



ADVISORY COUNCIL ON INTELLECTUAL PROPERTY

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## **THE PROTECTION OF NATIONAL ICONS**

A report to the Parliamentary Secretary to the  
Minister for Industry, Tourism and Resources,  
the Hon Warren Entsch MP

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**December 2002**

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## **1 Background**

1.1 The Parliamentary Secretary to the Minister for Industry, Tourism and Resources, the Hon Warren Entsch MP, asked the Advisory Council on Intellectual Property (ACIP) to examine the mechanisms available for the protection of what may be regarded as national icons. Mr Entsch noted that a number of issues related to the protection of national icons had come before the government in recent times. Consequently he considered there was an immediate need to have this issue examined in some detail so that the government could, if appropriate, develop a comprehensive and co-ordinated approach to the issues involved.

1.2 Mr Entsch also asked ACIP to provide an opinion on whether a particular system may be feasible and worth pursuing and if such a system appeared possible, Mr Entsch asked the Council to develop some broad guidelines on how it may operate.

1.3 There are currently a number of mechanisms in intellectual property, corporations statutes and the common law, varying in their suitability for the task, that could be used or adapted for use to protect some icons in particular ways. However, a system of legislative amendment of the existing law would not provide a comprehensive system of protection. There are several existing examples of legislation specifically designed to protect particular symbols and words. Both the more general currently available mechanisms and the specific legislation are discussed in some detail at attachment 1. Also there are some possible changes to current general laws that could be useful in an icon protection scheme.

1.4 The current forms of protection for national icons would not, in all cases, be able to meet the very broad range of concerns that have been expressed in representations to government. For example, in the lead up to Australia Day 2002, the Department of the Prime Minister and Cabinet (PM&C) found that the Commonwealth Government was unable to prevent what may be considered as the inappropriate use of the tune of the national anthem (*Advance Australia Fair*) in a television promotion of lamb. The tune was used with substituted words concerning the positive attributes of lamb (attachment 2) and provoked a strong and adverse public reaction. Due to negative public reaction, the advertisement was taken off-air but was then replaced with what may be considered an equally inappropriate revised version which was, again, based around the tune of the national anthem.

1.5 Although PM&C was advised that the Commonwealth probably owns copyright in the words and tune of the national anthem they were also advised that this is not sufficient to enable the government to control its use. Although it might be expected that the risk of negative public reaction and the prospect of bearing the brunt of public opprobrium would act as a disincentive to the use of this sort of publicity campaign, these factors were clearly not a satisfactory deterrent in this case.

1.6 In relation to the use of the national anthem, PM&C have stated in a letter to ACIP that:

*The Commonwealth actively promotes the use by the community of the National Anthem including by commercial organisations where the National Anthem is used as an expression of national pride in the form intended with respect and dignity and is not demeaned.*

PM&C also advises that similar issues arise from time to time around the use of the Australian national flag, eg, in the branding of products in campaigns such as *Buy Australian Made*.

1.7 Another example is that the name *Waltzing Matilda* has been the subject of a recent Federal Court case<sup>1</sup> in which the Winton Shire Council was partially successful in challenging the registration of the words *Waltzing Matilda* as a trade mark for use in relation to a range of food products and a chain of restaurants. This issue of whether the words *Waltzing Matilda* and similar national icons should be able to be registered as a trade mark was the subject of much debate in the media after the decision was handed down on 20 March this year.

1.8 Winton Shire Council has made, on several occasions, vigorous representations to the government that the words, because of their importance to Australian cultural heritage, should be kept free for use by any person, including in relation to commercial enterprises. The council considers that appropriation of the words for commercial use by a limited number of people, eg, through the development of trade marks, should not be allowed. The case itself did not involve the question of whether the words should be free for use by all as it was not a relevant issue in the case. The court has found that Winton Shire, because of its prior use of the words as a trade mark, has priority of ownership of the words as a registered trade mark for some of the services at issue. The defendant in the action has retained her right to register the words *Waltzing Matilda* as a trade mark for many other goods and services. An appeal to that decision was heard on 11 November 2002 before the Full Federal Court (Queensland Registry) which is likely to hand down its decision early in 2003.<sup>2</sup>

1.9 The controversy over the use of the *Bradman* name is also well-known and resulted in government action to protect the name. That controversy resulted from the re-naming of part of a road in Adelaide as Bradman Avenue in recognition of Sir Donald Bradman's achievements. When businesses located on the re-named road started to use the *Bradman* name in relation to their businesses this caused great public controversy as well as personal distress to Sir Donald. A partial solution was achieved by amendment of the *Corporations Regulations 2001* (the Corporations Regulations) so that no company name can be registered if, in the context in which it is proposed to be used, it suggests a connection with Sir Donald Bradman that does not exist. Sir Donald granted all rights to his name, likeness and image to the Bradman Foundation, a not-for-profit charitable trust.

1.10 In this case what was required was the limitation of the commercial use of the name *Bradman* to use by those associated with Sir Donald Bradman, eg, the Bradman Foundation wished to continue to exploit the name to raise money for its activities. Although the Bradman Foundation owns several trade marks for the name *Bradman*, registration is, and effectively can only be, for particular goods and services, ie, those on which the Foundation intends to use the name. Inclusion in the Corporations Regulations gives much broader protection but would not, eg, prevent further trade mark registrations or its use as a business

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<sup>1</sup> *Winton Shire Council v Lomas* [2002] FCA 288 (20 March 2002).

<sup>2</sup> The appeal was filed by Ms Brenda Lomas (file ref Q9802).

or trading name. Similar issues have arisen in relation to commercial use of the name May Gibbs.

1.11 Other examples have included the decision of Athletics Australia in early 2002 to give the national athletics team the name *Diggers*. This led to such a public outcry that Athletics Australia issued an apology and dropped the name very soon after it was announced. The playing of the tune *The Last Post* on the occasion of the last Ansett flight from Perth to Sydney also caused offence to some and the naming of ANZAC Bridge in Sydney also caused some controversy at the time.

1.12 These examples give some indication of the variety of issues that can arise over what might be termed inappropriate use of words, names, tunes, images etc. that are so important to Australia's national heritage that they could be considered national icons. Such inappropriate use may dilute, diminish, or bring the word, name, tune or image itself, along with the reputation of any actual living or deceased persons related to it into disrepute. In some cases the disrespectful treatment of national icons, because of their close association with national history, traditions and values, provokes strong reactions of outrage, hurt and distress in the community. For example, it could be argued that the use of the word *Diggers* in relation to a sports team was not accepted by the Australian community because the use of the word, in association with sport, served to dilute or trivialise the horrendous sacrifice and loss suffered by Australian and New Zealand Defence Force personnel in the first and second world wars.

## **2. Definition of an icon**

2.1 To enable a comprehensive discussion of the issue a very broad view of what could constitute a national icon has been taken in this paper. An icon could be any tangible or intangible thing, including a word, name, sound, music, lyric, place, geographic feature, animal, colour, building, organisation etc. The development of a definition of an icon, or criteria for recognition of an icon would be a very important part of any action to protect icons. The definition or criteria could be narrow or broad depending on the ambit required as illustrated by the table comparing a range of possible icons with a range of definitions at attachment 3.

2.2 An example of a narrower type of definition is definition 1 of attachment 3 which is as follows:

*A thing<sup>3</sup> of such importance to Australian culture, or that is so inextricably linked with Australian culture, that the derogatory use of that item would cause offence to the general Australian population. Such offence would result from the negative effect of that use on Australia's national identity and pride.*

2.3 This definition imports the concepts of a close tie to Australian culture and the requirement that protection be specifically aimed at derogatory use of icons such that that use would be offensive to general population. As shown by the table at attachment 3, such a definition would be likely to encompass icons such as ANZAC and *Waltzing Matilda* but not

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<sup>3</sup> 'thing' is used in this paper as shorthand for any tangible or intangible thing, including words, names, sounds, music, lyrics, places, geographic feature, animals, colours, buildings, organisations etc.

icons such as 'Sir Donald Bradman', 'Uluru' and 'Ned Kelly.' To render this sort of definition more transparent, it is suggested that criteria would need to be developed to flesh out terms such as 'derogatory use' and 'offence'.

2.4 A wider definition such as definition 8 at attachment 3, is as follows:

*A thing which is recognised by a body of the Australian community as representing or typifying some part of valued Australian heritage, spirit, character or culture to an extent that it is now useful to be recognised and appropriately protected as a national icon.*

2.5 This definition incorporates the concept of a thing representing some valued part of Australian heritage etc such that it is useful to protect it. It is ACIP's view that this definition could encompass many more possible icons than the first and would include some of the icons excluded by the first, eg, 'Sir Donald Bradman,' 'Uluru' and 'Ned Kelly.' Criteria that would need to be developed to support this type of definition may include guidance on what terms such as 'valued' and 'useful' may incorporate.

2.6 If any of options 1, 3, 4 or 5 discussed in Section 3 were to be implemented ACIP considers that the definition of an icon would be a central element of any legislation underpinning an icons system. ACIP recommends that any definition and/or criteria should be developed with the assistance of a wide-ranging public consultation process. This approach would be expected to involve many community-based organisations and would ensure a comprehensive approach. Such a process would also be likely to *test* public support for the concept of national icons protection as clearly public support would be crucial to the success of any icons protection scheme.

### 3. Options for protection of national icons

Three main types of use appropriate for icons

3.1 It is clear from the above discussion of the approaches to government and from examining possible candidates for icon status that three categories of use would be required to meet the range of uses identified to government to date. These would be as follows:

1. all free to use category — where use of the icon could not be made exclusive to one person or body for any purpose, eg, no exclusive trade mark rights could accrue to the icon;
2. a category where commercial use is restricted to those with a direct connection to the icon, eg, the Sir Donald Bradman example; and
3. no commercial use or use as a trade mark of the icon, eg, ANZAC and *Digger*.

