
Trade Marks and the Wine Industry

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Abstract

The Australian wine industry operates in a highly competitive environment. It is therefore necessary for wine producers to protect their marks. This article begins with the history of trade marks. It then examines and compares the common law and statutory causes of action available for infringement of a trade mark. Cases discussed include *J Bollinger v Costa Brava Wine Co Ltd* [1960] Ch 263, *Comité Interprofessionnel Du Vin De Champagne (Comité) v N L Burton Pty Limited (t/as Freixenet Spanish Champagne Distributors)* [1981] FCA 196 and *E & J Gallo Winery v Lion Nathan Australia Pty Limited* [2009] FCAFC 27. Legislation considered includes the *Trade Marks Act 1995* (Cth), the *Trade Practices Act 1974* (Cth) and the *Australian Wine and Brandy Corporation Act 1980* (Cth).

Introduction

In Australia, trade marks are regulated by the *Trade Marks Act 1995* (Cth) ('TMA'), which in s 17 answers the question 'What is a trade mark?' with the following definition: 'A *trade mark* is a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.'

This legal language does give some notion of what a trade mark is, but there is far more to trade marks than is conveyed by that convoluted sentence. One of the functions of trade marks is to protect the interests of the owner and another is to provide information about the product itself.¹ In terms of the latter, 'Successful marks are like packets of information',² the key being in the word 'sign'. The definition of sign in turn is provided by s 6 of the TMA which reads: '*Sign* includes the

following or any combination of the following, namely any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent.'

If a consumer is satisfied with one product that bears the trade mark of a particular maker, they may well be inclined to purchase on trust a different product with the same trade mark.³ Schechter says: 'The fact that through his trademark the manufacturer or importer may "reach over the shoulder of the retailer" and across the latter's counter straight to the consumer cannot be over-emphasized ...'⁴

Business names and company names can, of course, also generate goodwill. However, registration of such names serves to protect the public, rather than the goodwill of a business. Entities that carry on business under an assumed name are required to register that name under their respective state or territory *Business*

¹ Jill McKeough, Andrew Stewart and Philip Griffith, *Intellectual Property in Australia* (Butterworths, 3rd ed, 2004) 498.

² Stephen Carter, 'The Trouble with Trade Marks' (1990) 99 *Yale Law Journal* 759, 759, cited in Patricia Loughlan, *Intellectual Property: Creative and Marketing Rights* (LBC Information Services, 1998) 163.

³ Frank I. Schechter, 'The Rational Basis of Trademark Protection' (1927) 40(6) *Harvard Law Review* 813, 816-817.

⁴ *Ibid* 816-818. Schechter is making reference to a passage in H.G. Wells, *The World of William Clissold* (Ernest Benn, 1926) vol 1, 237.

Names Act.⁵ Registration of the name gives the public and relevant authorities a means of ascertaining the identity of the owner(s) of a business.⁶ The same applies to corporations who must register, under the *Business Names Act*, any name other than their registered company name. Registration of a trade mark, by way of contrast, is not compulsory and it serves the purely commercial function of protecting the goodwill of the owner of the mark.

The purpose of this article is to examine the law relating to trade marks, with particular emphasis on the wine industry. The first part of the article briefly outlines the history of trade marks and examines in more detail their purpose before describing the alternatives. The second part looks at the requirements for registration of a trade mark, and the process. The article concludes with a summary of the more important issues that emerge from the earlier discussion.

The History of Trade Marks

The history of 'marks' goes back millennia, with archaeologists finding four thousand year old saucers and bowls near Corinth in Greece which were imprinted with the potters' marks.⁷ Merchants' marks can be traced back to mediaeval times in England, as exemplified in the c1394 poem *Pierce the Ploughman's Crede* which referred to 'merkes of marchauntes'.⁸ The first reference to 'trade-marks' in a case appears to have been in England in the court of King's Bench in the case of *Southern v How* in 1618. This case concerned the use of the letters JG and a device on cloth manufactured by a clothier who had earned such a high reputation for quality that customers bought his cloth without further

inspection. A clothier who produced inferior cloth used the same mark and the sale of the inferior cloth damaged the reputation of the first.⁹ Although there is some confusion about just exactly what was said, this case has been relied on subsequently as authority for the proposition that the improper use of a trade mark is actionable.¹⁰ The legal action used to protect trade marks in the earliest cases, such as *Southern v How*, was tort of deceit, from which the tort of passing off developed.¹¹

