AUSTRALIA

Last updated: March 2014

This guide provides a basic profile of this jurisdiction’s trademark law and practice and is not intended to take the place of professional advice given with full knowledge of the specific circumstances of each case and proficiency in the law of this jurisdiction such as might be provided by a local trademark attorney.


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I. GENERAL

A. Rights Afforded by Registration

• Registration is not mandatory to establish rights to a trademark; prior use establishes right to a trademark; this is a “first to use” jurisdiction. The owner of a trademark in Australia is the first to use the mark, or the first to file an application, whichever is the earlier. In order to claim ownership based on prior use, the trademarks in question must be “substantially identical” and used for the same goods/services or “the same kind of thing,” which has been narrowly interpreted by the courts.

B. Time Frame for Obtaining Registration

• The approximate time from application to registration (for a regular prosecution, without opposition) is: seven months (if there is no third party opposition).

C. Advantages of Registration

• The advantages of registering a trademark include the following:
  • it provides prima facie evidence of ownership and validity;
  • it provides national/regional protection;
  • it allows use of “Registered Trademark” or other suitable abbreviations to demonstrate ownership of the trademark;
  • it allows access to bring actions in particular courts;
  • it helps to deter others from unlawfully using the trademark;
  • it provides a defense to infringement;
  • enforcement of an unregistered trademark is more difficult and more costly than enforcement of a registered trademark;
II. PRE-FILING

A. Registrable Trademarks

• The following signs that can be reproduced graphically and are capable of distinguishing the goods or services of one person or entity from another are registrable as a trademark:
  • words;
  • names (In general, a common Australia surname (i.e., a surname that occurs more than 750 times on the Australian Electoral Roll) or a commonplace name will not be considered sufficiently distinctive to qualify for registration unless evidence of use of the name is filed or the goods/services claimed are not commonplace.);
  • devices;
  • certain three-dimensional shapes (Often an application to register a three-dimensional shape encounters an objection that the mark is not capable of distinguishing the applicant's goods. The likelihood of an objection's being raised depends on the shape and the goods/services claimed.);
  • colors (A single-color mark is generally considered not capable of distinguishing, and substantial evidence of use of the mark is required to secure acceptance; but combinations of colors are generally inherently registrable.);
  • slogans (As slogan marks are generally composed of common English words, a distinctiveness objection can be encountered on occasion.);
  • sounds;
  • smells (olfactory trademarks);
  • trade dress/get-up;
  • holograms;
  • motion;
  • taste;
  • touch.

For general information about non-traditional marks, see:

Topic Portal: http://www.inta.org/Advocacy/Pages/NontraditionalMarks.aspx

Fact Sheet: http://www.inta.org/TrademarkBasics/FactSheets/Pages/NontraditionalTrademarksFactSheet.aspx

For information about protecting trade dress, see:
http://www.inta.org/TradeDress/Pages/TradeDress.aspx

• The special requirements for the registration of three-dimensional shapes are: An application claiming a shape as a trademark must include descriptions and representations that show each feature of the trademark sufficiently clearly to permit proper examination of the trademark. In general, representations of the shape mark should be in the form of perspective or isometric drawings that show clearly all the features of the trademark (usually top, bottom and side views are required). The parts of the configuration claimed to constitute the trademark should be shown in solid lines, while the unclaimed parts, if any, should be shown in broken lines. The drawings, views and/or photographs of the trademark must also be accompanied by a written
description of the trademark. The description and pictorial representation of a shape trademark should together clearly define all the details that constitute the trademark.

• The special requirements for the registration of colors are:

  • An application for a color or colors as a trademark must include a clear and concise description of the trademark as an endorsement to the application.

  • A pictorial representation showing the color claimed and the manner in which it is to be applied to the goods or packaging should also be supplied, especially in cases where the description is complex.

  • An example of the actual color or color combination claimed must be supplied in all cases.

