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**Council for Trade-Related Aspects
of Intellectual Property Rights**

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REVIEW OF LEGISLATION ON TRADEMARKS, GEOGRAPHICAL INDICATIONS AND INDUSTRIAL DESIGNS

Replies from Australia to questions posed by the European Community and its Member States¹, Japan² and the United States³

The following communication, dated 29 October 1996, has been received from the Permanent Mission of Australia.

¹Document IP/C/W/37

²Document IP/C/W/40

³Document IP/C/W/39

REPLIES TO QUESTIONS POSED BY THE EUROPEAN COMMUNITY
AND ITS MEMBER STATES

Trademarks

1. *Does Australian law implement Article 4C(3) of the Paris Convention in conjunction with Article 2.1 of the TRIPS Agreement which says that if the last day of the period (of priority) is an official holiday, or a day when the office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day? If yes, please explain how.*

Section 36(2) of the *Acts Interpretation Act 1901* (the Act) provides that:

"(2) Where the last day of any period prescribed or allowed for the doing of anything falls on a Saturday, or on a Sunday, or on a day which is a public holiday, or on a bank holiday in the place in which the thing is to be or may be done, the thing may be done on the first day following, which is not a Saturday, or a Sunday, or a public holiday or bank holiday in that place."

By virtue of the long title of the Act which is "An Act for the Interpretation of Acts of Parliament and Shortening their Language" the provisions in Section 36(2) of the Act apply to the *Trade Marks Act 1995*.

2. *Does Australian law provide for the prohibition to use trademarks (service marks) which constitute a reproduction, an imitation or a translation of a well-known trademark in accordance with Article 6bis of the Paris Convention in conjunction with Article 2.1 of the TRIPS Agreement, Article 16.2 and Article 16.3 of the TRIPS Agreement and, if so, on what basis?*

Australian law protects against the use of imitations or translations of well-known trademarks (service marks) through a combination of Sections 60 and 120(3) of the *Trade Marks Act 1995*⁴, the common law tort of passing off, Sections 52 and 53 of the *Trade Practices Act 1974*⁵ and the equivalent provisions of the Fair Trading Acts of the Australian states.

Australia's common law of passing off has its origins in the relevant British common law and is exemplified in the decision of the Australian High Court, *Moorgate Tobacco Co. Ltd. v Philip Morris Ltd.* (1984) 156 CLR 414. The text of this decision can be found in Annex 1 to this document (English only).

3. *Does Australian legislation provide temporary protection, and, if so, on what basis, for trademarks in respect of goods exhibited at official or officially recognized international exhibitions in accordance with Article 11 of the Paris Convention in conjunction with Article 2.1 of the TRIPS Agreement?*

Provision for temporary protection of the kind provided for by Article 11 of the Paris Convention is unnecessary because Australian law recognizes prior use of trademarks whether registered or

⁴ The Trade Marks Act 1995 has been notified under Article 63.2 of the Agreement and distributed as document IP/N/1/AUS/T/1

⁵ The Trade Practices Act 1974 has been notified under Article 63.2 of the Agreement and distributed as document IP/N/1/AUS/O/1

unregistered (see Sections 41 and 44 of the *Trade Marks Act 1995*⁴). In addition, Australian case law has established that ownership of a trademark can be determined by first use of the trademark in Australia (*Shell Co. (Aust) Ltd. v Rohm and Haas Co.* (1948) 78 CLR 601). The text of this decision can be found in Annex 2 to this document (English only).

4. *Could the Australian Government explain whether its legislation is in accordance with Article 15.3 of the TRIPS Agreement to the extent that trademark applications are not solely rejected on the ground that intended use has not taken place before the expiry of a period of three years from the date of application?*

Under Section 27 of the *Trade Marks Act 1995*⁴ it is sufficient for an applicant to have an intention to use the trademark in respect of the specified goods and/or services. There is no provision for the Registrar to reject the application for registration on the ground that the intended use has not taken place before the expiry of a period of three years from the date of the application.