During the 19th century it became accepted in Britain that the goodwill bound up in a mark was a form of property.¹² In 1875 the UK Parliament set up the first trade mark registry, regulated by the *Trade Marks Registration Act 1875* (UK). The Australian colonies of South Australia, Queensland, Tasmania and New South Wales had already set up registers before Britain did. All of the colonies had registers by Federation, but there were differences in how they operated.¹³ After Federation, when the Commonwealth government assumed the regulation of trade marks by virtue of s 51(xviii) of the *Australian Constitution*, the *Trade Marks Act 1905* (Cth) was similar in some respects to the *Trade Marks Act 1905* (UK). The *Trade Marks Act 1955* (Cth), was very different to the *Trade Marks Act 1938* (UK), both of which had replaced the 1905 legislation in their respective jurisdictions. The *Trade Marks Act 1995* (Cth) ('TMA'), the legislation currently in force, repealed and replaced the 1955 Act.¹⁴

Alternatives to Trade Marks

If, by choice or for some technical reason, a trade mark is not registered, there are two legal alternatives where

⁵ *Business Names Act 1963* (ACT); *Business Names Act 2002* (NSW); *Business Names Act 2007* (NT); *Business Names Act 1962* (Qld); *Business Names Act 1996* (SA); *Business Names Act 1962* (Tas); *Business Names Act 1962* (Vic); *Business Names Act 1962* (WA).

⁶ Paul Latimer, *Australian Business Law* (CCH Australia, 27th ed, 2008) 859.

⁷ Frank I. Schechter, *The Historical Foundation of the Law Relating to Trade Marks* (Columbia University Press, 1925) 20.

⁸ *Ibid* 22.

⁹ Mark Davison, Kate Johnston and Patricia Kennedy, *Shanahan's Australian Law of Trade Marks and Passing Off* (Law Book Company, 3rd ed, 2004) 2.

¹⁰ Schechter, *Historical Foundation*, above n 7, 6–9.

¹¹ Davison, Johnston and Kennedy, above n 9, 2–3.

¹² Intellectual Property Office (UK), *History of Trade Marks* <www.ipo.gov.uk>.

¹³ Davison, Johnston and Kennedy, above n 9, 7; Staniforth Ricketson, *The Law of Intellectual Property* (Law Book Company, 1984) 601–602.

¹⁴ McKeough, Stewart and Griffith, above n 1, 499.

there has been an infringement.¹⁵ The first is the common law tort of passing off, the precursor to the statutory trade marks regime as mentioned above, or an action for misleading or deceptive conduct under s 52 of the *Trade Practices Act 1974* (Cth) ('*TPA*'). Passing off is an 'economic tort' in that it protects the commercial interests of the plaintiff. It is used where the plaintiff has an established reputation in business, and the defendant, often a trade competitor, takes advantage of this to promote the defendant's own interests. This can be done by adopting a similar, or even the same, name, or by copying the designs of the plaintiff, or by identifying the defendant's product in a similar manner to the plaintiff's.

There have been a series of cases over the use of the word 'champagne' in relation to the selling of sparkling wine. One of the earlier ones, an English case, is *J Bollinger v Costa Brava Wine Co Ltd* [1960] Ch 263, more commonly known as the *Spanish Champagne* case. There were twelve plaintiffs, including Bollinger, all of whom were wine producers from the Champagne region in France. The plaintiffs were successful in preventing the defendant from marketing 'Spanish Champagne', on the basis that people would be deceived by the name.

