

Changes to the Australian Trade Marks Act 1995

The Trade Marks Amendment Act 2006 (“the Amendment Act”) received Royal Assent on 23 October 2006. The Amendment Act results from a review undertaken by IP Australia to ensure the Act was meeting the needs of Australian businesses and users of the Australian trade mark system.

06 November 2006

The Amendment Act introduces a number of changes which clarify uncertainties in the Act and reduce regulatory and administrative burdens on trade mark owners. The Amendment Act also introduces provisions which strengthen the rights of trade mark owners, including new and amended grounds of opposition. Most of these latter provisions are now in force. All other provisions are expected to take effect by 27 March 2007.

The amendments strengthen the rights of trade mark owners as follows:

- An application may now be opposed on the ground that the application was made in bad faith (section 62A). This is likely to assist in particular with spill over reputation type cases;
- A trade mark accepted under the prior continuous use provisions can now be opposed by the owner of a prior registered trade mark which has been used prior to the applicant’s first use date (section 58A);
- The requirements for an opposition based on a trade mark with a reputation in Australia have been made less restrictive by removing the requirement that the opposed mark must be substantially identical with or deceptively to the trade mark with the reputation in Australia (section 60); and
- An opposition based on geographical indication has been clarified so that it only applies where the goods specified in the opposed mark are

similar to those covered by the geographical indication or, where the goods are different, would otherwise be likely to deceive or cause confusion.

Other amendments include:

- Multi-class series applications will be allowable (section 6) and the Amendment Act clarifies that trade marks will be considered a series only where there are minor and obvious variations (subsections 27(5) and 51(1)). The Amendment Act will allow owners of current series applications and registrations to be linked into single multi-class applications or registrations (section 51A and 82A);
- The procedure for recording trade mark registrations with the Australian Customs Service has been streamlined by allowing trade mark owners to provide a written undertaking as security to Customs instead of having to provide a \$10,000 bank guarantee, bond or cash (subsection 133(3) and section 141);
- The Amendment Act removes the requirement that an applicant in a non-use removal action be an “aggrieved person”;
- Incorporated associations can now own collective trade marks (section 6); and



Trade Marks

- The Amendment Act allows a divisional application of a divisional application to maintain the filing date of the original parent application. Currently, the priority date may only be obtained from the actual filing date of the previous divisional application (section 60).

LATE RENEWALS

Trade mark owners should be aware that the grace period for renewing a trade mark after the renewal date has been reduced from 12 months to 6 months (sections 78, 79 and subsection 128(1)).

A full and detailed list of all of the changes can be found in the Explanatory Memorandum to the Trade Mark Amendment Bill 2006, which can be viewed at <http://www.aph.gov.au/ParlInfo/BillsNet/main.htm>

AUTHORS

Michael Wolnizer, Partner
Sally Foreman, Trade Mark Attorney



DAVIES COLLISON CAVE

If you would like to be removed from our mailing list, please send an email to mail@davies.com.au or telephone Melissa McLennan on + 61 3 9254 2777.

The contents of this information sheet are not intended to be, nor are they, a complete statement of the law on the particular subject matter and are for information purposes only. This update is not a substitute for legal advice.

Melbourne

1 Nicholson Street,
Melbourne VIC 3000
Telephone +61 3 9254 2777
Facsimile +61 3 9254 2770

Sydney

255 Elizabeth Street,
Sydney NSW 2000
Telephone +61 2 9293 1000
Facsimile +61 2 9262 1080

Brisbane

Level 3, 303 Coronation Drive,
Milton QLD 4064
Telephone +61 7 3368 2255
Facsimile +61 7 3368 2262

Canberra

Level 11, 60 Marcus Clarke St,
Canberra ACT 2601
Telephone +61 2 6248 8063
Facsimile +61 2 6248 6591

Newcastle

130 University Drive
Callaghan NSW 2308
Telephone +61 2 4960 8366
Facsimile +61 2 9262 1080