A: Identify the SIGN: s 6

Section 6 TMA: 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, SOUND or SCENT**

Can include (pp. 17-8 notes):

- Combination mark; Colour marks; Sound marks; Scent marks; Shape marks: [Coca-Cola Company v All-Fect Distributors Ltd \(1999\)](#); [Kenman Kandy Australia Pty Ltd v Register of Trade Marks \(2001\)](#)

STEP 1B: Identify the GOOD/S or SERVICE: s 19

Section 19 – (1) A trade mark may be registered in accordance with this Act in respect of:

- (a) goods; or
- (b) services; or
- (c) both goods and services.

(2) The registration of a trade mark may be in respect of goods or services of more than one class.

Goods and services are classified according to [international Nice classification system](#)

STEP 1C: Identify the “USE”: ss 17, 27

S 27(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;

The Trade Mark must be **used as a “badge of origin” / “an indicator of source”**

The TM must **FUNCTION as a trade mark** – i.e. customers recognise it as a badge of origin and don't look at the mark as being descriptive, functional or decorative.

TEST: Objective qn: “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 \(1963\)](#).

Note: Where TM use is NOT “use of a trade mark”

1. Artistic / Expressive / Decorative use: E.g. Andy Warhol, Campbell Soup Cans 1962
2. Use in comparative advertising
3. Ghost marking: [Imperial v Philip Morris \[1982\] FSR 72](#)

STEP 1D: To DISTINGUISH: s 17

A TM must be a **sign that DISTINGUISHES goods and services** from those of **other traders**.

- **General rule:** Mark needs to be something other traders **DON'T need to use in the normal course of trade**.
 - A **bad mark** = mark that other traders **may legitimately want to use for themselves** (e.g. descriptive word) = **DOES NOT** distinguish one trader's goods from those of another
 - Everyday language and trade expressions need to be available to all **legitimate** traders.

TEST: 'The question whether a trade mark is adapted to distinguish [must] be tested by **reference to the LIKELIHOOD that other persons, TRADING IN GOODS of the RELEVANT KIND and being actuated by only PROPER MOTIVES ... will think of the word and want to use it in CONNEXION WITH SIMILAR GOODS** in any manner which would **infringe** a registered trade mark granted in respect of it.': [Clark Equipment Co v Registrar of Trade Marks \[1964\] HCA 55](#)

NOTE: TM distinctiveness is **ASSESSED AS A WHOLE** i.e. can have non-distinctive words **COMBINED** with distinctive words

Examples of Distinctive marks / marks that ARE inherently adapted to distinguish

- Uncommon names: e.g. ADIDAS; Meaningless words – made up: e.g. EXXON, KODAK
- Most coined words – no meaning in English language: e.g. SURELOCK, CLICKFAST; Expressions not commonly used locally in the industry: e.g. OFF THE WALL
- Unlikely grammatical construction esp. misspellings: e.g. SHOPRITE; Slogans – with only indirect references: e.g. COLOUR ME SOFTLY; Combined World or City Marks: e.g. SPEED WORLD, COMFORT CITY

Example: Bad Marks? - fail to distinguish / NOT distinctive

- Descriptive marks e.g. describes the goods or that indicate the kind, quality, intended purpose or value of the goods or services (**TMA s 41(4)** Note 1)
- Marks that are common surnames or geographical names eg OREGON
- Examples of non distinctive / descriptive marks: THE BEST APPLES for apples; CARS for cars; FISH SHOP; HARDWARE STORE; Functional shapes eg plain bottle

STEP 2: Is the Applicant the OWNER of the trade mark?: s 27

Application may be made by person claiming to be the owner of trade mark **AND** is using / intends to use the trade mark: **s 27**. 'Person' includes natural & legal persons, and/or a body of persons (incl. unincorporated assocs): **s 6**. Joint ownership also possible under **s 28**

STEP 3: Are there any GROUNDS FOR REJECTING the mark (ss 31, 33)?: ss 39-44

IF YES (i.e. 1 or more grounds for rejection) = Registrar CANNOT accept application: s 33

s 31 – The Registrar must, in accordance with the regulations, examine and report on:

- (a) whether the application has been made in accordance with this Act; **AND**
- (b) whether there are grounds under this Act for rejecting it.

s 33 – The Registrar must, after the examination, **accept the application, UNLESS** he or she is satisfied that:

- (a) the application has **NOT** been made in accordance with this Act; **OR**
- (b) there are **GROUND**s under this Act for **REJECTING IT**.