These days, passing off by itself is the subject of infrequent litigation as it is easier to use the provisions of the *TPA*, although claims under the *TPA* are often accompanied by a claim in passing off.¹⁶ The *TPA* represents a shift in favour of the consumer away from the old 'caveat emptor' (buyer beware) attitude that gives the manufacturer a huge advantage. The general

focus of the *TPA* is to promote competition and fair trading in the market and to provide consumer protection.¹⁷ The most useful section in the context of this paper is s 52 which is headed 'Misleading or deceptive conduct':

52(1) [Prohibited conduct] A corporation shall not, in trade or commerce, engage in conduct that is misleading or deceptive or is likely to mislead or deceive.

52(2) Nothing in the succeeding provisions of this Division shall be taken as limiting by implication the generality of sub-section (1).

The behaviour captured by 'misleading or deceptive conduct' encompasses the examples given for passing off. A similar case to the *Spanish Champagne* case above, but brought under the *TPA* in Australia, is *Comité Interprofessionel Du Vin De Champagne (Comité) v N L Burton Pty Limited (t/as Freixenet Spanish Champagne Distributors)* [1981] FCA 196; (1981) 57 FLR 434 (7 December 1981). In this case, the Comité alleged a breach of s 52 by Burton Pty Ltd over the use of the term 'champagne' for sparkling wine. Unlike the outcome in the English *Spanish Champagne* case above, however, Franki J in the Federal Court held that there was no prima facie case of a contravention of s 52 of the *TPA*. Franki J decided this on the basis that the Comité had not established that enough of the class of people likely to be purchasers would be misled or deceived, or were likely to be misled or deceived, by the use of the word 'champagne' in reference to the Freixenet wine. This is because in Australia the term 'champagne' is commonly used to refer to a style of wine, rather than its origin. There has since been an agreement between the European Union and the Australian government which gives statutory protection to European 'geographical indications' for wines. This will be discussed in a separate article of this edition.

The disadvantage of both the common law action of passing off and an action under the *TPA* is that, to be

¹⁵ A mark may not be registrable for a number of reasons. For example, it may not fit the definition of a mark as per s 17 *TMA*, it may lack distinctiveness (s 41) or it may be too similar to another mark that has already acquired a reputation in Australia (s 60).

¹⁶ See for example, *Paul Hogan v Koala Dundee Pty Ltd* (1988) ATPR 40-902 and *Pacific Dunlop Limited v Paul Hogan* (1989) ATPR 40-948; in the former case the applicants succeeded in passing off, Pincus J finding it unnecessary to consider the *TPA* claim, and in the latter case the applicants were successful in both.

¹⁷ Section 2 *Trade Practices Act 1974* (Cth).

successful, the plaintiff or applicant must prove that their mark already has a well-established reputation. In addition, this reputation must exist in the geographical area in which the defendant is carrying out the conduct being complained of.¹⁸ This is not necessary with a trade mark which can be registered before the trade mark has been used, providing that there is an intention to use it.¹⁹

The advantage of registering your 'trade mark' is illustrated by the use of the 'Saint Allourn Estate' name in relation to a winery in the Margaret River area. The name was used for seven or eight years by Michael Chaney and his business partners, but was not registered by them as a trade mark during this time. The name was then registered by Manjimup vigneron Sydney Hooker of Stone Bridge Estate Wines, who offered to relinquish it for \$40,000, an offer which was refused. Michael Chaney and his partners had to change the name of their venture, which is now 'Aleno Estate Wines' which they have registered as a trade mark.²⁰

Requirements for the Registration of a Trade Mark

There are some significant differences in the current *TMA* when compared to previous trade marks legislation. Under the previous legislation, a "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter or numeral, or any combination thereof.²¹ Section 6 of the *TMA* adds to the category of 'signs' that are registrable by also including 'aspect of packaging, shape, colour, sound or scent'. Another difference is that that under s 33 of the *TMA* there is a presumption of registrability, and cases of doubt are to be resolved in the applicant's favour, whereas under the 1955 *Act* it was the applicant who had to establish that the mark was registrable.²²

The validity of a trade mark may be challenged at any time on the basis that it is not distinctive, or is likely to deceive or cause confusion (concepts that will be discussed in detail later). Otherwise, validity may be an issue during the registration process, or when the mark is advertised in the *Official Journal of Trade Marks* as having been accepted, or during infringement proceedings. A trade mark may be registered in respect of goods, services and goods and services, and the applicant must specify which particular class or classes for which registration is sought.²³ The various classes of goods and services are set out in Schedule 1 of the *Trade Mark Regulations 1995*.²⁴