  • If the applicant chooses to define the color/s more precisely by the use of a recognised color matching system (e.g., Pantone color), this reference may be included in the descriptive endorsement. Increasingly the Office is preferring color identification systems, as these can provide more long-lasting clarity as to the colors claimed for protection. Nevertheless, a color matching system is not essential. If no color matching system reference is provided, it will be necessary to provide an example of the color and ensure that the accompanying description refers to the representation as attached to the application form.

• The special requirements for the registration of sounds are:

  • An application for a sound as a trademark must include a graphical representation of the mark. This may be a simple verbal description of the sounds such as "CLIP CLOP MOO."

  • Musical notation is acceptable as a graphical representation of a sound mark consisting of a musical piece. However, a lengthy piece of musical notation such as the complete score of an orchestral or piano piece is unlikely to meet registrability requirements.

  • The name of a specific piece of music is not acceptable as a graphical representation unless additional information is supplied to identify the particular rendition claimed as a trademark. In general, the musical notation of the specific piece would be more appropriate than just its name.

  • As well as the graphical representation, the applicant must supply a clear and concise description of the trademark, which will be entered as an endorsement to the application.

  • The applicant must supply recordings of the trademark on a medium that allows for easy replaying. Currently, the most common media are CDs, DVDs and MP3 recordings.

• The special requirements for the registration of smells are:

  • The application must include a graphical representation of the scent mark. This could be by way of a verbal description of the scent, such as "the scent of pine." The description must include both what the scent is and how it is to be used in respect of the goods or services claimed.

  • The graphical representation must be in a form that conveys information to the
ordinary person allowing him or her to identify the trademark. Highly technical data will not be acceptable as a graphical representation. For example, the results of analytical techniques such as infrared spectroscopy; vacuum, fractional and molecular distillation; nuclear magnetic resonance; vacuum fractionation; or "electronic nose" analysis and chromatographic techniques would not be acceptable.

• An actual sample of the scent is not required at filing but may be needed during the course of examination.

• The special requirements for the registration of trade dress are: The application must include an accurate description of the mark noting all of the elements comprising the trade dress and should, where appropriate, identify the trademark as being an aspect of packaging.

• The special requirements for the registration of holograms are: The applicant must provide clear representations that show all the features of the trademark. The application must be accompanied by a description of the trademark that likewise clearly describes all the features of the trademark. A copy of the actual trademark must also be provided.

• The special requirements for the registration of motion are: The applicant must provide clear representations that show all the features of the trademark. The application must be accompanied by a description of the trademark that likewise clearly describes all the features of the trademark. A copy of the actual trademark, as a video clip for example, must also be provided.

• The special requirements for the registration of taste are: While “taste” arguably falls within the definition of a sign, IP Australia considers that it is difficult to determine how a taste or flavor could serve to distinguish an applicant’s goods. Often it may not be practical (or hygienic) for a customer to taste goods prior to selection and purchase. Tasting the goods after purchase does not seem to meet the requirements of denoting a trade source.

It is also common for flavors to be used to mask an unpleasant taste, as, for example, cherry or strawberry flavoring for children’s pain-relieving syrups and other medicines. The flavors in these cases have a functional purpose, and are thus not adapted to distinguish.

If an applicant were to apply for a taste trademark, the application would require the same kind of description as is expected for scent trademarks. The taste would need to be described in words that make it clear exactly what the flavor is. It would also need to be clear from the description how the taste was to be used in respect of the goods claimed.

• The special requirements for the registration of touch are: Feel or "texture" falls into the definition of a sign, and it is thus possible that an applicant could be successful in an application for a texture as a trademark. The usual tests apply as they do for any other kind of trademark. The applicant needs to provide an appropriate representation and description.

• In addition to regular trademark registrations, the following types of trademarks are registrable:
  • collective marks;
  • certification marks;
  • well-known marks;
  • service marks.
• Retail services are registrable provided that the nature of the retail services is clearly identified.