Grounds for Rejection: Part 4 Div 2 TMA. Can have multiple grounds / "citations" –

3A: Trade mark containing CERTAIN SIGNS: s 39

39 Trade mark containing etc. certain signs

- (1) An application for the registration of a trade mark must be rejected if the trade mark contains or consists of a sign that, under regulations made for the purposes of section 18, is not to be used as a trade mark.
- (2) An application for the registration of a trade mark may be rejected if the trade mark contains or consists of:
 - (a) a sign that is prescribed for the purposes of this subsection; or
 - (b) a sign so nearly resembling:
 - (i) a sign referred to in paragraph (a); or
 - (ii) a sign referred to in subsection (1);as to be likely to be taken for it.

3B: Trade mark that cannot be represented GRAPHICALLY: s 40

40 Trade mark that cannot be represented graphically

An application for the registration of a trade mark must be rejected if the trade mark cannot be represented graphically.

3C: Trade mark NOT DISTINGUISHING applicant's goods or services: s 41 – see pp. 25-9 for section + extra notes

A trade mark must be rejected if it is **not distinctive** of the applicant's goods or services: s 41(1)

A trade mark can **ONLY** be rejected on the basis that it **lacks distinctiveness** (s 41(2)) IF:

- it is **NOT INHERENTLY ADAPTED** to distinguish (s 41(3)(a)) AND it has **NOT acquired distinctiveness** through **PAST USE** (s 41(3)(b)); OR
- the trade mark is **PARTIALLY** inherently adapted to distinguish (s 41(4)(a)), AND it **HAS NOT** and **WILL NOT acquire distinctiveness** through **past or future use** (s 41(4)(b)).

STEP 3Ci: Is the mark **INHERENTLY ADAPTED TO DISTINGUISH** – thus prima facie distinctive?: s 41(1), (3), (4)

If NOT –

STEP 3Cii: Is there **evidence of FACTUAL DISTINCTIVENESS** due to the way the mark has been **USED PRIOR TO THE FILING DATE** such that it **operates as a “badge of origin”** / is **adapted to distinguish** one trader's goods from those of another: s 41(3)(b)

- Evidence that shows the mark has a **SECONDARY MEANING** (i.e. not just oven chips – people associate the word with oven chips the specific brand)
- If **YES** – s 41(3) will apply; will **NOT** be rejected
 - [Blount Inc v Registrar of Trade Marks \(1998\)](#)
 - [Ocean Spray Cranberries Inc v Registrar of Trade Marks \(2000\)](#) – where evidence of use fails

3D: Trade mark SCANDELOUS or its use CONTRARY TO LAW: s 42

42 Trade mark scandalous or its use contrary to law

An application for the registration of a trade mark must be rejected if:

- (a) the trade mark contains or consists of **SCANDALOUS** matter; or
- (b) its use would be **CONTRARY TO LAW**.

3E: Trade mark LIKELY TO DECEIVE OR CAUSE CONFUSION: s 43

43 Trade mark likely to deceive or cause confusion

An application for the registration of a trade mark in respect of **PARTICULAR GOODS OR SERVICES** must be **rejected IF, because of some CONNOTATION** that the trade mark or a sign contained in the **TRADE MARK HAS**, the **USE** of the trade mark in **RELATION to those GOODS OR SERVICES** would be **LIKELY to DECEIVE or CAUSE CONFUSION**.

- E.g. **HERBOLIC** for synthetic soap or **VITAMIN** for soap that has not vitamins
- Note: **DO NOT** use s 43 to **compare** trade marks – use s 44; s 43 when analysing **INDIVIDUAL** trade mark

3F: SUBSTANTIALLY IDENTICAL or DECEPTIVELY SIMILAR trademarks or TM applications: s 44 – see pp. 30-1 for section, 31-4 for elements

If **GOODS: s 44(1); If SERVICES: s 44(2)**

Note: S 12 = priority date definition (p. 31 notes), **s 72** re date of registration

STEP 3Fi: Is there **SIMILARITY** between the **MARKS?** i.e. Applicant's mark and earlier registered mark/s or applications?: s 41(1),(2), s 10

Use **SUBSTANTIALLY IDENTICAL + DECEPTIVELY SIMILAR** tests:

- **SI TEST:** In considering whether marks are **substantially identical** they should, I think, be **COMPARED SIDE BY SIDE**, their **similarities and differences noted** and the importance of these assessed having regard to the **ESSENTIAL FEATURES** of the registered mark and the **TOTAL**