



IP Passport

IMPORTS

IMP

Fact Sheet

IP Australia has prepared this information to help businesses consider how their intellectual property (IP) can be protected and what IP issues need to be considered when importing products and services.

ROLE OF IMPORTING

Importation of goods and services into Australia is big business with an annual value of over A\$250 billion.* Many of the products imported are the subject of IP rights. An awareness of IP rights and how they may impact on importing products into Australia is critical for Australian importers.

*Source: Department of Foreign Affairs and Trade, www.dfat.gov.au, 2012

IP ISSUES FOR IMPORTERS

Although IP rights are generally similar around the world, they are often territorial in nature. Protection depends on the existence of a registered right in the country of interest. For example, patents, registered designs and registered trade marks will provide protection only if they have been granted in the relevant country.

However, IP rights can also exist in Australia without registration. These include copyright and unregistered trade marks which may have common law rights.

Importers need to consider IP carefully when making arrangements in Australia for bringing their products into Australia.

Importing goods and services into Australia can infringe others' IP rights.

Don't assume that because a supplier owns the overseas right to goods that they have the same rights in Australia. Always carry out your own due diligence.

It's important to consider whether the importer (or its supplier) should act to obtain IP protection in Australia.

A trade mark registered and used overseas may provide limited or no protection if not registered in Australia. In fact, use of the ® symbol on products in Australia (indicating registration) may constitute an offence if the relevant trade mark is not registered in Australia.

Failure to consider IP rights in making importing arrangements may result in the importer being the subject of legal action by the owner of the IP rights in Australia.

This includes the possibility that products may be seized by the Australian Customs and Border Protection Service or may allow others to take advantage of the importer's efforts in establishing a reputation.

IDENTIFYING IP RIGHTS IN AUSTRALIA

Enquiries can be made relatively easily as to the existence of IP rights in Australia. These risk reduction steps might include:

- seeking evidence from the supplier of the nature of IP rights in relation to products (both overseas and in Australia) and that the supplier is able to provide to the importer all necessary rights to allow import and supply of the products in Australia
- conducting a search of IP rights databases for patents, trade marks, designs and plant breeder's rights maintained by IP Australia to identify whether relevant Australian IP rights exist; these searches may be undertaken online or with the assistance of an appropriate professional
- reviewing the marketplace to identify unregistered IP rights which may exist, for example, an unregistered trade mark being used by another person in Australia.

PROTECTING IP OF THE IMPORTED GOODS

If IP rights do not exist in Australia, importers may wish to consider whether they or their supplier should apply for IP protection in Australia. IP protection must be sought by the appropriate party. For example, trade mark applications should be filed by the trade mark owner. If a person who is not the owner of the trade mark applies for registration of the mark, the application or resulting trade mark registration would be invalid and vulnerable to opposition or cancellation.

In many cases international treaties and conventions will assist an owner of an IP right overseas to gain protection in Australia. IP Australia and IP professionals can provide guidance on the types of protection obtainable and how best to seek such protection.

ipaaustralia.gov.au

COMMERCIAL ARRANGEMENTS

An importer should ensure appropriate commercial arrangements are with its suppliers to:

- authorise (or license) its use of IP rights in Australia (or warrant that no rights are required)
- confirm whether the rights granted are exclusive (or whether others can also import the products)
- clarify what rights the importer has to register and enforce them.

In some cases, for example an arrangement which provides franchise rights, the parties also need to consider whether the *Australian Franchising Code of Conduct* or other Australian laws may apply.

ENFORCEMENT OF IP RIGHTS

A range of enforcement options are available for owners of IP rights in Australia who believe their rights are being infringed.

These include:

- civil court action seeking remedies such as injunctions to restrain the infringing conduct, damages or an account of the profits, delivery up of infringing items and legal costs. Court action may be used to protect certain unregistered IP rights, such as through actions for misleading or deceptive conduct or passing off
- notices of objection lodged with the Australian Customs

and Border Protection Service by owners of IP rights under which the Service will seize goods infringing copyright or registered trade marks to enable the IP rights holder to institute legal action

- in a limited number of circumstances, law enforcement agencies such as state and federal police will take action in relation to the criminal provisions in Australia's IP legislation. This can include offences related to the importation of goods that infringe IP rights, such as counterfeit fashion goods, computer software or DVDs.

PARALLEL IMPORTS

Parallel imported goods (sometimes known as “grey imports” or “grey goods”) are legitimately produced by or under a licence from the IP rights owner in another country and imported into Australia through “unofficial channels”, such as a distributor who is not specifically authorised by the IP rights owner. In some cases, parallel importation of goods is permitted. For example—parallel importation of sound recordings and computer programs will not constitute an infringement of copyright or a registered trade mark in certain circumstances. Importers need to consider whether such exemptions may apply.

FURTHER INFORMATION

IP Australia www.ipaustralia.gov.au (provides information on Australian IP rights and searchable IP rights database)

Australian Copyright Council www.copyright.org.au (provides information and advice on copyright in Australia)

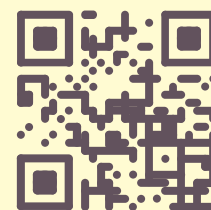
Australian Customs and Border Protection Service www.customs.gov.au (provides information on Notices of Objection)

ComLaw, Australian Government Attorney-General's Department www.comlaw.gov.au (provides online access to Australasian legal materials, including Australian legislation)

Australian Legal Information Institute (Austlii) www.austlii.edu.au (provides online access to Australasian legal materials, including Australian cases and commentary)

Australian Competition and Consumer Commission www.accc.gov.au (provides information on Australian competition and consumer laws, including the Franchising Code of Conduct)

Disclaimer: This information is intended to provide the reader with an awareness of some of the intellectual property issues relevant to importation of products. It is not exhaustive and does not constitute legal, business or professional advice. IP Australia recommends importers seek professional assistance as necessary. This fact sheet has been developed in conjunction with Spruson & Ferguson Patent & Trade Mark Attorneys.



Scan this QR code for more information