• The following are not registrable as trademarks:
  • marks contrary to moral standards or public order;
  • generic terms (These are registrable in theory provided the applicant can submit sufficient evidence of exclusive use of the mark in Australia prior to the filing date of the application to establish that the mark did in fact distinguish the applicant's goods or services at the time of filing the application.);
  • names, flags or symbols of states, nations, regions, or of international organizations;
  • non-distinctive trademarks absent a showing of acquired distinctiveness (secondary meaning);
  • marks that function principally as surnames (These are registrable provided evidence of use is filed demonstrating that the mark is distinctive or capable of becoming distinctive.);
  • marks that function principally as geographic location names (but not Geographic Indications or Appellations of Origin) (These are registrable provided evidence of use is filed demonstrating that the mark is distinctive or capable of becoming distinctive.).

• Geographical indications (GIs) are protected in this jurisdiction.
• GIs are protected by way of:
  • special laws for the protection of geographical indications or appellations of origin;
  • trademark laws in the form of collective marks or certification marks;
  • laws against unfair competition;
  • consumer protection laws;
  • specific laws or decrees that recognize individual geographical indications.

• The following products or categories are subject to GI protection in this jurisdiction: The Wine Australia Corporation Act 1980 provides specific protection for GIs in the area of wines and grape products such as brandy, grappa and fortified wines. Existing certification marks protect GIs in other areas (e.g., cheese).

B. Searching
• While conducting a private pre-filing search is not mandatory, it is recommended in that it can:
  • save the applicant the time, effort and cost entailed in developing, adopting and applying to register a trademark in which someone else has prior rights;
  • disclose additional potentially conflicting trademarks, e.g., prior unregistered rights such as those gained at common law.

• The national office is accessible online at the following URL: www.ipaustralia.gov.au.
• The official register can be searched online.

C. Use
• An applicant benefits from pre-filing use of a trademark. The owner of a trademark is the first to use a mark or the first to apply for registration, in Australia, whichever is earlier. Furthermore, common law rights are acquired through use of a mark.
• The benefits of pre-filing use are:
• Use may demonstrate acquired distinctiveness (secondary meaning) and help to overcome an objection to an application to register the trademark on the grounds of non-distinctiveness. A mark that has been used before filing may be registrable in the face of an earlier-filed application for an unused mark, and may even prevent the registration of such an unused mark.

• When a mark is not registered, use of that mark may provide the following benefits:
  • Courts may protect unregistered trademarks in some exceptional cases. The owner of an unregistered mark that has acquired a reputation in that mark may take action against the unauthorized use of a similar mark under the Schedule 2 of the Competition and Consumer Act 2010 (Cth) and/or for passing off.
  • Special protection against infringement may be available for a well-known trademark that is not registered. The owner of an unregistered mark that has acquired a reputation in Australia as a result of use of that mark overseas may take action against the unauthorized use of a similar mark under Schedule 2 of the Competition and Consumer Act 2010 (Cth) and/or for passing off.
  • Protection against infringement may be available for trademarks with substantial and longstanding use that are not registered. A defense to infringement of a registered trademark is available if the owner of the unregistered mark can establish that they would be entitled to registration in their own name if they were to apply for registration of their mark (e.g., on the basis of honest concurrent use or prior continuous use).

D. International Treaties

• Australia is a member of the following international treaties relating to intellectual property:
  • Paris Convention;
  • Trademark Law Treaty;
  • Singapore Treaty;
  • Madrid Protocol;
  • Nice Agreement.

III. FILING

A. Requirements

• If the applicant is not domiciled in this jurisdiction, a local address for service must be provided.
• Joint applicants are permitted in this jurisdiction.
• Either actual use or intent to use is required for application.
• The following information is required to complete an application:
  • name and address of the applicant;
  • description of trademark (generally required only in the case of a non-traditional mark);
  • representation of trademark (a depiction of the mark an applicant seeks to register);
  • list of goods/services.
While ALL of the items noted in the list immediately above are required to COMPLETE an application, ONLY THE FOLLOWING ITEMS from that list are required in order to SECURE A FILING DATE:

- name and address of the applicant;
- representation of trademark (a depiction of the mark an applicant seeks to register);
- list of goods/services.