The first and most obvious requirement for registration is that the trade mark falls within the definition given in s 6 of the *TMA*. Following on from this, the trade must be capable of being represented graphically, that is by writing or drawings.²⁵ The mark must also be capable of distinguishing the goods and/or services of the applicant from those of their competitors.²⁶ Distinctiveness may exist for two reasons: First, the mark may be inherently adapted to distinguish the applicant's goods from those of their competitors.²⁷ A trade mark that does little more than indicate the type, quality, intended purpose, origin or similar characteristics of the goods or services will be rejected for lack of distinctiveness.²⁸ For example a person's name would not of itself necessarily be inherently distinctive, whereas the person's name in the form of a fancy signature may well be inherently distinctive.²⁹ Secondly, a trade mark may be distinctive because of the applicant's extensive use of the mark prior to their application for registration.³⁰ This is known as 'acquired' distinctiveness, and means that the

¹⁸ See, for example, *Con Agra v McCain Foods (Aust) Pty Ltd* (1992) 23 IPR 193.

¹⁹ Section 17 *Trade Marks Act 1995* (Cth).

²⁰ Mark Pownell, 'Chaney is trumped on winery trademark', *The West Australian* (Perth), 14 October 2000, 77.

²¹ Section 6 *Trade Marks Act 1955* (Cth).

²² McKeough, Stewart and Griffith, above n 1, 513.

²³ Sections 19 and 27(3) *Trade Marks Act 1995* (Cth).

²⁴ *Trade Marks Act 1995* (Cth), sch 1. Alcoholic beverages other than beer are contained in class 33, whereas beer is in the same class as soft drinks, fruit juices, syrups and other non-alcoholic beverages, and that is class 32.

²⁵ Section 40 *Trade Marks Act 1995* (Cth), and reg 4.3.

²⁶ Section 41(2) *Trade Marks Act 1995* (Cth).

²⁷ Section 41(6) *Trade Marks Act 1995* (Cth).

²⁸ Section 41(3) *Trade Marks Act 1995* (Cth).

²⁹ McKeough, Stewart and Griffith, above n 1, 522.

³⁰ Section 41(6)(a) *Trade Marks Act 1995* (Cth).

trade mark has already gained a reputation before registration is sought.³¹ An example of this is the trade mark HOUGHTON, for the winery in Western Australia. The first wine was produced in 1859 on a property in the Swan Valley named after Lieutenant Colonel Richmond Houghton who had purchased the property as part of a syndicate in 1859. The property was sold in 1859 to a Dr John Ferguson, so Houghton was no longer involved at the time of the first vintage.³² The trade mark HOUGHTON, in simple unadorned font, was registered as a trade mark in 1937, and has remained registered continuously ever since.³³ There is nothing inherently distinctive in the word 'Houghton', so if it were to be registered for the first time now it would require some embellishment to make it inherently distinctive for the purposes of the *TMA*.

A mark will also be unregistrable if it is likely to deceive or confuse. Deception or confusion, or both, feature in ss 43, 44 and 60 of the *TMA*. Under s 43 the mark may be deceptive or misleading because of some 'connotation' in relation to the class or classes of goods or services for which registration is sought.³⁴ This refers to those marks where, contained within the mark itself, there is some inference of quality or suggestion of an attribution which is false. An example is where an application to register BRAVEHEART THE MUSICAL as a trade mark was successfully opposed because it falsely suggested a connection to the movie Braveheart.³⁵ Section 44 relates to where 'the applicant's trade mark is substantially identical with, or deceptively similar to' an already registered trade mark for similar goods or services, or one for which registration is being sought which has an earlier priority date.³⁶ The assessment of whether marks are 'substantially identical' is done by a side by side

comparison. Section 10 of the *TMA* says that 'a trade mark is taken to be deceptively similar to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion'. *E & J Gallo Winery v Lion Nathan Australia Pty Limited* [2009] FCAFC 27 ('Gallo'), discussed in more detail later, illustrates both principles. The primary judge put both marks, BAREFOOT (registered by Gallo Winery in Class 33 'Alcoholic beverages (except beer)') and BAREFOOT RADLER (registered by Lion Nathan in Class 32 'Beers ...'), side by side and concluded that the two marks were not identical. He then 'assessed whether the mark used by Lion Nathan so nearly resembled Gallo's mark that it would be "likely to deceive or cause confusion"' and concluded that it did.³⁷ The decision was upheld on appeal to the Full Court of the Federal Court.

