



Australian Government

IP Australia

Discovery House, Phillip ACT 2606

PO Box 200, Woden ACT 2606

Australia

Phone: 1300 651 010

International Callers: +61-2 6283 2999

Facsimile: +61-2 6283 7999

Email: assist@ipaustralia.gov.au

Website: www.ipaustralia.gov.au

Official Notice

Trade Marks Amendment Bill 2006

The Trade Marks Amendment Bill was introduced into the Senate on 21 June 2006. The Bill amends the *Trade Marks Act 1995*, (the Act) which has been in force for ten years, and has recently been subject to review. The review sought comment from interest groups, released three issues papers and received comments from interested parties, including intellectual property professionals and small businesses. An industry reference group consisting of intellectual property professionals and industry representatives was set up to help in the consultations. The review found that the trade marks system was working effectively, but there were some changes that could be made to enhance the system. This Bill implements changes to the trade mark system arising out of that review.

The changes made by the Bill will improve the trade marks system in a number of ways. The Bill will strengthen trade mark rights, providing greater certainty to trade mark owners and the general public. The Bill includes provisions that will reduce the regulatory and administrative burden on the users of the system. It will also increase the transparency of the trade mark system, and increase alignment of the trade mark system with other intellectual property rights.

This notice is intended to provide a brief overview of the primary amendments contained in the Bill, and therefore focuses on the main issues. There are 103 items in the Bill, although many of these relate to minor, technical and consequential amendments. The Bill itself and the explanatory memorandum (EM) to the Bill should be considered for a full list and detailed understanding of the provisions. The Bill and the EM are available on-line at BillsNet <http://www.aph.gov.au/ParlInfo/BillsNet/main.htm>. None of the changes listed here will come into effect until after the Bill has been passed and has received Royal Assent; however, many of the provisions will not commence until six months from that date. This is to allow for regulations to be made to fully implement a number of the provisions. It will also allow time for more comprehensive information about the effects of the changes to be provided for our customers.

Some highlights from the *Trade Marks Amendment Bill 2006*

Legal Personality

- Only persons having legal personality may own trade marks filed after the date of Royal Assent. This provision does not affect the validity of trade marks filed prior to that day in the name of, for example, trusts or business names, irrespective of when they are registered.

Divisional Applications

- A divisional application may only be made for some of the goods/services excluded from the parent, for as long as the parent is pending
- The most recent application in a “chain” of divisionals can receive the filing date of the oldest trade mark in the chain.

Trade Mark Series Applications

- Series applications may now be multi-class
- What constitutes an allowable series application has been clarified
- Multiple series applications or registrations filed in respect of single classes prior to commencement may be “linked” to form single applications or registrations.

Collective Trade Marks

- May now be owned by incorporated associations.

Amendments to Trade Mark Applications

- Amendment provisions have been clarified
- More flexibility provided for the correction of clerical errors and obvious mistakes – amendments to be advertised for opposition purposes
- Requests for minor amendments no longer need to be in writing.

Grounds of Opposition

- New or modified grounds of opposition to:
 - enable the owner of a trade mark that is deceptively similar to another trade mark to oppose its registration on the basis of absolute first use;
 - allow registration of a trade mark to be opposed on the ground that it has been applied for in bad faith;
 - make the requirements for opposition based upon a trade mark with a reputation in Australia less restrictive;
 - clarify that opposition based upon a geographical indication only applies where the goods covered by an opposed trade mark are similar to those covered by a geographical indication, or the use of the opposed mark on the goods it covers is likely to deceive or cause confusion; and
 - provide for a trade mark found in opposition to have been amended contrary to the Act to be revoked and re-examined.

Opposition to Non-use Removal

- Any person to be able to make an application for a trade mark to be removed from the Register due to non-use, not just a person aggrieved
- Clarification of the Registrar’s discretion not to remove a trade mark from the Register where a potentially successful action has been brought for non-use of a trade mark on goods or services for which the trade mark was registered, but the trade mark owner has demonstrated use of the mark on closely related goods or services
- Clarification of the Registrar’s discretion to restrict registration of a trade mark used in a particular geographic area to that area.

Renewal Grace Period

- The grace period within which a trade mark registration can be renewed has been reduced from 12 months to 6, in line with the periods allowed under *Patents Act 1990*, the *Designs Act 2003*, and the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*.

Registrar may initiate Court Action

- The Registrar will now be able to initiate court action to amend or remove a trade mark from the Register, under certain circumstances where this is clearly in the public interest.

Power of a Registered Owner to deal with a Trade Mark

- The power of a registered owner to deal with their trade mark will be limited only by any rights recorded in the Register as being vested in another person.

Grounds for Rejection, Opposition and Cancellation

- The legislation has been clarified to ensure that the grounds of rejection, opposition and cancellation found throughout the Act and associated Regulations are appropriately included wherever they are relevant.

Protection of the Commonwealth from Legal Action

- The Commonwealth will be protected from legal action being taken, for example in relation to scandalous or defamatory trade marks, where the Registrar has published or otherwise dealt with them in good faith and in accordance with the requirements of the Act.

Customs: Notices of Objection and Security for Seizure of Goods

- Notices of objection will now cease after 4 years, whereas previously they had to be renewed every two years
- Trade mark owners will be able to provide a written undertaking as security for the Customs Office's expenses in seizing counterfeit goods, instead of having to provide cash up-front.

Queries Brendan Bourke
 Domestic Policy Section
 +61 2 6283 2443

Contact: IP Australia
Phone: 1300 651 010 or +61 2 6283 2999
Fax: +61 2 6283 7999
E-mail: assist@ipaaustralia.gov.au
Web: www.ipaustralia.gov.au