The list of goods and services in this jurisdiction may specify:

- the relevant Class heading (However, there is case law to the effect that a class heading does not include all goods/services in a class (e.g., computer software has been held not to be covered by the Class 9 heading). Any specific goods/services of interest should be listed in an application if not clearly encompassed by the class heading.);
- a list of the common commercial names for the specific goods or services of interest;
- the relevant entire (long) alphabetic class listing (It is likely that IP Australia would accept such a specification, but the application could be opposed by a third party on the basis that the applicant has no intention to use the mark in respect of all items claimed. Claiming the entire alphabetic class listing is not recommended.).

The following number of specimens of the trademark must be submitted: For color marks, six color representations are required.

Although not a filing requirement, a power of attorney might need to be submitted during prosecution in the following circumstances:

- none. A power of attorney is not required in any circumstances.

In this jurisdiction, the following type of registration is available:

- national;
- international.

This jurisdiction is a party to the Madrid Protocol but not the Madrid Agreement and may be designated in international applications.

An international application is subject to the same registrability requirements and examination procedure as a locally filed application. (See the entry for the Madrid Agreement and Protocol.)

Applications can be filed online at the following URL: at www.ipaustralia.gov.au provided that a local address for service is provided.

The official file cannot be accessed online.

Applications are officially searched as to prior trademarks.

B. Priority

If an applicant’s home country is a member of the Paris Convention, the filing date of its home application can be claimed as the filing date in this jurisdiction, provided that its home application was filed within the fixed period of six months preceding the application in this jurisdiction.

If an applicant’s home country is a member of the World Trade Organization, it should be possible to claim the home filing date. (Consult a local trademark attorney.)

An International registration can be based on a national application or registration in this jurisdiction.
C. Classification

• This jurisdiction uses the Nice Classification System.
• If a trademark is or will be used in more than one class of goods and/or services, one application can cover multiple classes of goods or multiple classes of services but separate applications are also permitted.
• For a multi-class application, the applicant must pay class fees on a per-class basis.

D. Representation

• An application to register a trademark may be filed directly in this jurisdiction by:
  • the applicant, even if not a citizen of or domiciled in the jurisdiction (provided that the applicant has an address for service in the jurisdiction (e.g., the address of a distributor));
  • the applicant, but only if a citizen of or domiciled in the jurisdiction;
  • a trademark representative/attorney/agent, even if not a citizen of or domiciled the jurisdiction (provided that the representative/agent/attorney has an address for service in the jurisdiction);
  • a trademark representative/attorney/agent, but only if a citizen of or domiciled in the jurisdiction.

IV. APPLICATION

A. Publication

• The filing particulars of an application are made available to the public.
• The filing particulars are made available:
  • through publication and online.
• The following application details are made available to the public:
  • mark;
  • name of applicant;
  • address of applicant;
  • state or country of incorporation of applicant;
  • application number;
  • application date;
  • goods/services;
  • priority claim information;
  • representation of trademark.

B. Examination

• Applications are examined in respect of:
  • formalities: i.e., for compliance with the filing requirements;
  • classification: i.e., to ensure that the goods or services fall within the class(es) listed in the application;
  • clarity: i.e., that descriptions are clear, and are understandable;
  • descriptiveness: i.e., to check whether a trademark functions solely to provide information about the goods and services affiliated with the trademark;
• distinctiveness: i.e., to ensure that trademarks are capable of being represented graphically and of distinguishing goods or services of one individual or organization from those of other individuals or organizations;
• deceptiveness: i.e., to check whether a trademark of such a nature as to deceive the public (for instance as to the nature, quality or geographic origins of the goods or services);
• conflict with an earlier registration, prior filed application or earlier unregistered rights resulting from an official search.

