

New Grounds introduced under the Trade Marks Act

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After extensive review a decade after its introduction, the Trade Mark Act 1995 (Cth) (the 'Act') has undergone important changes implemented by the Intellectual Property Laws Amendment Act 2006 (Cth) and the Trade Marks Amendment Act 2006. Additional grounds have been enacted to oppose a trade mark accepted for registration and revoke those already registered. Specifically there are:

- increased grounds on which accepted trade marks can be opposed;
- greater powers for the Registrar to revoke a registered trade mark; and the removal of the need for a person to be aggrieved in order to file a non-use application.

New Opposition Grounds Under the Act

- There are a number of new grounds of opposition to accepted trade marks, as well as clarification to pre-existing grounds:
 - Section 58A allows the owner of a trade mark to oppose the acceptance of a substantially identical or deceptively similar trade mark, that was accepted on the grounds of showing section 44(4)) prior continuous use;
 - Section 60 provides greater protection of marks with sufficient marketplace reputation by removing the requirement that the opposed mark must be substantially identical with or deceptively to the trade mark with the asserted marketplace reputation in Australia (the 'Reputation Based Mark'). Notwithstanding that the opposed mark may not be substantially identical or deceptively similar to a Reputation Based Mark, the opposed mark may be denied registration, if it can be shown by the opponent that use of the accepted mark would be likely to cause deception or confusion in the marketplace; and
 - Section 62A provides that a trade mark can be opposed if it was applied for in bad faith. This is likely to assist in preventing the registration of 'ghost marks' and marks deliberately registered for the purpose of later selling it to the 'rightful' owner. This section is somewhat akin to provisions adopted to prevent domain name cyber squatting;
 - Under section 55(2) the Registrar is given the discretion to revoke acceptance and to re-examine an application where an opponent can establish that the application was amended contrary to the Act;
 - Clarification is also given to the opposition ground based on a geographical indication (section 61) so that it only relates to goods for which the geographical indication is relevant (for wine and other fine foods based products).

Revocation of Registration under the Act

The new s 84A of the Act enables the Registrar of Trade Marks to revoke the registration of a trade mark within 12 months of registration if satisfied in the circumstances that the trade mark should not have been registered and that such

action is reasonable taking into account any and all of the circumstances that existed at the time of registration.

The circumstances that are to be taken into account in considering whether the trade mark should not have been registered include, but are not limited to:

- errors or omissions leading to registration;
- Australia's obligations under international agreements; and
- special circumstances.

The circumstances that are to be taken into account in considering whether it is then 'reasonable' to revoke the registration include, but are not limited to:

- any use of the trade mark;
- any legal proceedings relating to the trade mark;
- other action taken in relation to the trade mark; and
- special circumstances.

The two important prerequisites to the Registrar's power to revoke are that a mark cannot be revoked without notifying the owner and affording them an opportunity to be heard by way of submissions and/or requested hearing. The provisions are intended to provide administrative recourse for wrongly registered marks, potentially avoiding the more expensive judicial path to do so.

Removal of Standing Requirement for Non-Use Proceedings

The previous requirement that an applicant be an aggrieved person in order to apply for the removal of the registration of a mark on the basis of non-use has been removed. Any party may now apply for removal.

Conclusion

These various new grounds introduced into the Act, provide a broader scope of rights for parties to contest the registration of the marks they consider to be wrongly made or in fact marks which they have common law rights to. The removal of the aggrieved person standing requirement previously required under the Act for non-use proceedings, is likely to see an increase in these type of removal applications.

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