Section 60 covers situations where the mark may be likely to deceive or cause confusion, and hence be unregistrable, because it is too similar to a trade mark that has already acquired a reputation and goodwill in the Australian market for that type of good or service.³⁸ Section 60 is applicable where registration is opposed, 'the registration of a trade mark in respect of particular goods and services may be opposed on the ground that ...', rather than being a ground for rejection at the application stage. It may also be available where the other mark is not registered.³⁹

Section 17 requires that the trade mark is 'used or intended to be used'; while it is possible to register a trade mark before it is used in fact, there must be genuine intention at the time of registration to use the mark.⁴⁰ The use must be bona fide and not a means of hoarding a mark or preventing other, similar marks from being registered.⁴¹ Non-use may be grounds for

³¹McKeough, Stewart and Griffith, above n 1, 519.

³²<www.houghton-wines.com.au>.

³³<www.ipaustralia.gov.au>.

³⁴Section 43 *Trade Marks Act 1995* (Cth).

³⁵*Durkan v Twentieth Century Fox Film Corporation* (2000) 47 IPR 651.

³⁶Section 44(1)(a) & (b) *Trade Marks Act 1995* (Cth).

³⁷*E & J Gallo Winery v Lion Nathan Australia Pty Limited* [2009] FCAFC 27, [13–16].

³⁸Section 60(1) & (2) *Trade Marks Act 1995* (Cth).

³⁹McKeough, Stewart and Griffith, above n 1, 539.

⁴⁰*Ibid* 505.

⁴¹*Ibid* 506–507.

opposing the registration of a mark. Part 9 of the *TMA* is headed 'Removal of trade mark from register for non-use', and sets out provisions enabling 'a person' to apply to the Registrar to have a trade mark 'that is or may be registered removed from the Register'.⁴² The *Gallo* case is a good example of use that is considered not to be bona fide, and also illustrates the removal of a mark from the Register for non-use. In *Gallo* the applicant (Gallo Winery), based in the United States, did not export its product to Australia. However a third party imported a small amount of the applicant's wine into Australia and the applicant relied on this as bona fide use of the mark in Australia. Because the applicant was unable to show use 'in the course of trade by a person' (here 'the person' being the applicant), there was no 'use' as such by Gallo to satisfy the requirements of the *TMA*.⁴³ In addition the respondent (Lion Nathan), in a cross application, sought to have the applicant's mark BAREFOOT removed from the Register for non-use, and was successful.⁴⁴

Section 18 provides that certain signs, as specified in the regulations, are not to be used as a trade mark or part thereof. A few examples are 'patent', 'copyright', 'registered' and national flags.⁴⁵ There are certain signs that are not permitted because they are scandalous or the use would be contrary to law. Geographical names can be registered but must satisfy the requirement for acquired or inherent distinctiveness; this is to be distinguished from false geographical indicators, which

is discussed elsewhere in this journal and is particularly important with respect to wine.

The Process of Registration

Anyone wishing to register a mark should first search the trade marks database to ensure that their mark will not infringe an already registered mark.⁴⁶ However, such a search will not reveal possible infringement of an unregistered mark. TM Headstart⁴⁷ is a service offered by IP Australia that provides an online check of the likelihood of registrability of a mark.⁴⁸ The online assessment at present costs \$90 and the results are available within five working days.⁴⁹ If a mark is considered unregistrable at this stage, IP Australia will provide the reasons which then allow the owner of the mark to make necessary changes.