• If the local trademark authority issues a preliminary refusal to register a mark based on an earlier registration owned by another:
  • The existence of a valid coexistence agreement between the applicant and cited registrant may be accepted as evidence permitting registration of the application; its acceptance is at the discretion of the trademark authority. Whether or not a coexistence agreement is accepted by the Trade Marks Office will depend on the terms of the agreement. An agreement will not be acceptable if it there are any conditions or limitations on the terms of use or registration of the applicant's trademark for the goods/services that are the subject of the application. Accordingly, most coexistence agreements are not acceptable.
  • This jurisdiction does not have disclaimer practice (i.e., a practice whereby the applicant must disclaim any exclusive right to an element of a trademark that is not distinctive). The Office cannot require an applicant to enter a disclaimer, but an applicant may voluntarily enter a disclaimer. Usually this would be the result of an opposition or other negotiation with a third party. Voluntarily entering a disclaimer will not affect the inherent registrability of the mark.

• The order of the application process is as follows:
  • Examination, publication, registration.

C. Prosecution

• Accelerated examination may be requested. A declaration must be provided outlining the reasons expedited examination is required. If accelerated examination is requested, the application will be examined within four weeks of the request. Examination of applications claiming convention priority is automatically accelerated.
• A reason for acceleration is required. The following are considered acceptable reasons: there is a risk of infringement, the applicant has already invested in the manufacture and/or advertisement of goods/services bearing the mark, or other good reason.
• A fee for acceleration is not required.
• The following rights are established by a pending application:
  • the filing date of the application establishes a home filing date for purposes of priority;
  • the filing date of the application establishes a constructive date of first use for an intent to use application;
  • the pending application can be cited in official examination against a subsequent (later filed) conflicting application;
  • the pending application can be used in a third party opposition proceeding against a subsequent (later filed) conflicting application;
  • the pending application establishes a prima facie proof of ownership of a trademark (although an application may be opposed on the basis of a prior use of the mark by another trader).
D. Opposition

- An application can be opposed.
- The following can be grounds for opposition:
  - proprietary rights, such as an earlier conflicting registration;
  - the mark is descriptive, i.e., it consists of a sign or indication that may serve in trade to designate the kind, quality, quantity, intended purpose or value of goods or of rendering of services or other characteristics of goods or services;
  - the mark is not distinctive;
  - the mark is misleading, deceptive or disparaging;
  - the mark is functional;
  - breach of copyright;
  - rights under Article 6 bis of the Paris Convention (notorious or well-known mark);
  - rights under Article 6 ter of the Paris Convention (protection of armorial bearings, flags and other State emblems);
  - the mark is generic, i.e., the mark consists exclusively of signs or indications that have become customary in the current language or in the bona fide and established practices of the trade;
  - the mark consists of a geographical indication;
  - the mark is against public policy or principles of morality, i.e., scandalous;
  - use of the mark would be contrary to law (including breach of registered design rights).
- An application is published for opposition purposes after formal examination of the application.
- The opposition period begins on the following date: date of publication in the Official Journal of Trade Marks.
- The opposition period ends on the following date: two months from the date of publication.
- Anyone may oppose an application.
- Oppositions can be filed online using eServices at www.ipaustralia.gov.au.

E. Proof of Use

- Proof of use is not required prior to the issuance of a registration or the issuance of a notice of allowance/acceptance.

V. ASSIGNMENT AND LICENSING OF AN APPLICATION

A. Assignment

- An application can be assigned.
- An assignment of an application can be made for a portion of the territory covered by the application.
- An assignment of an application can be for some or all of the goods or services listed in the application.
- Goodwill must be included in an assignment of an application. An assignment must include the goodwill in the mark itself, but need not include the goodwill of the business
(the physical assets). Assignments with the goodwill of the business may give rise to difficulties in some circumstances, as stamp duty may be payable.

- A written assignment for an application requires:
  - name of the assignor;
  - address of the assignor;
  - name of the assignee;
  - address of the assignee;
  - details of the trademark being assigned;
  - the goods and services being assigned;
  - the territory being assigned;
  - the effective date of the assignment;
  - signature by the assignor;
  - consideration (either actual or nominal).

