

EXAM NOTES TRADEMARK LAW

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TM Application process overview

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

Search

There are two types of searches:

- **identical trade mark search**

to disclose the existence of an identical trade mark in respect of the exact goods/services of interest to a client or a use and registrability search. An identical trade mark search cannot be relied upon alone to advise a client that he/she is free to use the trade mark in Australia.

- **clearance/registrability search**

involves a search of the Trade Marks Register in respect of the exact trade mark and its phonetically equivalent trade marks in an attempt to disclose any trade marks which are considered substantially identical or deceptively similar.

**(more detailed/ comprehensive search than identical TM search)*

The results of such a search will typically inform whether there is likely to be an **objection** under the *Trade Marks Act 1995* (Cth), s 44 or whether there is a **potential infringement by use under s 120**.

Limitations of a search

- Official trade mark records are **computerized**, and search results reflect the accuracy of those records, the computer software, and different people at the ATMO who enter the information.
- Search only covers registrations and applications to approximately **14 days before the date of the search report**. A delay of about 2 weeks between the filing of a trade mark application and its capture on the ATMO database means that a conflicting mark may not show up.
- Under the *TMA*, it may be an **infringement to adopt a well-known trade mark (s 120) of another party or a trade mark similar thereto** in respect of any goods or services, and **we may not be personally aware as to whether a trade mark is well known in Australia**.
- Under the **Paris Convention**, it is possible to file trade mark applications in Australia with a claim for priority from the date of a corresponding overseas application. **A further search later is recommended to ascertain whether a conflicting convention application has been filed within the relevant period.**

Examination

Step 1: s 6 and s 17

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

Step 2: Identify goods/services

S 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.

S 19(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 3: Identify Use

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 Phillip Morris* [1982] FSR 72

Step 4: Applicant must be owner – s 27

Applicant must claim to be the owner of the trade mark – s 27(1)(a) and

Applicant must: (s 27(1)(b))

- Be **using or intend to use the trade mark** in relation to the goods/services covered by the application.
- Have **authorised or intend to authorise another person to use** the trade mark in relation to the goods/services.
- Intend to assign the trade mark to a future corporation with the intent that the corporation uses the trade mark in relation to the goods/services.

Trade Marks Regulations 1995 (Cth), 4.1 - 4.4; Part 3 Trade Marks Manual.

Imperial Group v Phillip Morris

FACTS:

- Plaintiff wanted protection for MERIT, but it was too descriptive.
- Instead, the plaintiff registered NERIT, in an attempt to stop other traders from using MERIT.
- The defendant began using MERIT, and the plaintiff sued for infringement of NERIT.

Held: Registration for NERIT was invalid, as there was no genuine intention to use NERIT as a trade mark (even though the plaintiff had actually sold a small amount of goods under that trade mark).

Presumption of registrability

Under the *TMA*, a presumption of registrability exists that operates in favour of applicants.

Must accept: The Registrar must accept the application after examination unless a **ground of rejection can be made out** (s 33(1)(b)).

Must reject: The Registrar must reject the application if satisfied that there are grounds under TMA for rejecting it – see ss 39 – 44.

Grounds for *Rejection* for Registration (at examination)

1. **S 39:** TM containing certain signs
2. **S 40:** TM cannot be represented graphically
3. **S 41:** TM not inherently adapted to distinguish
4. **S 42(a):** scandalous matter
5. **S 42(b):** contrary to law
6. **S 43:** Likely to deceive or cause confusion
7. **S 44:** Substantially identical or deceptively similar

s 39: Trade mark contains proscribed signs

- **S 39(2)(a)** states that a trade mark **may be rejected** if it **contains or consists of a sign** that is prescribed in the regulations for **s 39(2)**.
- **S 39** further provides that a sign so nearly resembling the prescribed sign as to be likely to be taken for it: **s 39(2)(b)(i) must be rejected**.

There are several types of signs **prescribed** in *Trade Marks Regulations 1995* (Cth), **reg 4.15(a)**:

- Patent
- Patented
- Registered
- Registered design
- Copyright
- Plant Breeder's Rights
- Words or symbols to the same effect, including the symbols © and ®
- A representation of the flag or seal of the Commonwealth or of a state or territory
- A sign notified by the International Union for the Protection of Industrial Property

Ground for rejection – “likely to deceive or confuse”

A ground for rejection exists under **s 39(2)** if a trade mark contains or consists of one or more of the signs prescribed and the presence of that sign **would be likely to deceive or confuse** the **relevant buying public** into a belief that:

- the goods and services bearing the trade mark have a particular status given by legislation, or
- there is a connection between the applicant and the person with whom the sign is associated.

Example:

- Prescribed sign that may suggest a false connection between the user of the trade mark and a particular organisation, person or governing body.
- That connection might include a direct implication of trade origin, sponsorship, patronage, permission or approval of the goods or services in respect of which the trade mark is used.
- An applicant may be able to overcome a ground for rejection under s 39(2) if they can establish they have the permission of the relevant body to use the sign in relation to the goods and/or services of the application, and there is no time limit on that permission.
- Question: Why might the stipulation of “no time limit” be necessary?