Date Introduced: 24 August 1978
House: House of Representatives
Presented by: Hon. I. Macphee, M.P., Minister for Productivity

Short Digest of Bill

Purpose

To extend the Trade Marks Act 1955 to cover trade marks used in relation to services as well as trade marks relating to goods.

Background

Trade mark legislation at present covers only marks relating to goods, (such as the "wool mark"), and not marks used by businesses providing services, such as entertainment, repairs or insurance. This distinction existed in the early British legislation on which our present Act is based. The legislation was considered in the Union Label case in 1908 which held that the Act did not extend to a 'mark' which indicated that certain goods were made by union labour. Subsequent High Court interpretation now permits the conclusion that the Act can be extended to cover service-related marks.

British trade mark law has already been amended to extend protection to design marks. Similar protection for businesses marketing services exists in many other developed countries, including the United States, Japan, and most of Europe. Most of these countries however will not extend this protection to marks which are not protected in the country from which they originate. Australian businesses operating overseas can thus be put at a disadvantage, which would not exist if their marks were given recognition here.

Main Provisions

The substantive change is that the Act is extended to cover services as well as goods. This change is achieved by inserting, where relevant, the words "or services" after "goods" where it appears in the Act.

Clause 3 amends sub s.6(1) of the Act so that the term "trade mark" can apply to either goods or services, and the permitted use of trade marks is extended to include services.
Clause 6 amends s.23. This section covers applications for the removal of trade marks from the Register by an aggrieved person on the grounds of non-use by the proprietor.

The amendment to sub s.23(2) permits the High Court or Registrar to refuse to remove a registered trade mark relating to goods or services if the mark has been used for closely related goods or services.

The inclusion of a new sub s.(3A) will enable limitations or conditions to be laid down by the Court or the Registrar of Trade Marks concerning the effect of registration of a trade mark for services in certain cases. This provision already applies for goods.

Clause 11 amends s.33. The section, as it stands, prevents the registration of a trade mark for goods if it is substantially identical with or deceptively similar to a registered trade mark, or a trade mark whose registration is in process and will become effective earlier. The amendments enable this provision to encompass services closely related to goods, services themselves, and goods closely related to services.

Clause 14 amends s.36 so that provisions relating to associated trade marks apply to both those registered in respect of goods and those for services. A new sub s.(1A) specifically deals with trade marks for services. It lays down the same provisions which apply in the case of goods. These are, that where there are substantially identical trade marks, or ones which so nearly resemble one another as to be likely to deceive, and these are in the name of the same proprietor, then the Registrar may require that they be entered in the Register as associated trade marks.

Clause 40 amends s.107 so as to define more clearly the circumstances in which a trade mark may be deemed to be applied to goods or services without the assent of the owner. No substantial change is made.

Defence, Science & Technology Group
LEGISLATIVE RESEARCH SERVICE
6 September 1978