- Legal verification of a written assignment document is required by: signature on behalf of the assignor in accordance with its laws of incorporation.

- An assignment of an application need not be recorded to be effective.

**B. Licensing**

- An application can be licensed.
- A license of an application can be made for a portion of the territory covered by the application.
- A license of an application can be for some of the goods or services listed in the application.
- A license of an application can be exclusive (only one licensee, with the owner excluded).
- A license of an application can be sole (only one licensee and the owner).
- A license of an application can be non-exclusive (multiple licensees and the owner).
- Use, by a related company, of a mark that is the subject of an application need not be licensed. If the trademark owner exercises financial control over the related company, any use of the mark by the related company is deemed to be authorized use. If there is no financial control or quality control by the trademark owner over the related company, use of the mark should be licensed.
- A license of an application can be made with a time limitation.
- A license document for an application requires:
  - the name of the licensor;
  - the address of the licensor;
  - the name of the licensee;
  - the address of the licensee;
  - details of the trademark to be licensed;
  - the goods and services being licensed;
  - the commencement date of the license;
  - the term of the license;
  - the territory of the license;
  - the goods/services being licensed;
• quality control provisions;
• signature by the licensor;
• signature by the licensee;
• express permission to sublicense, if appropriate.

• Legal verification of a written license agreement is required by: Legal verification need only be executed by the parties in accordance with their laws of incorporation.

• A license of an application need not be recorded to be effective. Technically, the recordal of a license is not possible. However, a licensee can record a claim to a right or interest in a trademark, which trademark is the subject of a registration of application, arising from the license by making a joint application with the owner of the mark.

VI. REGISTRATION

A. Requirements

• A fee is required for issuance of the registration.
• The following documentation is required for issuance of the registration:
  • none.

B. Rights

• The following rights are established by registration:
  • the exclusive right to use the registered trademark;
  • the right to oppose subsequent conflicting applications;
  • the right to bring a cancellation action against a subsequent conflicting registration;
  • the right to sue for infringement against confusingly similar third party trademark use;
  • the right to license other third parties to use the trademark;
  • the right to apply for seizure by customs authorities for importation of counterfeit goods;
  • the right to obtain damages for infringement.
• A trademark becomes incontestable, that is, the validity of the registration cannot be challenged, after the following time period:
  • never.
• The territorial limit of registration is: Australia (including Christmas Island, the Cocos (Keeling) Islands and Norfolk Island).

C. Term

• The initial term of a registration is:
  • ten years.
• The beginning of the term of a registration is calculated from the:
  • application date.

D. Marking Requirements
• Marking is not compulsory for registered trademarks, but is advisable because: it places third parties on notice of registered rights or that the owner claims trademark rights in a mark (whether registered or unregistered).
• Any marking should be in the form(s) mentioned below. Please consult with your local attorney in case of doubt.
  • TM;
  • ® (The registered symbol should be used only if the mark is registered in Australia or, if the mark is not registered there, if the packaging or other use makes it clear that the trademark is only registered overseas).
  • use of a legend (e.g., *ABC is the registered trade mark of XYZ).
• The use of ® is legally recognized.

VII. ASSIGNMENT AND LICENSING OF A REGISTRATION

A. Assignment

• A registration can be assigned.
• An assignment of a registration can be made for a portion of the territory covered by the registration. However, there is a risk that the registered trademark may become vulnerable to cancellation if it ceases to be distinctive of any one trader due to use by different entities in different parts of Australia. Use should therefore only be localized.
• An assignment of a registration can be for some or all of the goods or services listed in the registration. However, a registered trademark may become vulnerable to cancellation if it ceases to be distinctive of any one trader due to different entities using the same mark for similar goods or closely related services.
• Goodwill need not be included in an assignment of a registration. As assignment can be without the goodwill in the trademark or without the goodwill in the business, e.g., the physical assets. Assignments with the goodwill of the business may give rise to difficulties in some circumstances as stamp duty may be payable.
• An assignment document for a registration requires:
  • the name of the assignor;
  • the address of the assignor;
  • the name of the assignee;
  • the address of the assignee;
  • details of the trademark being assigned;
  • the goods and services being assigned;
  • the territory being assigned;
  • the effective date of the assignment;
  • signature by the assignor;
  • consideration (either actual or nominal).
• Legal verification of a written assignment document is required by: The document need only be executed by the assignor in accordance with its laws of incorporation.
• An assignment of a registration need not be recorded to be effective.