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3.2 Keeping these types of use in mind, ACIP developed and investigated six options for the protection of national icons/national symbols as follows:

1. **The 'recognition only' option** — granting of icon status with no further protection given;

2. **The 'national symbols' option** — the establishment of specific 'national symbols' legislation prohibiting the derogatory use of such symbols, eg, the national flag, the national anthem (tune and words);
3. **The 'national icons' options** — the establishment of specific 'national icons' legislation prohibiting the derogatory use of such icons;
4. **The 'amendment option'** — consisting of amendments to current legislation to give support to the protection of national icons;
5. **The 'combined national icons' option** — a combination of options 3 and 4; and
6. **The 'non-exclusive trade mark' option** — an amendment to the *Trade Marks Act 1995* (TM Act) that would allow the prohibition, by regulation, of both the registration of certain terms and the accruing of trade mark rights in common law through use, of those terms. ACIP recommends that the term *Waltzing Matilda* be listed as a non-exclusive trade mark under this provision.

3.3 ACIP proposes that if a protection scheme along the lines of options 1-6 were to go ahead, the number of icons that would meet very stringent criteria would not be large.

3.4 **Option 1** — granting icon status with no further protection — the 'recognition only' option. In a similar manner to the recognition granted to recipients of the Order of Australia, the granting of icon status would allow special recognition to be afforded things that had the requisite qualities making them candidates for national icon status. This option would have no or minimal impact on pre-existing rights and would not provide any specific rights in respect of an icon — it would be analogous to an honour.

3.5 **Option 2** — the establishment of specific 'national symbols' legislation prohibiting the derogatory use of such symbols. This legislation would be directly related to current (and any future) 'national symbols' such as the national flag and the national anthem and would provide legislative protection of such symbols from derogatory use. Such legislation would be constrained in its effect by the Constitutional freedom of political discussion, however, the object of the legislation would be simply to allow a court to order an injunction to prevent the inappropriate use of national symbols. For example, it could be used to prevent or stop the use of the tune of the national anthem being accompanied by inappropriate words in a commercial product advertisement. See paragraph 3.7 below for an indication of what 'derogatory' may mean.

3.6 **Option 3** would entail the enactment of a 'light touch,' relatively simple form of specifically designed legislation to protect 'national icons'. It is envisaged that such legislation would prohibit, within constitutional boundaries, the derogatory use of icons. The main advantages of this type of legislation would be that it would provide a general overarching protection that could be applied very flexibly to any sort of icon and would not unduly interfere with, or unreasonably detract from other rights such as intellectual property rights, that may be held concurrently with icon status.

3.7 'Derogatory use' might refer to use, eg, that would be considered to:

- cause offence to the general Australian population (eg, the use of *Digger* for an athletics team);

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- cause the icon to be lowered in the estimation of the general public (eg, the association of the icon with illicit drugs or cheap, low quality goods);
- cause a person associated with the icon to be, unfairly, lowered in the estimation of the general public (eg, an unwarranted insult to Sir Donald Bradman's memory); or
- cause a sense of injury to the feelings of national identity and pride usually generated by the icon (eg, the use of the tune of the national anthem, with inappropriate substituted words in a commercial meat promotion)

3.8 The development of criteria to be used to gauge whether a use of an icon is 'derogatory use' should be developed on the basis of wide-ranging public consultation before adoption.

3.9 This option would not provide effective protection of some types of icons, however. The most significant gap would be in the protection of icons such as *Waltzing Matilda* where, eg, the icon could be appropriated by one or more people as a traditional form of intellectual property such as a trade mark.

3.10 **Option 4** would entail amendments to a raft of Commonwealth intellectual property legislation and the State and Territory business name registration systems. The amendments would allow for specific treatment of listed icons in a range of legislative instruments to allow for their control and protection. The logistics of this sort of protection would be very complex. If amendments had to be carried out after the listing of each icon this would present a very long and very uncertain process. The government of the day may not be able or willing to give icons legislation any reasonable priority and listing and passage of all the legislative changes may therefore be many years apart. This would clearly frustrate the intention of protecting icons. Attitudes may change and legislation might lose support from opposition parties, leaving icons vulnerable to misuse even though they may have been listed.

3.11 In view of the risks of amending legislation on a case by case basis it would be more effective to develop and implement a package of legislation enabling certain protections, by way of prescription by regulation, on achievement of appropriate icon status. For example, a schedule could be implemented for section 18 of the TM Act and another in the ANZAC regulations, ready for icons listed in, eg, the 'not for commercial use' category. Some schedules already exist, such as Schedule 2 of the Trade Mark Regulations and new ones could be implemented such as a new Part 2 of Schedule 6 of the Corporations Regulations for 'company names not for commercial use' and 'company names for the exclusive use of persons or bodies having a special connection to a national icon'.

3.12 Under such a scheme the listing of an icon could trigger the prescription of the icon in one or more regulatory instruments designed to protect the icon from inappropriate use. The decision to list might also include, from a menu of pre-determined choices, the specific legislative amendments that would accompany the particular protection decided upon. This would provide a flexible method of achieving the protection appropriate to each icon.

3.13 Alternatively, a more transparent approach may be to have, for example, the three categories of icon mentioned at paragraph 3.1 above — 1) commercial use by all/no exclusive use, 2) commercial exclusive use by one or more parties having a connection with the icon, and 3) no commercial use of the icon. An icon would be listed in the appropriate categories and this would trigger a pre-determined list of regulatory amendments to support that listing.

3.14 Difficulties may arise in the case of gaining the agreement of States and Territories to amendments to business names rules and, to some extent, corporations names rules. Even though the latter is now, through referral of power by the States under section 51(xxxvii) of the Constitution, a Commonwealth responsibility, there may be some sensitivity from State and Territory governments over the use of those rules for the purposes envisaged here. The referral of this power by the State Governments is also subject to a sunset clause ending 5 years from the date of commencement of the *Corporations Act 2001* (Cth) (15 June 2006) or earlier by proclamation. Alternatively, if so decided by individual State Governments, the referral of power can be extended past 5 years.<sup>4</sup>

3.15 The control of Domain names is not a government controlled activity and would need the co-operation of auDA, the private sector organisation with responsibility for the granting of domain names in Australia.

3.16 This option, if enacted by itself would, however, inevitably leave gaps in the protection required by icons as it would not be as effective as option 3 in areas where copyright is the traditional method of protecting the type of intellectual property involved. For example, amendments of the current law would not, without stretching those concepts beyond what is reasonable, be sufficient to protect the national anthem from inappropriate use.

3.17 A combination of options 3 and 4 could be considered as option 5. **Option 5** would provide government with a very flexible and comprehensive instrument to deal with the protection of icons. As shown by the table at attachment 4 this combined option would be an effective way of protecting, eg, icons as diverse as *Waltzing Matilda* and the *national anthem*, because it allows some control of current rights in addition to providing an overarching prohibition against derogatory use.

3.18 ACIP considers, however, that this approach as well as that outlined in option 4, would be very complex to implement and, although they have the advantage of being comprehensive, the scope and seriousness of the problem so far identified would not warrant this level of legislative intervention at this time. See attachment 4 for an indication of how current law in combination with a 'derogatory use' type legislation could be used to comprehensively protect national icons.

**Option 6** is designed to deal with the specific case of *Waltzing Matilda* and any further like cases that come to government's attention. It would provide for a special status trade mark here referred to as a 'non-exclusive' trade mark. A registered trade mark is a form of private

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<sup>4</sup> Eg, *Corporations (Commonwealth Powers) Act 2001* (NSW), ss 5-7.

property and gives the owner the exclusive right, subject to any other co-existing registrations, to use and authorise others to use that trade mark on the goods and/or services for which registration is granted. A registration also gives the owner the right to relief, in the form of an injunction and/or either damages or an account of profits, for infringement of the trade mark. The customs seizure powers are also available to owners and authorised users of a registered trade mark. For an overview of trade marks generally, see section 2 of Attachment 1. It is in the trade mark area that major conflicts are arising in respect of the Waltzing Matilda name.

3.20 As discussed above, Waltzing Matilda meets even the most stringent example of possible criteria examined by ACIP for classification as a national icon. Regardless of whether any other options are adopted, ACIP recommends that, in recognition of its special status as an Australian cultural term, *Waltzing Matilda* should be declared, from the commencement date of the regulations declaring it, a 'non-exclusive' trade mark under a new section of the *Trade Marks Act 1995* (TM Act). Such a section would be somewhat similar to section 18 of the TM Act that prohibits the *registration* or *use* of a trade mark while preserving any rights in trade marks that were registered or used in good faith before the date of commencement of the regulations.<sup>5</sup>

3.21 Section 18 has the effect that no person who has not used a trade mark before declaration, or registered it, can *use* it as a trade mark. Where rights have been accrued by trade mark registration or use as a trade mark in good faith prior to that date, those rights continue unaffected.

3.22 For the proposed non-exclusive trade marks, a similar regime would be appropriate such that any rights that accrued, through registration and/or use, prior to declaration under the new section would continue to enjoy the same exclusive rights that they had prior to the declaration and would be able to take infringement action or passing off actions as appropriate. However, no person could accrue further exclusive rights to that term from the date of the declaration as a 'non-exclusive' trade mark but they would, at their own risk, be able to use the term as a trade mark to distinguish their goods from those of others. They would not, however, be able to enforce any rights in regard to such a trade mark. To ensure this option is fully effective, consideration should be given to additional amendments to the *Trade Practices Act 1974* to prevent some actions under sections 52 and 53 for misleading and deceptive conduct in the use of icons in the course of trade. This would be appropriate only in cases where the action was based on one trader objecting to the actions or representations of another on the basis that the defendant to the action was attempting to pass off their goods or services as the goods or services of the plaintiff.