The first step in the process of registering a trade mark is to lodge an application with the Trade Marks Office at IP Australia.⁵⁰ Only the person who 'owns' the mark may apply to register it.⁵¹ The owner of the mark is the person who first adopted the mark as a trade mark for their goods or services. It is not necessary for the owner to have actually 'invented' the mark.⁵² It is also necessary for the applicant to show that they intend to use the mark in connection with their goods or services.⁵³ Registration must be in the prescribed form.⁵⁴ Schedule 1 of the *Trade Marks Regulations 1995* (Cth) sets out thirty four classes of goods and eleven classes of services in relation to which registration may be

⁴² Section 92 *Trade Marks Act 1995* (Cth).

⁴³ *E & J Gallo Winery v Lion Nathan Australia Pty Limited* [2009] FCAFC 27, [55–56].

⁴⁴ *E & J Gallo Winery v Lion Nathan Australia Pty Limited* [2009] FCAFC 27, [61].

Editor's note: The authors have advised that after the paper was reviewed, and before it went to press, the High Court granted Gallo Wineries special leave to appeal. In *E & J Gallo Winery v Lion Nathan Australia Pty Limited* [2010] HCA 15 (19 May 2010) the High Court considered the issue of 'use' of Gallo's 'Barefoot' mark in Australia, within the context of s 17 of the *TMA*. The High Court concluded that Gallo had in fact used its mark in Australia because some of their 'Barefoot' wine was offered for sale and actually sold to consumers in Australia. The use was genuine and in good faith, and it did not matter that the number of bottles offered and actually sold was minimal, 144 and 41 respectively.

⁴⁵ *Trade Marks Regulations 1995* (Cth), reg 4(15).

⁴⁶ See: IP Australia, *The Application Process for Your Trade Mark* <http://www.ipaustralia.gov.au/trademarks/process_index.shtml>.

⁴⁷ *Ibid.*

⁴⁸ *Ibid.*

⁴⁹ *Ibid.*

⁵⁰ Intellectual Property (IP) Australia. IP Australia is a Commonwealth Government agency that administers Australia's statutory intellectual property regimes, including trade marks. It operates within the Department of Innovation, Industry, Science and Research.

⁵¹ Sections 27(1)(a) and 28 (for applications by joint owners) *Trade Marks Act 1995* (Cth).

⁵² *Shell Co of Australia Ltd v Rohm & Haas Co* (1949) 78 CLR 601, 625.

⁵³ Section 27(1) *Trade Marks Act 1995* (Cth).

⁵⁴ Section 27(2) *Trade Marks Act 1995* (Cth).

sought.⁵⁵ As noted earlier, Class 33 refers to 'Alcoholic beverages (except beer)'. It is necessary for the applicant to specify the types of goods (or services) to be protected by the mark.

Registration of a trade mark involves two stages, the examination process and the opposition stage.⁵⁶ The Registrar will first examine the application to determine whether it complies with the *TMA* and whether there are any grounds for rejecting it.⁵⁷ The grounds for rejection are set out in ss 39 to 44 of the *TMA*. These include that the mark is not capable of being represented graphically,⁵⁸ that it fails to distinguish the applicant's goods or services,⁵⁹ that the mark is scandalous or contrary to law,⁶⁰ or that it is likely to deceive or cause confusion.⁶¹ However, before a mark can be rejected, the Registrar must give the applicant an opportunity to be heard.⁶² Of particular relevance to the wine industry is the fact that the use of geographical names is now prohibited under the provisions of the *Australian Wine and Brandy Corporation Act 1980* (Cth). In consequence, trade marks bearing geographical indicators, such as 'Champagne' can no longer be registered or used.⁶³

If an application for a mark is accepted for possible registration, its acceptance will be advertised in the *Australian Official Journal of Trade Marks* and the applicant will be notified.⁶⁴ This is when the opposition stage commences. In the three months following the

date that the acceptance was advertised,⁶⁵ any person who opposes registration of the mark may file a notice of opposition with IP Australia.⁶⁶ The opponent must then show that the application should be rejected on one or more of the grounds specified for rejection, as per the *TMA*.⁶⁷ A common ground for opposition is that the applicant is not the owner of the mark.⁶⁸ The applicant must be given an opportunity to respond⁶⁹ and the Registrar will then decide whether to register the mark or to refuse registration.⁷⁰