B. Licensing

• A registration can be licensed.
• In this jurisdiction registered trademark users cannot be recorded. However, a joint application can be made by a trademark owner and user to record the trademark user's claim to a right or interest in the trademark.
• A license of a registration can be made for a portion of the territory covered by the registration.
• A license of a registration can be for all or some of the goods or services listed in the registration.
• A license of a registration can be exclusive (only one licensee with the owner excluded).
• A license of a registration can be sole (only one licensee, and the owner).
• A license of a registration can be non-exclusive (multiple licensees and the owner).
• Use, by a related company, of a registered mark need not be licensed. If the trademark owner exercises financial control over the related company, any use of the mark by the related company is deemed to be authorized use. If there is no financial control or quality control by the trademark owner over the related company, use of the mark should be licensed.
• A license of a registration can be made with or without a time limitation.
• A license document for a registration requires:
  • the name of the licensor;
  • the address of the licensor;
  • the name of the licensee;
  • the address of the licensee;
  • details of the trademark to be licensed;
  • the goods and services being licensed;
  • the commencement date of the license;
  • the term of the license;
  • without limitation of time;
  • the territory of the license;
  • quality control provisions;
  • simple signature by the licensor (see below for execution requirements);
  • simple signature by the licensee (see below for execution requirements).
• Legal verification of a written license agreement is required by: The parties need only execute the license in accordance with their laws of incorporation.
• A license of a registration need not be recorded, but could help in enforcement, to demonstrate use of the mark.
• The license for a renewed registration need not be re-recorded.

VIII. POST-REGISTRATION

A. Use Requirements

• Attack on the ground of non-use is available.
• To avoid being attacked on the ground of non-use, a trademark must be used within the following period of time: three years. However, an application for cancellation for non-use cannot be lodged until five years have elapsed from the “date of registration” (deemed to be the date of application for registration).
To satisfy the use requirement, the amount of use:
- can be minimal. A single sale during the relevant three-year period can be sufficient to defeat a non-use application, but it must be genuine commercial use.

Use of the trademark must occur in:
- this jurisdiction. However, the Registrar has a discretion not to remove a registered mark even where no use is proved. In the case of a well-known mark not used in Australia but with "spill-over" reputation in Australia, the Registrar may exercise that discretion.

The consequences of a trademark’s not being used are as follows: The registration is vulnerable to attack for non-use and/or another trader may use a deceptively similar mark without fear of commercial conflict.

Periodic statements of use or other mandatory filings by the trademark owner setting forth use of the trademark are not required.

An action for non-use of a trademark can be brought by:
- any interested third party.

Non-use can be excused under the following circumstances:
- import restrictions;
- other government policies.

Resumption of use of a trademark prior to the filing of an action to revoke or cancel that trademark may cure non-use if preparation for the resumption of use began before the registrant was aware that an action had been or was about to be filed.

Use of a registered trademark in a modified form would not affect the enforceability of a registration and is allowed if the difference is slight and provided that the modification does not materially alter the distinctive character of the trademark. A local trademark attorney should be consulted.

Amendment of a registration to conform to a modified form is possible. Consult a local trademark attorney. Amendment is permitted only provided that the amendment does not substantially affect the identity of the trademark as initially filed.

B. Cancellation

Cancellation is available against registrations.