3.23 The concept of a 'non-exclusive' trade mark may appear anomalous, however, the previous and current trade marks acts have both incorporated honest concurrent use provisions which allow identical or similar trade marks to be registered for goods/services of the same description.<sup>6</sup> These provisions recognise that there are circumstances where '...a

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<sup>5</sup> There is an incorrect reference in section 18 to the *Legislative Instruments Act 1995*. This act does not exist and therefore the reference will need to be deleted.

<sup>6</sup> Section 34 of the *Trade Marks Act 1955*; section 44(4) of the *Trade Marks Act 1995*.

degree of confusion ha[s] to be tolerated within the system ...<sup>7</sup> Examples would include where two people in different geographical locations independently develop similar trade marks in similar industries and trade using those trade marks without any deception or confusion arising. Such trade marks may be registered, however, the later registered mark could be subject to a limitation as to geographical area. Another example would be a situation where two traders independently develop the same trade mark in the same industry and their area of use overlaps. In this situation there may be some degree of confusion, however, if the trade marks were adopted honestly both may be registrable and no geographical limitation would be imposed.<sup>8</sup>

The two main elements of a trade mark have been identified by Mason CJ, Dawson and Gaudron JJ as being that a trade mark must have the capacity to distinguish particular goods and services and that the proprietor of the trade mark must have some connection with the goods/services.<sup>9</sup> The concept of a 'non-exclusive' trade mark would be consistent with these elements. As there would be no need to ban the registration of trade marks that had no capacity to distinguish the goods/services to which they would be applied, a 'non-exclusive' trade mark, although it could not be registered, could have the capacity to distinguish the goods/services to which it was applied and the second requirement of a connection between the trade mark and the proprietor could be met. The fact that it could be used by anyone as a trade mark would be likely to result in it being used as a trade mark by, perhaps, a wide range of people at a very low level of use but few traders would invest heavily in a trade mark over which they could not exercise exclusive control. Therefore confusion as to the trade source of goods under such trade marks would quite likely be rare as confusion usually only arises where the trade mark has developed a reputation in the market through extensive use in the particular industry. A trader is unlikely to adopt a trade mark for use in their industry where another trader has already developed a reputation under that mark or one similar to it. The risk remains, of course, that a trade mark will be used in bad faith to deceive the public as to the source of the goods/services, ie, to pass goods without a reputation off as the goods that do have a reputation. ACIP considers this risk to be low but how tolerable such a risk is would form part of the government's consideration as to whether it would take up this recommendation. It may be that actions under sections 52/53 of the Trade Practices Act should in fact remain available to deal with such cases.

#### **4. The process of granting and reviewing icon status**

4.1 With the exception of options 2 ('national symbols' legislation) and option 6 (which would require a less comprehensive system), options 1,3,4 & 5 would require some form of process to select a national icon (see attachment 5 for details). Similarly to the Honours system, ACIP suggests this would entail forming a panel of eminent Australians widely representative of Australian society to decide, with the aid of appropriate guidelines, whether a proposed icon should be recommended to the Governor-General for a grant of the status of national icon. A secretariat would be needed to assist in this process.

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<sup>7</sup> Dawson and Toohey JJ in the *Moove* case (1990) 18 IPR 385 at 416.

<sup>8</sup> Graham J in *Buler Trade Mark* (1975) 92 RPC 275.

<sup>9</sup> *Davis v Commonwealth* (1988) 166 CLR 79.

4.2 Clearly the national symbols of option 2 would be self-selected and hence no formal selection process would be required. The manner of selecting items that may warrant the status of a non-exclusive trade mark would necessarily be more ad hoc and less formal than the process outlined in attachment 5. ACIP considers that the Minister responsible for administration of the *Trade Marks Act 1995* should be responsible for listing such trade marks. It is recommended that the Minister should, where he or she considers a prima facie case has been made out for listing, form an ad hoc committee, broadly representative of the community and with some intellectual property expertise, tasked with thoroughly investigating the impacts of a proposed listing and with making a recommendation on listing to him or her. Alternatively, the Minister could refer such matters to ACIP which itself is a group with representation from small and large industry sectors and experts in intellectual property. If appropriate, community representatives could be co-opted to the ACIP to give broader representation of other community interests.

4.3 A process of review of national icons would be required to enable the removal of items no longer appropriate to the status of national icon, national symbol or non-exclusive trade mark, as the case may be.

## **5. Prior existing rights**

5.1 The issue of pre-existing rights is one of the most contentious issues in the development of a system for protecting icons. This may involve two options — extinguishing all pre-existing rights or allowing the pre-existing uses of icons to continue unaffected when icon protection is granted.

5.2 There are likely to be pre-existing rights — particularly intellectual property rights — in many potential icons. An example of this is the term *Waltzing Matilda*. There are quite a number of pre-existing trade mark registrations for the term and there may be many common law trade marks existing that consist of or contain the words *Waltzing Matilda*. Acquiring those rights would be very expensive for government, such action would be likely to be controversial and would have the capacity to disrupt existing businesses. The extinguishment of pre-existing registered rights may not require just compensation under the Constitution because such extinguishment may not be characterised as an acquisition of property. However, any arbitrary treatment of pre-existing rights would be likely to diminish public support for a system that would rely very much on public support for its effectiveness.

5.3 To be effective, extinguishing rights would also need to apply to business names (and company names). It would therefore need further cooperation from the state and territory governments. Since such a system would be a national system, the states and territories would most likely argue that any compensation should be a federal matter.

5.4 The co-existence of pre-existing rights with icons would mean that generally speaking, those who have pre-existing rights to a name that is later classified as an icon would not be prevented from using that word or image in the manner in which they used it prior to protection as an icon. This situation applies to words currently protected under the *Olympic Insignia Protection Act 1987*. For example, *Olympic* was registered for tyres many years prior to the Olympic legislation, and that legislation protects those prior rights while

granting the Australian Olympic Committee certain exclusive rights in the word *Olympic*. While appropriate to the very specific protection provided for protected olympic expressions, this option may be seen by some as not appropriately dealing with what they may view as the current misuse of icons.

5.5 In the context of trade marks rather than protected olympic expressions, it is clear that if the community was free to use icons where a pre-existing trade mark had been registered, this could effectively nullify the trade mark owner's rights. For example, one company currently has trade marks rights for the exclusive use of *Waltzing Matilda* in relation to barbecues. If other businesses, particularly those involved with barbecues or related equipment, began using the word, this could seriously dilute the value of the original trade mark. This could also lead to morally justified, but not necessarily legally enforceable, claims for compensation because, although not necessarily an acquisition of the trade mark, it would have the same effect.

5.6 ACIP considers that if any of options 1 or 3 to 6 were to be adopted:

- Pre-existing uses of icons should be quarantined from the effects of an icons system except to the extent that 'derogatory use', if it were to be introduced, would not be allowed — unless there was a specific exemption for that use; and
- Measures to guard against abuse of the icons protection system by tactics such as 'icon squatting' would need to be instituted. By 'icon squatting' ACIP refers to the possibility of a proposed icon being used in bad faith simply to accrue rights such as trade mark rights either while any legislation was being put in place or before the granting of icon status. This is similar to the 'cybersquatting' epidemic that occurred once the Internet became more widely used for commercial purposes.

## **6. Constitutional and civil liberties issues**

6.1 It appears from a superficial evaluation, that there would be constitutional authority to legislate for all of the options proposed or, at the very least, most aspects of all of those options (see attachment 6). However, ACIP considers that specific advice would need to be sought on the constitutional validity of any icons protection scheme where it was proposed to implement one or more of the proposed options.

6.2 All options would be subject to the constitutional protection of freedom of political discussion. This would have considerable impact on the extent to which icons could be protected from, eg, 'derogatory use' of an icon where that use was in the course of political discussion. Because they are symbols of government, the use of national symbols may inherently render their use part of a political discussion except in specific contexts such as purely commercial contexts. ACIP intends no curtailment of political discussion through its recommendation of the introduction of icons legislation and considers this should be made very clear in any implementing legislation.

6.3 Similar provisions to those appearing, eg, in the *Olympic Insignia Protection Act 1987*, that exempt the use of protected insignia for the purposes of review or criticism should be considered in any icons scheme. Similarly, some consideration needs to be given to

allowance for the use of national icons or symbols in satire and parody, outside of political discussion, in any scheme.

## **7 Recommended options and discussion of recommended options**

7.1 ACIP recommends that option 6 be implemented. If the government considers it appropriate to take further action to protect national icons then ACIP considers that options 1 and 2 have considerable merits that would warrant the government's further consideration.

### **7.2 Option 6 — non-exclusive trade mark (*Waltzing Matilda*)**

7.2.1 After careful consideration of a number of possible definitions against a number of possible icons, ACIP concluded that the term *Waltzing Matilda*, because of its particular significance to Australian culture, is the one item that stood out from the others as requiring some special consideration (see attachment 3). This is illustrated by the fact it was a top contender for Australian National Anthem and many still claim that it should be the national anthem. ACIP therefore recommends that a new provision should be inserted into the TM Act as suggested above at paragraph 3.20. This would, for any term listed in the regulations under the provision, prevent trade mark rights from accruing to individuals or bodies from the time such regulations commenced. ACIP also considers that amendment to the Trade Practices Act should be considered to prevent the ability of traders to take action for deceptive or misleading conduct, on the basis of the trade mark use of an icon under sections 52 and/or 53 of the Trade Practice Act. However, ACIP considers that the extensive pre-existing trade mark rights, passing off rights and rights to take action under the Trade Practices Act in the term should remain unaffected.

