

Trade Mark Law Notes – Semester 1 2026

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s41 – Distinctiveness

Trade mark not distinguishing applicant's goods or services

- (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.
- (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.

- Rationale: Ensuring that individual entities do not obtain undue control over particular signs with desirable meanings
- Preliminary consideration: is the mark inherently (prima facie) distinctive? What is the semantic content of the mark as a signifier of the specified goods or services?
 - There will probably not be a strong case for cancellation under s41 if the mark is prima facie distinctive. (Kenman Kandy 2002)
 - The mark must be located at a point on the continuum that it cannot be said that because of their 'inherent' nature alone they will be able to function as a badge of origin (Handler 2014)
- [Opposing party] may seek cancellation on the basis that the mark is **not capable** of distinguishing [goods/services] under s41. The decision maker must be satisfied that, at the filing date, the mark had not acquired distinctiveness, and that it will not become factually distinctive, for the mark to be taken not to be capable of distinguishing for the purposes of s41(2), and thus for the application to be rejected under s41(1).
- **STEP 1:** Identify where along the continuum of distinctive character the mark falls:

What is the extent of the mark's inherent adaptation?		
s41(3): The mark is not to any extent inherently adapted to distinguish	S41(4): it is to some extent but not sufficiently inherently adapted to distinguish	Neither apply: it is sufficiently inherently adapted to distinguish/ prima facie distinctive

- This may be established by applying the *Cantarella/Clark Equipment* test:
 - The mark as a whole must be considered (*Diamond T Motor Co*)
 - (1) What is the 'ordinary signification' of the sign?
 - Descriptive examples: MINT SLICE (*Re Application by Arnott's Biscuits*), EXTRA DRY (*Harvey v Lion-Beer*)
 - (2) What is the likelihood of other traders acting in a particular way in relation to this sign? (Kitto J at [514] in *Clark Equipment*)
 - This test is generally approached negatively: it will be shown to be capable of distinguishing if it is **not descriptive** (Clark).

Other grounds

S42 – Mark would be scandalous or 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.

- Scandalous: generally not useful anymore unless it is very blatant
 - Must be reasonably based on the tenets of the offended group CF ‘merely sentimental’ (Re Ellis & Co’s Trade Mark (1904) 21 RPC 617 (Farwell J at 620))
- Allows for discussion of several different schemes
 - Other legislation: copyright etc.
 - ACL misleading or deceptive conduct
 - Passing off (and ACL equivalent)
- Generally forward-looking: asks whether use would be contrary to law CF it whether it could be
 - Not really interested in past reprehensible conduct → if relevant, discuss under s62A

Copyright

- Generally not possible to claim copyright in single words, titles or short phrases (Fairfax v Reed International Books [2010] FCA 984)
- Copyright over graphic features: stylised words are protected a drawings within s10(1) of Copyright Act 1968 (Cth) (Elwood v Cotton On [2008] FCAFC 197) → looked at the overall get up
 - Other criteria in s32 will apply: Image/device/logo must be the product of ‘some independent intellectual effort’ OR ‘sufficient effort of [an artistic] nature’ (IceTV Pty Ltd v Nine Network Australia [2009] HCA 14) → generally if opponent can show that author expended effort in the design choices, will meet the originality hurdle
 - Commercial effort will not be sufficient (Telstra Corp v Phone Directories [2010] FCAFC 149 (Perram J))
 - Opponent must show they are the owner/exclusive licensee of the copyright. Copyright vesting in a third party will NOT be sufficient.
- Tribunal must be satisfied that the defendant’s work was derived from the copyright owner’s work (CF Mitchell v BBC EWPC 42; AIA Agricola Italiana Alimentare v Borgo Developments [2018] ATMO 184)
- Relevant where there is an artistic work/media e.g. tv series, books

Other Legislation

- Australian Consumer Law
- Precluded by legislation such as: Telstra Corporation Act 1991 (Cth), Olympic Insignia Protection Act 1987 (Cth), Wine Australia Act 2013 (Cth)
- Use of certain emblems: The Geneva Conventions Act 1957
- Use of certain words: Banking Act 1959 and Life Insurance Act 1995
- Specific legislation for classes of products: Tobacco Plain Packaging Act 2011 (TPP Act)

Contrary to ‘Common’ Law

- “contrary to law” is NOT limited to breaches of statutory provisions (Neumann v Sons of the Desert SL [2008] FCA 1183)
- Enables consideration of passing off

actual use of registered mark or actual business of owner or goods the owner of the TM produces or any acquired distinctiveness associated with TM or any reputation

Considerations

- Words: how they look, length of the word, how they sound, meaning
 - Particularly start of the word and syllables
 - Sounds can be taken into account (Crazy Ron's Communications Pty Ltd v Mobileworld Communications Pty Ltd (2004) 209 ALR 1)
- 'idea' communicated by the mark
- Distinctive/essential features of the TM
- Do NOT consider the totality of conduct (CF passing off) but can consider it in general terms
 - Passing off inquiry is broader, not appropriate for deceptively similar (CA Henschke & Co v Rosemount Estates Pty Ltd (2000) 52 IPR 42)
 - Circumstances in which goods are likely to be bought a sold (e.g. sports shoes wall)
 - Characteristics of likely consumers
 - Circumstances of market (Henschke v Rosemount [2000]: crowded, typical wine consumers, how wine appears on wine lists)
 - Consideration of widespread use (MID Sydney v Australian Tourism [1999]: use of the TM by third parties, ease of consumers to differentiate)
- Reputation is not taken into account (Australian Meat Group v JBS Australia Pty Ltd [2018])
 - Purpose of the registration system is to "provide a bright line that delineates the property rights" of the registered owner, to go against this would run the risk of collapsing the long standing distinction between infringement and passing off (Self Care [2023] HCA)
 - However will be considered in terms of sound/meaning (e.g. Levis)

"of the same description" or "closely related to"

- Generally consider three principal factors (McCormick)
 - Nature of the goods (incl. origin and characteristics)
 - Use and purpose of the goods
 - Trade channels through which they are bought and sold
 - Produced by the same manufacturer?
 - Sold in the same shops
 - Sold to the same type of customers?
 - Those engaged in the manufacture and/or distribution are considered to belong to the same trade?
- Re Aussat Pty Ltd (1993) 27 IPR 309 discusses the criteria as to whether services are closely related to goods
 - Are the goods and services if matching technical complexity?
 - Is the technical training of the people who make the goods or provide the services the same?
 - Do the people who make the goods or provide the services belong to the same unions or associations?
 - Are there personnel who are implicit in the provision of the service, or a necessary ancillary to the provisions of it, who are viewed by the ordinary person as having the essential expertise in common to the provision of either the goods or services? (For example, in "vehicle hire services" and the goods "cars", there are the ancillary