The following can be grounds for cancellation:
- proprietary rights, such as an earlier conflicting registration;
- the mark is descriptive, i.e., it consists of a sign or indication that may serve in trade to designate the kind, quality, quantity, intended purpose or value of goods or of rendering of services or other characteristics of goods or services;
- the mark is not distinctive;
- the mark is misleading, deceptive or disparaging;
- the mark is functional;
- breach of copyright;
- rights under Article 6 bis of the Paris Convention (notorious or well-known mark);
- rights under Article 6 ter of the Paris Convention (protection of armorial bearings, flags and other State emblems);
- the mark is generic, i.e., the mark consists exclusively of signs or indications that have become customary in the current language or in the bona fide and established practices of the trade;
• the mark consists of a geographical indication;
• the mark is against public policy or principles of morality;
• the mark is contrary to law (including breach of registered design rights).
• See Section V.G. Use Requirements.
• There is no deadline for bringing a cancellation action; a cancellation action can be brought at any time.
• The following parties may bring a cancellation action:
  • An application for cancellation may be made by an "aggrieved person" (or by the Registrar if it is in the public interest).
• Cancellation actions cannot be filed online.

C. Renewal

• The following documentation is required for renewal:
  • none.
• The first renewal date of a registration is:
  • 10 years from the application filing date.
• Subsequent renewals last for the following period of time:
  • 10 years from the renewal date of the registration.
• The renewal pre-payment period is:
  • no more than the following number of months before the renewal date: 12 months.
• There is a grace period for renewing registrations once the renewal date has expired.
• The grace period after the renewal date has expired is:
  • six months.
• The penalty for late renewal is:
  • a fine. A late fee is payable for each month or part thereof after the renewal period.
• Renewal can be effected online at the following URL: www.ipaustralia.gov.au.

IX. DOMAIN NAMES

• A domain name may be protected as a trademark only if the domain name is not merely a Web address but is used or intended to be used in connection with goods or services. Domain names also may be registered as trademarks if they meet the usual registrability requirements.
• The following approved registrars can register a domain name in this jurisdiction: A list of approved Registrars is available at https://www.auda.org.au/industry-information/registrars/.
• Availability of domain names in this jurisdiction can be searched through the following website(s): Numerous websites exist (see websites of the Registrars referred to above).
• The Country Code Top-Level Domain (ccTLD) for this jurisdiction is: "au."
• To obtain a domain name under the ccTLD in this jurisdiction, the following is required:
  • To be eligible for a com.au domain name, registrants must be one or more of the following:
    • an Australian registered company; or
• trading under a registered business name in any Australian State or Territory; or
• an Australian partnership or sole trader; or
• a foreign company licensed to trade in Australia; or
• an owner of an Australian Registered Trade Mark; or
• an applicant for an Australian Registered Trade Mark; or
• an association incorporated in any Australian State or Territory; or
• an Australian commercial statutory body.

The domain names in the com.au space must either: (a) exactly match, or be an acronym or abbreviation of, the registrant’s company or trading name, organization or association name or trademark; or (b) be otherwise closely and substantially connected to the registrant.

• Domain name registrations can be assigned.
• Domain name registrations can be licensed.
• A domain name registration may be contested in this jurisdiction through the following mechanisms:
  • a Uniform Domain-Name Dispute-Resolution Policy (UDRP) proceeding, filed through the following locally approved domain-dispute resolution service provider (s) in the jurisdiction: auDA.
  • the following other mechanisms, whether local dispute resolution mechanism or otherwise: by filing a court action for trademark infringement and/or breaches of the Australian Consumer Laws.
• If a registration lapses due to failure to renew, it can be revived or restored in the following way: There is usually a grace period for late renewal. The length of the grace period will depend on the Registrar.
• The application to register a domain name as a trademark will be examined for conflicts with prior trademarks.
• An earlier-filed domain name registration will create an obstacle to a later-filed trademark registration application filed by another only if the domain name is being used as a trademark in addition to being used as an address, the domain name holder objects to use and registration of the trademark, and the domain name is used in relation to similar goods/services.
• In general, the courts apply the same principles for domain name disputes as are applied for trademark disputes.
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