Geographical indications

5. *Does Australian law grant protection against unfair competition in relation to geographical indications, as provided for in Article 10bis of the Paris Convention in conjunction with Article 2.1 of the TRIPS Agreement, over and above what is provided for under the Trade Practices Act 1974 and the fair trading legislation in the States and Territories of Australia?*

The answer to question 2 provides a description of the Australian régime for protection against unfair competition and the provisions of the *Trade Practices Act 1974*⁶, common law provisions and relevant state laws. This régime also applies to the use of geographical indications.

6. *Does Australian law provide protection for geographical indications for all goods (and not only for wine and grape products) in accordance with the provisions of Article 22 of the TRIPS Agreement and, if so, on what basis?*

Australia's obligations under Article 22.2 of the TRIPS Agreement are met by the *Trade Practices Act 1974*⁶, the common law provisions of passing off, relevant state fair trading legislation and labelling, requirements. Obligations in respect of Article 22.3 are satisfied by Sections 43, 61 and 88 of the *Trade Marks Act 1995*⁴.

7. *Does Australian law provide the legal means for interested parties to prevent the use of any means in the designation or presentation of a good, that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good in accordance with Article 22.2 of the TRIPS Agreement?*

See the answer to question 6.

8. *Does Australian law provide for the protection granted under Articles 22.2 and 22.3 of the TRIPS Agreement to a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory in accordance with Article 22.4 of the TRIPS Agreement and, if so, on what basis?*

See the answer to question 6.

9. *Does Australian law provide for the protection of spirits not obtained from grapes, in the terms of Article 23 of the TRIPS Agreement?*

See the answer to question 6.

10. *Does Australian legislation provide that, in order to be entitled to obtain the registration of a trademark containing or consisting of a sign that is a geographical indication for goods not originating in the same territory as the goods identified by the geographical indication, it is necessary to have acquired, through use in good faith, the right to use such a trademark, in accordance with Article 24.5 of the TRIPS Agreement?*

Australia's obligations under Article 24.5 of the TRIPS Agreement are met by Section 61 of the *Trade Marks Act 1995*⁴.

Industrial designs

11. *Does Australian law provide for a grace period of at least six months for the payment of fees prescribed for the maintenance of industrial property rights in accordance with Article 5bis(1) of the Paris Convention (1967) in conjunction with Article 2.1 of the TRIPS Agreement?*

Section 27A of the *Designs Act 1906*⁶ (the Act) together with Regulation 23 of the *Designs Regulations*⁷, which is made in accordance with Section 41 of the Act, provide for a grace period of six months.

12. *Are textile designs, including fashion, protected under Australian law (Article 25.2 of the TRIPS Agreement)? If yes, on which legal basis and under which conditions?*

The *Designs Act 1906*⁶ and the *Copyright Act 1968*⁸ together provide protection for new and original designs including textile designs.

⁶ The Designs Act 1906 has been notified by Australia under Article 63.2 of the Agreement and distributed as document IP/N/1/AUS/D/1

⁷ The Designs Regulations have been notified by Australia under Article 63.2 of the Agreement as an "other law" (see document IP/N/1/AUS/1/Rev.1). Regulation 23 reads as follows:

Extension of period of registration

23.(1) Subject to regulation 63 and to sub-regulation (2), an application for the purposes of sub-section 27A(2), (12) or (13) of the Act for an extension or further extension of the period of registration of a design shall be in accordance with Form 7.

(2) For the purposes of sub-section 27A(14) of the Act, an application under sub-section 27A(12) or (13) of the Act may be made within six months after the expiration of the period of registration of the design to which the application relates as extended under sub-section 27A(8) or (12) of the Act, as the case may be.

⁸ The Copyright Act 1968 has been notified by Australia under Article 63.2 of the Agreement and distributed as document IP/N/1/AUS/1/Add.1

REPLIES TO QUESTIONS POSED BY JAPAN

1. *Since it is not clearly stipulated in the Designs Act 1906 that textile designs are protected in conformity with the TRIPS Agreement, please explain under which provision of the Act or other copyright related law these designs are protected. Moreover, to make sure that the opportunity to seek and obtain protection for textile designs is not impaired unreasonably, please explain your system or practice particularly with regard to cost, examination or publication (cf. paragraph 2 of Article 25 of the TRIPS Agreement).*

Any design is capable of registration provided it meets the criteria for registration and the definition of a design provided in the *Designs Act 1906*⁶ (the Act). Section 4 of the Act provides:

"design" means features of shape, configuration, pattern or ornamentation applicable to an article, being features that, in the finished article, can be judged by the eye, but does not include a method or principal of construction."