7.2.2 It should be noted that, because of the extensive prior claims to the use of the term *Waltzing Matilda* as a trade mark, any assistance the Waltzing Matilda Centre Limited derived from implementation of this option would be reduced as explained below. There are some longstanding registrations for the words *Waltzing Matilda* for a limited number of goods and services, including clothing, alcohol, barbeques, metal boxes and bins and cinematographic goods and services (attachment 7). It is also evident from a search of registrations that have lapsed or been removed from the Register that there is a long history of the use of *Waltzing Matilda* as a trade mark dating from 1959 which has never, as far as is known, been objected to before for cultural reasons.

7.2.3 There have also been some more recent applications which claim trade mark rights in the term *Waltzing Matilda* in respect of many goods and services. One of these was recently litigated in the Federal Court between the Winton Shire Council and Ms Brenda Lomas. Although Ms Lomas was required to delete some of the goods and the claims to services in class 42, including restaurant and take away services, for which she requested registration, she has had her right to registration of a wide range of food, agricultural, horticultural and forestry products and for advertising, business management and administration services confirmed (see attachment 7). WM Productions Pty Ltd has applied to register *Waltzing Matilda* as a trade mark for a wide range of goods and services. The Waltzing Matilda Centre has also applied for several trade marks which include the words *Waltzing Matilda* for wide ranging goods and services. The WM Productions trade marks are currently being opposed by Waltzing Matilda Centre Limited. It is clear that a close battle for trade mark rights in similar goods and services is currently being fought between Ms Lomas, WM

Productions Ltd and the Waltzing Matilda Centre Limited/Winton Shire Council in respect of *Waltzing Matilda*.

7.2.5 If government was to prohibit the accrual of exclusive trade mark rights to *Waltzing Matilda* this would not, as suggested, be likely to affect the fairly extensive rights already accrued to individuals and bodies in the term unless the Government was prepared to revoke those rights and, if required by law or public pressure, to compensate those prior owners. If the Government was not prepared to revoke the existing rights, then it would not be in the interests of the Centre to give up any trade mark registration rights they had accrued because they may themselves infringe the rights of others if they do not have registered rights of their own, although common law rights may be sufficient protection in some instances. The centre would be in the position where others may have gained trade mark rights in *Waltzing Matilda* for certain goods or services that the Centre would also like to sell or provide under the same (or similar) trade mark but would be prevented from doing so because of prior rights.

7.2.6 Even if the recommendation would not assist the current controversy, it would prevent further private trade mark rights accruing to a cultural term that should, arguably, be free for use by all.

7.2.7 In the event that use of the current applications/registrations for the words *Waltzing Matilda*, as trade marks, were to cease, proceedings could be implemented to have those unused trade marks removed from the Trade Marks Register under Part 9 of the TM Act. For example, where a trade mark was registered for a particular purpose, eg, in respect of a film, it may be that long term use of the trade mark is not envisaged. This may depend on the success of the film itself. It is clear that a trade mark based on a film such as *Crocodile Dundee* may have an extended life because of the phenomenal success of the film. In other cases, however, a film may have a limited lifespan in the mind of the public and, if not sold to another party who would actively use it, may fall into disuse after the film's release.

7.2.8 In most cases an application to remove a registered trade mark would only be available from five years after the filing date of the application to register the trade mark (sections 92(4)(b) and 93(2) TM Act). Therefore, it may be that the number of *Waltzing Matilda* registered trade marks would decline over time. However, the possibility also remains that by preventing further exclusive rights in trade marks for *Waltzing Matilda* the currently existing trade marks would increase in value and so it would be more likely that they would be sold on. A provision preventing assignments of trade marks, either registered or common law, that contain or consist of a non-exclusive trade mark would prevent the sale of such trade marks but would be a retrospective diminution of rights of the affected trade mark owners. For the same reasons that the government may not wish to extinguish all pre-existing rights in trade marks, it may not wish to extinguish this valuable right either. If the effect of the banning of further rights accruing, however, had the effect of increasing the value of a trade mark over what its value would have otherwise been, there may be a strong case to investigate, on a case-by-case basis, whether the sale of affected trade marks should be allowed.

### 7.3 Option 1 — recognition only option

7.3.1 ACIP considers that if the government wished to proceed with the protection of national icons further than the inclusion of a non-exclusive trade mark option in the TM Act (option 6), then option 1 would be a valuable way to recognise any tangible or intangible thing that has a particular role or significance in Australian culture. However, it would not grant any special rights to use or exclude others from using or gaining rights, eg, intellectual property rights, in those items in a commercial context. Nor would government be able to control any aspect of use of the thing granted icon status except to remove the status if it was no longer appropriate. The act of granting the item icon status would be valuable simply because of the recognition it would bring to the icon.

7.3.2 However, this option could be criticised because it would not prevent, eg, the sale of any commercial rights that may have existed in the icon either prior to it being granted icon status, or after such grant, to other individuals or bodies, including non-Australian individuals or bodies. For example, if *Jolly Swagman* was to be granted icon status and intellectual property rights accrued prior to or after such a grant, *Jolly Swagman* could be dealt with as the owner of those rights saw fit, including the sale of those rights to overseas bodies. This clearly would have the capacity to bring a system of protection of Australian national icons into disrepute.

### 7.4 Option 2 — protection of national symbols

7.4.1 ACIP considers that Option 2 should also be considered by government if it wished to provide further protection of the nation's pre-eminent national symbols as implementation of option 2 would allow for better protection of current and future national symbols. It is clear from the example given of the national anthem being used in a meat promotion on television that some carefully crafted further protection of national symbols could be of benefit. It is not the intention of ACIP that such protection would in any way stifle political debate or cause any self-censorship in political debate. The intention here would be merely to allow government to be able to prevent or stop instances of Australia's national symbols being used in a purely commercial way that, in the average Australian's estimation, infringes seriously the dignity of those symbols. ACIP would not wish to see such legislation used to prevent the use of national symbols, even in a way that did seriously infringe their dignity, where that use was in the course of political discussion of any sort. The Constitutional freedom of political discussion would prevent any legislation having such effect, however, any unease about the effect of the legislation on public discourse may mean that it would never gain the level of public acceptance that would enable it passage through the Parliament.

## **8 Implementation**

8.1 ACIP recognises that all the options discussed in this paper, including those it recommends for further action, directly and indirectly affect a variety of ministerial portfolios and would therefore require consideration at a whole of government level before any option could be acted upon. It is also very clear that, because of the nature of some of the options for protection being suggested, wide-ranging public consultation would be required before government could implement any of the options discussed.

## CURRENT PROTECTION (Attachment 1)

### 1.1 Current legislation granting specially designed protection

1.1.1 There are currently a small number of examples of special legislative protection of what could be termed icons. Probably the most comprehensive example is the protection of the word ANZAC under *The Protection of Word 'Anzac' Regulations* (in force under the *War Precautions Act Repeal Act 1920*) (attachment 4) which, broadly speaking, protects the word ANZAC from use as a trade mark in the course trade or business and from registration as a trade mark, design or business name. The Corporations Regulations also prohibit it from constituting the whole, or part of, the name of a corporation. The TM Act prohibits its registration as a trade mark.

1.1.2 The *Flags Act 1953* simply declares the Australian National Flag and the Australian Red Ensign. It also gives the Governor General the power to proclaim such other flags as he thinks fit. For example, in recognition of the fact that Aboriginal flag is increasingly being flown by both Aboriginal and non-Aboriginal people and is gaining in importance in Australian society, the government initiated steps in 1994 to give the flag legal recognition. After a period of public consultation, the government made its own decision in July 1995 that the flag should be proclaimed a "Flag of Australia" under section 5 of the Flags Act and the flag was proclaimed by the Governor General of Australia, William Hayden, on 14 July 1995. The Act also gives the Governor General the power to authorise use of the flags either without defacement or with specific defacement. He or she may also publish rules for the guidance of person's using or flying the flags. There are no penalty provisions in the Flag Act.

1.1.3 The *Scout Association Act 1924* makes it an offence to misuse the name 'Scout Association' or the name of any scout association branch and provides for the Association to be able to apply for a design registration for any of its insignia. The penalties are fines of \$10.

1.1.4 The Victorian Government has enacted the *Australian Grand Prix Act 1994* to establish the Australian Grand Prix Corporation (the Corporation) and to facilitate the holding of an annual Formula One Grand Prix at Albert Park, Melbourne. The Act declares that the Corporation has a proprietary interest in all grand prix insignia. The Act makes it an offence to supply goods bearing the grand prix insignia or to use the grand prix name or insignia without the consent of the Corporation. The Act also allows the police to seize goods bearing insignia where that use has not been authorised.

1.1.5 Although not protecting *Australian* icons an example of legislation protecting symbols and words of iconic status is the Federal *Olympic Insignia Protection Act 1987*. This legislation:

- grants the Australian Olympic Committee (AOC) copyright in the Olympic rings symbol;
- prohibits the registration of a trade mark which consists of or contains the Olympic symbol, the Olympic motto or certain Olympic designs;
- grants designs protection for certain Olympic designs; and

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- grants the AOC the exclusive right to use and license the use of the Protected Olympic Expressions for 'commercial purposes' (ie, the words Olympic, Olympic Games, Olympiad, their plurals and words likely to be mistaken for those mentioned).