Upon registration, the Registrar records the applicant's name, the goods and/or services concerned and the conditions, if any, in the Trade Marks register.⁷¹ Registration lasts for ten years from the date of filing of the application.⁷² The owner of the mark may request a renewal for a further ten years before expiry of the initial period of protection,⁷³ and such requests can be repeated for as long as the owner has a genuine use for the mark. An owner's failure to request a renewal within six months of an expiration date will, however, result in the mark being removed from the register.⁷⁴ As discussed in *Gallo* above, trade marks may also be removed from the register on the grounds of non-use of the mark in Australia. The statutory period of non-use is three years.⁷⁵

Remedies for Infringement

Infringement of a trade mark may occur by use of a sign that is substantially identical or deceptively similar to

⁵⁵ Trade Marks Regulations 1995 (Cth) sch 1.

⁵⁶ See: IP Australia, *A Guide to Trade Mark Oppositions for Trade Mark Applicants* <http://www.ipaustralia.gov.au/resources/forms_trademarks.shtml#tm_oppositions>.

⁵⁷ Section 31 *Trade Marks Act 1995* (Cth).

⁵⁸ Section 40 *Trade Marks Act 1995* (Cth).

⁵⁹ Section 41 *Trade Marks Act 1995* (Cth).

⁶⁰ Section 42 *Trade Marks Act 1995* (Cth).

⁶¹ Section 43 *Trade Marks Act 1995* (Cth).

⁶² Section 33(4) *Trade Marks Act 1995* (Cth). Section 35 provides that appeals against the Registrar's decision may be made to the Federal Court.

⁶³ See article 'Geographical Indicators in Wine Labelling' in this edition of *Legal Issues in Business*.

⁶⁴ Section 34 *Trade Marks Act 1995* (Cth).

⁶⁵ However, due to Australia's international obligations, the time period is six months. See, for example, IP Australia, *The Trade Mark Application Kit – An Easy Guide to Applying for Your Trade Mark* <<http://www.ipaustralia.gov.au/pdfs/trademarks/kit.pdf>>.

⁶⁶ Section 52 *Trade Marks Act 1995* (Cth). The grounds for opposition can be viewed at IP Australia, above n 56.

⁶⁷ Section 52(4) *Trade Marks Act 1995* (Cth).

⁶⁸ IP Australia, above n 56.

⁶⁹ Section 54(1) *Trade Marks Act 1995* (Cth).

⁷⁰ Section 55(1) *Trade Marks Act 1995* (Cth).

⁷¹ Section 69(1) *Trade Marks Act 1995* (Cth).

⁷² Section 72 *Trade Marks Act 1995* (Cth).

⁷³ Section 77(1) *Trade Marks Act 1995* (Cth); s 72 *Trade Marks Act 1995* (Cth).

⁷⁴ Section 78 *Trade Marks Act 1995* (Cth).

⁷⁵ Section 92 *Trade Marks Act 1995* (Cth).

the owner's mark in relation to goods or services for which the mark is registered, in connection with closely related goods, or in connection with unrelated goods where the owner's interests 'are likely to be adversely affected'.⁷⁶ Remedies for infringement of a registered mark include an injunction, damages or an account of profits.⁷⁷

Conclusion

Trade marks are important business assets and the best way to protect a mark is often by registering it. Even though a fee must be paid to IP Australia upon application for registration of a mark, this fee is likely to be insignificant in relation to the benefits flowing from exclusive use of that mark. Infringement of an unregistered mark is only actionable once the mark has acquired an established reputation in the relevant market. Until such time, a competitor is able to (use and) register a similar or identical mark which will then preclude the original creator of the mark from using their mark thereafter. By way of comparison, trade marks can be registered before any goodwill attaches to the mark, which is especially important where the resources used to create the mark are high. Unlike other categories of intellectual property, the exclusive rights of the trade mark owner can operate indefinitely, provided the mark is used in the course of commerce.

⁷⁶ Section 120 *Trade Marks Act 1995* (Cth).

⁷⁷ Section 126 *Trade Marks Act 1995* (Cth).