The elements of "pattern and ornamentation" can clearly be applied to the surface of a textile and thus fall in the above definition.

In addition, Sections 74-77 of the *Copyright Act 1968*⁸ provide for protection of textile articles bearing surface decoration notwithstanding that they are sold in quantity in Australia following their manufacture.

There is no process to record or register copyright in Australia and no costs are associated with obtaining the right.

A copy of the relevant information brochure for registration of designs is attached (see Annex 3 to this document (English only)). This provides detail on the process of registration and cost.

2. *The word "making" is not included in the scope of infringement provided for in Section 30 of the Designs Act 1906. Are design rights appropriately protected in that regard (cf. paragraph 1 of Article 26 of the TRIPS Agreement).*

The reference in Section 30 of the *Designs Act 1906*⁶ to the application of a design to any article includes the "making" of an article in respect of which the design is registered. Therefore the requirements of Article 26 of the TRIPS Agreement are met.

3. *In your country, where the provisions on the "Crown use" are applied, some restrictions are imposed on the owner of a protected industrial design: for example, license fees will not be paid to the owner of a registered design. Is there any possibility that the legitimate interests of a rightholder can be unreasonably prejudiced within the meaning of paragraph 2 of Article 26 of the TRIPS Agreement?*

The assertion that licence fees will not be paid is incorrect as Section 40A(4) requires that the terms for Crown use must be agreed between the Crown and the owner or be fixed by a court. Therefore the legitimate interests of a rightholder are recognized and protected by Sections 40A(4) and 40D(3) of the *Designs Act 1906*⁶.

4. *In your country, the first duration of protection available is less than ten years, and any renewal thereafter cannot be requested at the time of registration. It may happen, therefore, that the duration of protection is less than ten years when the first duration has lapsed and the restoration is not permitted afterwards. Would this not be contrary to the spirit of paragraph 3 of Article 26 of the TRIPS Agreement?*

Section 27A of the *Designs Act 1906*⁶ provides that unless the design is established to be "not new or original" the owner is entitled to maintain registration on payment of relevant renewal fees for 16 years from the date of filing of the application. This provision is fully consistent with Article 26.3 of the TRIPS Agreement.

REPLIES TO QUESTIONS POSED BY THE UNITED STATES

1. *Please explain whether the nature of goods or services to which a trademark is to be applied can serve as an obstacle to the registration of the mark under Australian law. If so, please identify and explain the subject matter excluded under this authority, the relative provisions of the Australian law that serve as a basis for these exclusions, and how this practice complies with TRIPS Article 15.4.*

Section 6 of the *Trade Marks Act 1995*⁴ provides:

"6. "Goods of a person" means goods dealt with or provided in the course of trade by the person...", and

"Services of a person" means services of a person dealt with or provided in the course of trade by the person."

These provisions, together with the terms of Section 27, mean that the nature of the goods or services can in no way limit or serve as an obstacle to the registration of the mark under Australian law.

2. *Please explain whether Australian trademark law establishes a presumption of likelihood of confusion in the determination of confusing similarity in cases where identical marks are used on identical goods, as required by TRIPS Article 16.1. If so, please identify and explain the legal basis for this presumption.*

The Australian trademark law does establish a presumption of likelihood of confusion in the determination of confusing similarity in cases where identical marks are used on identical goods (see Section 120 of the *Trade Marks Act 1995*⁴).

3. *Please explain how unregistered well-known trademarks are protected in Australia, as required by TRIPS Articles 16.2 and 16.3.*

Well-known trademarks are protected under Australian law through Section 60 of the *Trade Marks Act 1995*⁴, the common law tort of passing off, Sections 52 and 53 of the *Trade Practices Act 1974*⁵ and equivalent provisions of the Fair Trading Acts of the Australian states. The text of the Australian High Court decision in *re Moorgate Tobacco Co. Ltd. v Philip Morris Ltd.* (1984) 156 CLR 414 can be found in Annex 1 to this document.