1.1.6 Part IV of the *Geneva Conventions Act 1957* provides that it is an offence incurring a maximum fine of \$1 000, for a person to use a range of international symbols including the Red Cross and the Red Crescent without the consent of the relevant Minister. A court may order the forfeiture to the Commonwealth any goods bearing the unauthorised insignia.

## **2 Current mechanisms that may give limited protection to national icons and where amendments may be useful in protecting national icons**

### **2.1 Registered trade marks**

#### General

2.1.1 A trade mark is defined in the *Trade Marks Act 1955* (TM Act) as 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. Signs able to constitute a trade mark can include one or more letters, words, names, signatures, numerals, devices, brands, headings, labels, tickets, aspects of packaging, shapes, colours, sounds, scents etc. A trade mark will be registered for specific goods and services in one or more of 45 classes of goods or services.

2.1.2 Several individuals can own similar or identical trade marks if the goods or services to which the trade mark/s is applied are not of the same description. Alternatively more than one individual may register similar or identical marks if evidence of prior use or sufficient evidence of honest concurrent use of the later application for a trade mark is presented to the Registrar where goods and/or services are of a similar description. Trade mark registrations can be renewed every 10 years and there is no limit on their potential life span.

2.1.3 A registered trade mark is a form of private property and gives the owner the exclusive right to use and authorise others to use that trade mark on the goods and/or services for which registration is granted. A registration also gives the owner the right to relief, in the form of an injunction and/or either damages or an account of profits, for infringement of the trade mark. The customs seizure powers are also available to owners and authorised users of a registered trade mark.

2.1.4 A major advantage of registration of a trade mark over a common law trade mark is that registration is proof of ownership of the trade mark. This means that the expensive and sometimes difficult task of showing a reputation in a trade mark that is necessary in, eg, a passing off action or, as is sometimes required, in a Trade Practices action, may not be necessary in the case of defending or enforcing rights in respect of a registered trade mark.

2.1.5 When deciding whether a trade mark is registrable, the trade mark is examined to ensure that it does not raise any ground for rejection. The grounds for rejection are listed in the TM Act and also constitute, with the addition of a couple of other matters, grounds for opposing the registration of a trade mark and grounds for rectification of the registration in the courts.

## 2.2 Capable of distinguishing

2.2.1 One of the main requirements for registration of a trade mark is that it must be capable of distinguishing the applicant's goods and/or services (section 41, TM Act). That is, the trade mark must not contain or consist of material, as an overwhelmingly significant feature, that other traders would, in the normal course of business, need to use in their own business. For example, it is clear that all green grocers would need to be free to use the word 'apple' but this same restriction would not apply to computer manufacturers.

2.2.2 Under this provision it is clear that if an icon was in such common use that it effectively had a secondary meaning denoting some characteristic of the goods or services for which registration was sought, then the application would be refused. An example of this was trade mark application number 393275 for clothing. The trade mark consisted of an ordinary (non-stylised) representation of a kangaroo.<sup>10</sup> The trade mark was refused at an internal hearing because it was found that the device of a kangaroo was not distinctive of goods and/or services emanating from Australia. The image of a kangaroo effectively described the goods/services as 'Australian.' The hearing officer said:

*The kangaroo of course is the pre-eminent national symbol and thus is required by other traders to indicate the Australian origin or Australian content of their goods ... to emphasise the Australian flavour of their goods ... I do not intend to say that any representation of a kangaroo would be unregistrable. A particularly striking or unusual rendering may be so.*

## 2.3 Deceptive or confusing

2.3.1 Another requirement of the TM Act is that a trade mark cannot be registered if it contains or consists of some connotation which would be likely to deceive or cause confusion when used on the goods and/or services for which registration is sought (section 43). For example, if the trade mark consisted of the word 'gold' for all types of jewellery including silver jewellery then the application would be found to be misdescriptive of silver jewellery and would be refused for those goods.

2.3.2 In a recent decision, a Deputy Registrar of Trade Marks found, in the course of an action to remove a 'Waltzing Matilda' mark from the Register, the trade mark was misdescriptive of *videos, videotapes, cassettes, recording discs, CDs, audio/visual tapes, cassettes and discs* because the expectation of the public would be that those goods would

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<sup>10</sup> *Brandella Pty Ltd's Appn* (1987) 9 IPR 315.

relate to the famous song. In that case the Deputy Registrar dismissed the action to remove the trade mark from the Register on the condition that the owner agreed to delete the above goods from their registration. The implication is that no one would be able to register, *prima facie*, a 'Waltzing Matilda' trade mark in respect of those goods or goods of a similar nature because that term is not capable of distinguishing those goods. However, if a significant reputation can be shown for that trade mark in respect of those goods then it is possible a trade mark could be registered in respect of those goods (subsections 41(5) and (6) of the TM Act).

## 2.4 Scandalous or contrary to law

2.4.1 A trade mark application must also be rejected if it contains or consists of scandalous matter or its use would otherwise be contrary to law (section 42). To be considered scandalous the trade mark has to have the capacity to offend a section of Australian society, however, a 'sentimental objection' is not sufficient to raise the ground of rejection. In the case of scatological, profane or otherwise offensive trade marks the test is how the 'ordinary person' is going to perceive the trade mark. The Registrar has always been most careful not to register trade marks the use of which could give offence to members of any particular religion, eg, the word *Jesus* has been rejected in the past. In a suitable case it may be that registration of an icon used in some sort of derogatory manner in a trade mark would be refused on the basis that it was scandalous, ie, it would cause offence to a portion of the community.

2.4.2 An example of where a trade mark is prevented from being registered as a trade mark because it would be contrary to law is the word ANZAC. ANZAC is protected by the *Protection of the word "ANZAC" Regulations* (see attachment 2) which specifically prevents the Registrar of Trade Marks and the Registrar of Designs from registering trade marks and designs, respectively, which include the word ANZAC. It is interesting to note that the word ANZAC is also prohibited from being the name or part of a name of a registered corporation unless permission is granted by the Minister for Veteran's Affairs under section 147 of the *Corporations Act 2001* and regulations 2B.6.01, 2B.6.02, 5B.3.01, 5B.3.02 and Schedule 6 of the *Corporations Regulations 2001* (see attachment 5). The word ANZAC is also protected under the *Customs (Prohibited Imports) Regulations 1956*. Item 13 of Schedule 1 of those regulations prohibits absolutely the importation of 'Goods the description of which includes the word ANZAC or bearing the word ANZAC or a word so nearly resembling the word ANZAC as to be likely to deceive.' The word ANZAC is also prohibited under section 39 of the TM Act.

## 2.5 Prohibited trade marks (registered and common law)

2.5.1 Subsection 18(1) of the TM Act enables the specification, by regulation, of signs that cannot be used as a trade mark or as part of a trade mark. This provision applies to *both* applications to register a trade mark and to the use of common law trade marks. Subsection 39(1) states that applications for trade mark registration *must* be rejected where they contain or consist of signs that have been prescribed for the purposes of section 18. The listing of such trade marks will not affect any trade mark registrations or common law trade marks that were registered or used in good faith, respectively, before the regulations prescribing them come into force (subsection 18(2)).

2.5.2 There are currently no trade marks specified in the regulations under this provision, nor were there under the *Trade Marks Act 1955*. There is no process currently in place to decide in what circumstances, and applying what criteria, such signs would be prescribed. The Act merely states that a sign may be specified in the regulations as one not to be used as a trade mark. There is no appeal mechanism included in this provision. The only appeal possible would be to the Federal Court against a decision to reject the application, however, as the discretion here is extraordinarily wide it appears that it would be very difficult for an applicant to argue that the regulation was, eg, *ultra vires*. There is also no penalty provided in the Act for breach of such a proscription, however, anyone who used a prohibited sign as a trade mark would be unable to enforce any rights in the trade mark under the TM Act or under common law, eg, in a passing off action.

2.5.3 This provision has the potential to provide a very useful tool to protect icons from becoming the exclusive trade mark property of one person at the same time as preventing their use as trade marks by any person. This is so because prescription under this provision does not allow use of the prescribed sign as a trade mark *at all* and is, therefore, equally effective in both the registration and common law systems. This would not be the desired outcome in all situations, eg, the Winton Shire Council would like to be able to use *Waltzing Matilda* as a trade mark and the Sir Donald Bradman Foundation also wishes to use Sir Donald's name commercially, eg, as a trade mark in some instances. However, it could assist in some cases where it was considered that no commercial exploitation would be appropriate, eg, for words having similar import and character to ANZAC.

2.5.4 Some issues arise around the fact that there is currently no penalty for use of prohibited signs. The first issue is whether a penalty is required. Is the fact that any 'trade mark' developed for a prohibited sign would, presumably not be enforceable be of itself sufficient to prevent use? If it is considered that the force of a penalty is needed, it could take the form of a permanent injunction by a court ordering the defendant not to use the sign as a trade mark or, perhaps, a civil fine could be imposed. The use of a criminal penalty may be difficult to justify when a comparison is made with other activities that are subject to criminal penalty. Another issue is how would a civil action be started — would this be triggered by the Minister's decision or would the matter need to be referred to the DPP by, eg, the Secretary of the Department or by the relevant minister? In either case the Commonwealth itself would need to mount the action or take the complaint.

## 2.6 Prohibition of registration of trade marks

2.6.1 Subsection 39(2) of the TM Act states that the Registrar *may* reject an application which contains or consists of a sign that is prescribed for the purposes of subsection 39(2) or is so like a prescribed sign as to be likely to be taken for it. A series of signs has been prescribed under subsection 39(2) in regulation 4.15 and Schedule 2. These include a range of IP-related words and signs, any representation of the Arms, flag or seal of the Commonwealth, a State, a Territory, a city or town, a public authority, a public institution in Australia, or a sign notified to the WIPO as not entitled to registration under international arrangements. Schedule 2 lists the 7 signs (see attachment 4), including the words 'Returned soldier' and 'Olympic Champion', referred to by subregulation 4.15(f).

## ATTACHMENT 1

2.6.2 Again, there is scope here to prevent the registration of icons as trade marks where the desired outcome is that the icon not be the exclusive property of one person or be used as a registered trade mark. This provision only relates to trade marks in the trade mark registration system and hence has no effect on common law trade marks.

2.6.3 Notification of certain signs to WIPO may be advisable in some instances. For example, the Turkish Trade Marks office was concerned at a request it received for registration of the word ANZAC. The Turkish Government liaised with the Australian Government on the matter and rejected the application on the basis that its registration would be contrary to the public good. Its listing with WIPO would have obviated the need for extensive negotiations on the subject and listing is currently being sought.

### 2.7 Requirement of intention to use as a trade mark

2.7.1 Where the desired outcome is that an icon should be used commercially by one person or organisation only, one option is to register the icon as a trade mark. However, some problems can arise with this solution.

2.7.2 One issue is that it is necessary that there be an intention to use the trade mark as a trade mark at the time the application is made. If the person or organisation does not intend to use the icon as a trade mark it will not be possible to make a valid application for registration of the icon as a standard trade mark. Similarly even if there is an intention to use a trade mark an application can only be made for goods and/or services in relation to which the applicant intends to use the trade mark. Where it is the case that the person or organisation does not intend to use the trade mark on all the goods and/or services possible, then there will be 'gaps' in the trade mark coverage that others would be free to exploit. Where there is no use of a registered trade mark after a certain time from registration, the registration can be de-registered in a fairly cheap and quick administrative action unless the owner can show it has used the trade mark.

### 2.8 Defensive trade marks

2.8.1 In circumstances where exclusive use of a name is required by one person or body but there is no intention to use a trade mark on every good or service consideration could be given to application for registration of a defensive trade mark. These registrations are available in cases where the trade mark is so well known for particular goods and/or services that its use on other goods and/or services would be likely cause confusion in the public's mind as to who was producing the goods and/or services. For example, the Holden car company has obtained defensive registrations for the word 'Holden' for tyres based on their famous car mark even though they do not produce or sell tyres. In those cases a defensive registration is available for the goods and/or services for which there would be confusion but this would not, except in the most exceptional case, provide complete coverage over all goods and services for one person or organisation.

2.8.2 It may be possible to amend the defensive registration criteria to cater specifically for icons to enable comprehensive trade mark coverage that would prevent the registration by others of the icon, where:

- there is a pre-existing standard registration in the icon owner's name for a range of goods/services for which confusion might occur, and/or

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## ATTACHMENT 1

- there is no pre-existing registration in the icon owner's name for a sign that has been given icon status of a type that would require exclusive trade mark rights.

This solution would more appropriately be achieved by prohibition under section 39 of the TM Act and, similarly, it would not prevent the use of common law trade marks incorporating the icon.

## 2.9 Prior registrations

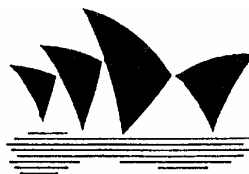
2.9.1 In some cases another party may have registered the trade mark before the person or organisation claiming the icon as theirs. This was considered, on the evidence before the trade marks office, to be the case with Winton Shire Council's application for a *Waltzing Matilda* trade mark. However, in a recent decision of the Federal Court of Australia, Spender J found that Winton Shire Council had actually used *Waltzing Matilda* as a trade mark, albeit very briefly, before the priority date of the opposed trade mark application but only for a limited number of services. The defendant was able to register her trade mark for many other goods and services.<sup>11</sup>

2.9.2 Another problem, particularly in the case of image icons is that the image that the icon 'owner' registers is only one version of the icon. There will be cases where a different image of exactly the same icon is registrable in the face of the icon image previously registered because the later trade mark is not considered sufficiently similar to the previous one to prevent registration. For example, in the case below the Sydney Opera House Trust, which has the previously registered trade mark (figure B) was unable to prevent the registration of a later trade mark for the same goods (figure A) because the two signs were found not to be deceptively similar.

Figure A (Janne Lindrum)



Figure B (Sydney Opera House Trust)



2.9.3 In other cases a trade mark for the word description of an image, eg, 'the southern cross' could co-exist with images of the southern cross constellation.

## 3 Passing off actions

3.1 The common law tort of passing off is available where a person has effectively represented that their own goods or services are actually those of another. This is a case of one person using the reputation of another for their own commercial ends. The plaintiff in a passing off action must show that:

<sup>11</sup> *Winton Shire Council v Lomas* [2002 FCA 288 (20 March 2002)].

## ATTACHMENT 1

- a) The plaintiff(s) has an established reputation or goodwill in the relevant goods or services;
- b) That there is or there will be a misrepresentation by the defendant that its goods or services are those of the plaintiff(s), whereby confusion or deception is likely to be created for the relevant public; and
- c) There is actual or will be damage to the plaintiff's goodwill or reputation as a result of (b) above.<sup>12</sup>

3.2 This tort has been used to protect against inappropriate commercial use of a person's name or image. For example, Paul Hogan was successful in a passing off action against a company using a caricature 'Koala Dundee' which was 'got up' to look like Paul Hogan's film character 'Crocodile Dundee'. It is not clear that this tort would be of great use in the protection of icons but there may be circumstances such as, eg, in a like case to that of Sir Donald Bradman where it could be useful to a limited extent.

3.3 As an example, the tort may be useful for the protection of Sir Donald Bradman's interests in cricket equipment (if he had any) but would not provide any useful protection against the name *Bradman* being used as the name of a cafe as Sir Donald would have no reputation in the latter services. This was the issue that led to the name 'Sir Donald Bradman' being restricted under the Corporations Regulations. The limiting factor with this tort is that a reputation in the mark (whether a name, image etc) *in relation to particular goods or services* must be proved. Additionally, it is only the person whose reputation was used wrongly, or their successors in title to the business operation using the mark, who would be able to take the action. Because of the necessity to show reputation, the action would only be available as long as the reputation remains strong. Such actions are also costly to those taking them.

#### **4 Trade Practices Act**

4.1 The *Trade Practices Act 1974* (TP Act), and state and territory fair trading acts can, in appropriate circumstances, provide protection from the use of a person's name or other reference where that use is misleading or deceptive. The two most relevant sections of the TP Act to a discussion of icons are sections 52 and 53. Section 52 of the TP Act and equivalent provisions in state and territory legislation prohibit conduct that misleads or deceives, or is likely to mislead or deceive, in the course of trade or commerce. Courts have held that this protection extends to the use of a names and personalities. Section 53 of the TP Act and state and territory equivalent provisions prohibits representations, in the course of trade or commerce, that goods, services or organisations have sponsorship or approval that they do not have.

4.2 Section 52 prohibits behaviour, in trade or commerce, that is, or is likely to be, misleading or deceptive. There must be an objective misrepresentation — there is no necessity for actual deception or confusion or for there to be any intention to mislead or deceive on the part of the defendant.

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<sup>12</sup> Lahore, Patents, Trade Marks and Related Rights, Butterworths service, paragraph 75,080.

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4.3 The use of the 'Crocodile Dundee' persona, discussed above under 'passing off', was also found to be in breach section 52 of the TP Act. It was found that the manufacturer of shoes who used a caricature of the character 'Crocodile Dundee' in one of its advertising promotions was held to have falsely represented that it had endorsement by Paul Hogan, the actor who played character 'Crocodile Dundee' in the film of the same name.<sup>13</sup> The massive popularity and public recognition of the 'Crocodile Dundee' character played a large part in this decision. The decision was confirmed on appeal. It can be contrasted to a decision where no misleading or deceptive conduct was found when a television personality's name, along with a photograph of a younger woman, was used in relation to an advertisement for video recorders.<sup>14</sup> In another case, Kieran Perkins failed to show misleading and deceptive conduct on the part of Telstra who used his image in an advertising supplement.<sup>15</sup>

4.4 It is not strictly necessary for a plaintiff to show goodwill or reputation in the marketplace. However, if the conduct complained of under section 52 involves a misrepresentation about a trade name or 'get up' etc., it may be necessary to establish reputation in order to convince the court that the relevant section of the public is likely to be deceived or misled or vice versa.<sup>16</sup>

4.5 The remedies available for a breach of section 52 are very flexible, including extensive injunctive powers under section 80 and damages under section 82.

4.6 Section 53 of the TP Act '...is concerned with false representations, or false and misleading statements, as to certain specified matters. In each case the conduct prohibited is such that it would be clearly caught by section 52. Where, however, particular conduct can be shown to be within the narrower confines of section 53, criminal liability will ensue, see s[ection] 79.<sup>17</sup> For example, the unauthorised use of the Australian Coat-of-Arms could breach subsections 53(c), (d) and/or (e) of the TP Act.

4.7 This provision may be useful in the protection of icons where an icon was used in the course of trade or commerce in a misleading or deceptive manner. In some instances, eg, in test cases, the Trade Practices Commission will take an action under the Act. It is not clear under what circumstances this is done.

## 5 Copyright

5.1 Copyright gives to the owner of the copyright the exclusive right to prevent others from making unlawful copies, and from making certain unlawful dealings in copies, of a work or other subject-matter of copyright. Copyright protects the expression of original material in literary, artistic, dramatic or musical works, films, broadcasts, multimedia and computer programs against copying. Copyright generally remains current for the lifetime of the creator, plus 50 years.

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<sup>13</sup> *Hogan v Pacific Dunlop Ltd* (1988) 83 ALR 403; *Pacific Dunlop Ltd v Hogan* (19889\_23 FCR 553.

<sup>14</sup> *10<sup>th</sup> Cantanae Pty Ltd v Shoshana Pty Ltd* (1988) 79 ALR 299.

<sup>15</sup> *Talmax Pty Ltd v Telstra Corporation Ltd* (1996) ATPR 41-484.

<sup>16</sup> Lahore, Butterworths sevice, *Patents, trade marks and related rights*, paragraph 84,250.

<sup>17</sup> Lahore, Butterworths sevice, *Patents, trade marks and related rights*, paragraph 84,260.

5.2 One of the key requirements of copyright is that, except for sound or television broadcasts, the protection given is for the fixed material form of the work, ie, there is no copyright in the subject matter itself as opposed to the form in which it is expressed. Therefore ideas, purely oral work or improvised music or drama, eg, which cannot be reduced to a material form cannot attract the protection of copyright.

5.3 To attract copyright protection a work must also be original, ie, it cannot merely be a copy of something else. The level of originality, however, is not high but must be more than trivial variation and must be recognisable as the work of the author claiming copyright. It is difficult for a word or phrase to qualify as a 'work' for the purposes of copyright. For example, the invented word *Exxon* was said not to attract copyright as it did not afford either information and instruction, or pleasure, in the form of literary enjoyment.<sup>18</sup> Although the reasoning in that case has been questioned it appears that it would be very difficult for one or two word phrases to attract copyright protection. It is suggested that this would be very much more difficult in the case of well known words.

5.4 Copyright appears to have limited applicability to an icon protection system. There are a number of limiting factors. The work must be original and, by their nature, icons will more often than not be part of the public domain, eg, ANZAC, Uluru. There will, in many cases, already be numerous copyright works that incorporate icons, eg, photographs, artistic interpretations of the Sydney Opera House, the use of the Australian flag on packaging to indicate the Australian origin of the goods. Protection for an icon 'in general', or the idea behind an icon, cannot be achieved under copyright because it is only the version or versions fixed in material form that would be protected. For example, it would not be possible for one person to copyright all versions, in material form, of the Sydney Opera House.

5.5 Also, the first ownership of copyright lies with the creator. This will be an issue where there is no identifiable author of the work. This is certainly an issue, eg, in the protection of indigenous artworks where more than one person may be the author of the work, and will certainly be an issue where the authorship is unknown. In many cases where an author cannot be identified the inevitable conclusion will be that the work is part of the public domain. Copyright is also of limited duration whereas many icons will, by their nature, be very long lived and require protection as long as they have icon status.

5.6 These issues will have a huge impact on how useful copyright concepts could be to icon protection but there is at least one instance where they have been overcome. The *Olympics Insignia Protection Act 1987* overcomes the authorship and duration limitations of copyright by vesting ownership of copyright in the Olympic Rings symbol in the Australian Olympic Committee on an ongoing basis. In suitable cases this type of deeming provision may prove a very useful tool for the protection of some icons.

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<sup>18</sup> *Exxon Corp v Exxon Insurance Consultants International Ltd* [1981] 3 All ER 241.

## 6 Copyright — Moral Rights

6.1 A moral rights system was introduced into Australian copyright law by the *Copyright Amendment (Moral Rights) Act 2000* which came into effect on 21 December 2000. Generally speaking moral rights apply to works, except films, in which copyright subsists even if the work was generated prior to the 21 December 2000. As a consequence of the legislation there are now three moral rights under the *Copyright Act 1968*:

- A right of attribution of authorship (an author's right to be identified as the author of the work);
- A right not to have authorship falsely attributed (an author's right to take action against false attribution); and
- A right of integrity of authorship (an author's right to object to derogatory treatment of his or her work which prejudicially affects his or her honour or reputation).

6.2 Copyright must subsist in the work for it to attract moral rights. Moral rights are not assignable like other copyright property — they remain with the original author. However, they do exist for the duration of copyright and a legal representative can take action after the author's death if copyright is still current.

6.3 The most useful aspect of moral rights for icon protection is the concept of a right to integrity of authorship — a right to object to derogatory treatment of an author's work that prejudicially affects his or her honour or reputation. Derogatory treatment means doing anything in relation to a work that results in the work's material distortion, mutilation, material alteration having a prejudicial effect on the author's honour or reputation or the doing of anything else to the work having that effect. The right of integrity only applies to the treatment of works, eg changes to a work, that occurred after 21 December 2000.

6.4 A threat of legal action under the legislation was used recently by the architect of the National Gallery of Australia, Mr Colin Madigan, to force consultation with him on proposed alterations to the entrance to the National Gallery. He was able to insist, on the basis of the legislation and support for his claims under the legislation from prominent architects, that he be consulted about major works planned for the entrance to the gallery. Prior to this he had no legal entitlement to be consulted about changes to his architectural work.<sup>19</sup>

6.5 The same issues arise as under the general copyright section above with regards to the subsistence of copyright in icons. However, a legislative instrument that enabled action to stop or prevent the derogatory use of icons may well be an extremely useful tool in the protection of icons. If legislation were to deem that the words, images, music, bodies listed in the regulations were not to be used in a manner that would prejudice the honour or reputation of the icon/society this may be sufficient protection for at least one of the categories of icons. A number of issues arise, such as, who would take any action against 'derogatory use', on what basis they would do so, what exemptions would be

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<sup>19</sup> 'The Edifice Complex', *The Age*, Sat 28 September 2002.

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allowable, the consequences arising from 'derogatory use', the impact of the legislation on freedom of speech etc.

6.6 It is clear that a moral rights approach to icons would result in a very different concept to that implemented in the Copyright Act. However, a roughly similar approach to icons protection would enable the co-existence of the icon status with other rights.

### **7 Industrial designs**

7.1 Industrial designs are registered rights which protect the shape or appearance of manufactured goods. Currently a design registration gives the owner exclusive rights to commercially exploit the design for up to 16 years. It cannot be renewed beyond this period. To be registrable, a design must be new or original. 'New' means not known or previously used in Australia. 'Original' means it has never been applied to a particular product, although it may have been applied to another type of product. The design (or one very similar) must not have been registered, published, used or sold in Australia prior to the date on which the application for registration was lodged, or the earliest priority date (whichever is the earlier). A registered design is personal property and gives the owner the exclusive right to use or authorise others to use the design and to take action to stop unauthorised use of the design.

7.2 Design registration is not available for products that are primarily literary or artistic in character, eg, book jackets, calendars, stamps, medals etc., however, copyright protection may be available for such products. Neither is design registration available for circuit designs, the Olympic rings or the Olympic motto, a torch and flames design prescribed under the *Olympic Insignia Protection Act 1987*, a representation of the Queen or any member of the Royal Family, the coat of arms, flags or seal of the Commonwealth or any State of the Commonwealth, the armorial bearings, flags, State emblems or signs of any country other than the Commonwealth or the coat of arms or emblems of any city or town in the Commonwealth or of any State or Public Authority or public institution.

7.3 The *Designs Act 1906* could be use useful to support any icons protection in that any protected icons could be prohibited from use as a part of a registered design or design protection could be deemed to apply to an appropriate icon.

### **8 Company names**

8.1 Section 51(xx) of the Australian Constitution gives the Commonwealth only limited power to regulate corporations. For example, this provision has been interpreted as falling short of giving the Commonwealth the power to incorporate companies.<sup>20</sup> Up until recent times, the Commonwealth was able to achieve a unified system of incorporation in this country through a scheme of legislation consistent throughout the Commonwealth, referred to as the *Corporations Law*. Because of serious questions raised by the High Court about the constitutional validity of some key elements of those provisions,<sup>21</sup> the States decided on 25 August 2000 to make a broad referral of power in

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<sup>20</sup> *New South Wales v Commonwealth* (1990) 169 CLR 482.

<sup>21</sup> *Re Wakim; Ex parte McNally* (1999) 198 CLR 511; *R v Hughes* (2000) 171 ALR 155.

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respect of corporations to the Commonwealth under section 51(xxxvii) of the Constitution. The referral was to be in respect of the formation of corporations, corporate regulation and the regulation of financial products and services and has a sunset clause of 5 years ending at around 15 July 2006. The referral of power has resulted in the Commonwealth *Corporations Act 2001* (Corps Act).

8.2 To register a company under the Corps Act, the company's promoters must make application to the Australian Securities and Investments Commission (ASIC) (section 117). An application must state the name of the company (subsection 117(2)). A company comes into existence at the beginning of the day it is registered and its name is the name specified in the certificate of registration (section 119). A company must set out its name at its public office and on all its public documents and negotiable instruments (section 153). A company can choose to use its Australian Company Number (ACN) as its name (section 148.). If it chooses not to use its ACN as its name, a company can choose any name as long as it is available and acceptable for registration under the regulations (section 147). A name will not be available if it is identical to a name that is previously reserved or registered under the Corps Act, is identical to a name on the national business names register, or is unacceptable under the regulations (section 147).

8.3 It is possible to search all Registered And Reserved Company And Business Names, Schemes, Trusts And Non Registered Entities; all Registered, Reserved And Deregistered Company And Business Names, Schemes, Trusts And Non Registered Entities; all Registered Company Names, Non-Company Names, Schemes, Trusts And Non-Registered Entities; and Business and State Names through the ASIC website at <http://www.search.asic.gov.au/gns001.html>. The *Corporations Regulations 2001* set out when a name will be identical or otherwise unacceptable under the regulations. If a company wants to trade under a name different to its company name it will have to register a business name in the appropriate State or Territory business name register prior to operating under that name.

8.4 Regulations 2B.6.01, 2B.6.02, 5B.3.01, 5B.3.02 and Schedule 6 of the regulations sets out the rules for availability and where names are unacceptable. Schedule 6 (see attachment 5) sets out, for paragraph 147(1)(c) or 601DC(1)(c) of the Corps Act, that a name will be unacceptable if, in the opinion of ASIC, eg:

- it is undesirable;
- it is likely to be offensive to members of the public or members of any section of the public;
- it contains a restricted word specified in Part 3 of Schedule 6, eg, 'Executor', 'RSL', 'Made in Australia', or a word or abbreviation having the same meaning as those terms;
- it suggests, where there is no such connection, a connection with the Crown, the Commonwealth Government, a State or Territory Government, a municipal or other local government, government departments or authorities or the government of a foreign country;
- it suggests a connection, where there is no such connection with:
  - a member of the Royal Family
  - the receipt of Royal patronage

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- an ex-serviceman's organisation
- **Sir Donald Bradman;**
- It is included in Part 4 of Schedule 6 which sets out words that can only be used with the permission of the relevant minister, eg, use of the word ANZAC requires the permission of the Minister for Veteran's Affairs, 'Geneva Cross' requires the permission of the Minister for Defence, 'United Nations' the permission of the Minister for Foreign Affairs and 'University' the permission of the Minister for Education, Training and Youth Affairs; or
- It is included in Part 5 of Schedule 6 which sets out words that can only be used with the permission of the Australian Prudential Regulatory Authority (APRA).

8.5 In August 2002 the Treasury released *Guidelines for Ministerial Consent to Body Corporate Names Under the Corporations Act 2001* (available at <http://www.treasury.gov.au/documents/385/RTF/NamesGuidelines.rtf>). However, those guidelines do not include information on what when a name would be considered 'undesirable' or a name 'likely to be offensive'. Decisions on these provisions are made by ASIC on a case by case basis. In some instances the time of the application will have an effect on its acceptability. For example, the name 'Dianna and Dodie Corporation', lodged at the time of Lady Dianna's death, was rejected. With the passing of time it may now be acceptable. The name 'Virgin Mary' has been rejected in the past.<sup>22</sup> If a person is unhappy with ASIC's decision they can apply to the Minister for permission to use it as a corporation name despite the provisions against its use (subsection 147(2)).

8.6 The inclusion in the regulations of Sir Donald Bradman's name was the result of Sir Donald's deep offence at the naming of an Adelaide brothel 'massage on Bradman' when a section of a road in Adelaide was renamed Bradman Drive in honour of Sir Donald.

8.7 It is clear that company names are often used as primary identifiers in the marketplace, eg, One.tel, HIH insurance, Telstra etc. The fact that the name 'Sir Donald Bradman' cannot be included in the name of a company, unless the company has a connection with Sir Donald Bradman, illustrates that the control of company names, because of their widespread use as general business identifiers, could be very useful in any attempt to protect national word icons. Even currently ASIC has very wide powers, through the ability to reject a company name because it is 'undesirable' or would 'offend the public', to control the use of word icons. If ASIC were unable to use their current powers to protect icons from being used as company names, or it was considered undesirable that it should do so, some action to add specific icons to the various lists in Schedule 6 may be possible. The issue of pre-existing registrations would need attention but may not be reversible.

## 9 Business names

9.1 Where a person, including a corporation, intends to trade under a name that is not their own name they must register that name as a business name. All States and

<sup>22</sup> Discussion with officers from Department of the Treasury.

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Territories have their own business name acts and business name registers. The reason for this requirement is that it allows the identification of the proprietors of a business and thus assists in the protection of the public in their dealings with such proprietors. The registration of a business name does not establish any rights to that name or in that name that do not already exist, eg, registering a business name will not, of itself, give rights in a trade mark, entitle a person to a 'passing off' action or give any other property right.

9.2 Section 9 of the *Business Names Act 1962* (NSW) directs the Director-General of the Department of Fair Trading not to register, without the consent of the Minister, a business name that is, in the opinion of the Director-General, undesirable or is a name, or a name of a kind, that the Minister has, for the purposes of the Act, directed the Director-General not to accept for registration. If such a name is registered because of an error it can be deregistered. All other State and Territory business names acts contain virtually identical provisions.

9.3 Business names are essentially used in the same way as corporation names, ie, as primary identifiers in the marketplace. If it is considered that the provisions of the *Corporations Act 2001* would be usefully employed in the protection of word icons, then the issue of business names also needs to be addressed. This is particularly so where corporations choose not to use their corporation name as a trading name. Some co-ordination between the Federal and State levels of government as to what is allowable would need to be introduced. It may be, eg, that some reference to the Corporations law could be inserted into State and Territory business laws regarding icons. One example of such a scheme may be that a further schedule could be added to the Corporations Regulations (eg, Schedule 6, part 6) setting out 'national icons not to be registered as part of a corporation name'. These could be added to the types of words not available as business names under each State and Territory business names act. Any such change would incur the obvious difficulty of gaining agreement to, and amending in reasonable proximity, all State and Territory business names legislation. Another issue will be that registration of some icons as business names may have already occurred in some jurisdictions (see section 7 — pre-existing rights).

## 10 Domain names

10.1 All computers on the Internet have a unique identifying number called an Internet Protocol address. The Internet Protocol address is what a computer uses to find an Internet site. Unfortunately, it is not intuitive or easy for people to remember. A domain name is the unique name that corresponds with an Internet Protocol address and is both intuitive and easy to remember. For example, IP Australia's Internet Protocol address is 203.21.147.134 but most people access the web site using the domain name, which is [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au) — much easier to remember!

10.2 Internet domain names are divided into to main levels — the first being international or generic top level domains (gTLDs), eg, '.com' and the second being country code national top level domains (ccTLDs), eg, '.com.au'. The gTLDs have mainly been registered by US companies and must be registered with one of the 77 registrars accredited by the Internet Corporation for Assigned Names and Numbers (ICANN).

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When registering a gTLD, the registrant must agree to be subject to ICANN's mandatory Uniform Domain Name Dispute Resolution Policy (UDRP) if a complaint is lodged. That policy is very detailed and can lead to an order for the domain name to be transferred to the complainant or another body, particularly in cases where a domain name incorporates a trade mark, or a word close to a trade mark, and the registrant has no real interest in the name except as a domain name. The adoption of the UDRP rules does not rule out recourse to the courts — this is also available as an alternative if desired.

10.3 Australian ccTLDs must be registered with one of the registration bodies approved by .au Domain Administration Ltd (auDA), an Australian not-for-profit company vested with the responsibility of operating the .au domain for the benefit of all stakeholders.

10.4 The final report of the auDA Advisory Panel Number 1 (the Name Policy Advisory Panel), 'Eligibility and Name Allocation Policy Review in Second Level Domains' was approved by the auDA Board on 8 April 2001. The new policy 'Domain name eligibility and allocation policy rules for open second level domains (2LDS)' (Policy No 2002-07 available at [www.auda.org.au](http://www.auda.org.au)) came into operation on 8 May 2002.<sup>23</sup>

10.5 The policy makes it very clear that no proprietary rights exist in domain names — a registrant does not 'own' a domain name, they merely hold a licence to use it for a specific period of time (renewable every 2 years) and under certain terms and conditions. The registrant must agree, when licensing a domain name, that it must not directly, or indirectly, register a domain name with the purpose of selling it and the registrant must not in any way transfer or purport to transfer a proprietary right in any domain name registration. The policy makes it quite clear there are no proprietary rights in a domain name to 'sell'. AuDA reserves the right to revoke a licence where the registrant purports to sell a domain name and can transfer it to another person in the course of a dispute resolution procedure under the .au Dispute Resolution Policy (auDRP)(published as Policy No 2002-22) at <http://www.auda.org.au>.

10.6 There is, further, no hierarchy of rights in the Domain Name System, eg, a registered trade mark does not confer any better entitlement to a domain name than a registered business name. Domain name licences are allocated on a 'first come, first served' basis, however, they can be revoked if the registrant has made a false warranty to the registrar or otherwise acted in bad faith in order to obtain the domain name. The eligibility criteria that must be met, eg, for .com.au registrations, are that the registrant must be Australian, renewal will be dependent on the registrant continuing to meet the eligibility and allocation rules and the proposed name must not be on the reserved list which can be found at <http://www.auda.org.au>.

10.7 Acceptable proof of Australian entity status includes an Australian registered trade mark, or trade mark application, proof of identity (eg, Australian passport, Australian drivers' licence), an Australian Business Number or a Business Name or Company name registered in Australia.

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<sup>23</sup> Personal Communication with Christopher Disspain, Chief Executive Officer, auDA, 3 May 2002.

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10.8 For the .com.au 2TLD the eligibility criteria require that the registrant must have some connection with the domain name, eg, they must have the name registered as an Australian registered company, be trading under the name, have an application or registration for a trade mark for that name, the name must have a close and substantial connection with the registrant such that, eg, the domain name refers to a product that the registrant manufactures or sells or a service that the registrant provides or an event that that registrant organises or sponsors or an activity that the registrant facilitates, teaches or trains or a venue they operate or a profession that the registrant's employees practice.

10.9 A very significant issue for icons is the reserved list which contains names that may not be licensed. In discussion papers in the development of the policy the Panel noted that there are some words that are subject to statutory protection such as ANZAC which is protected under the Protection of Word 'Anzac' Regulations made under the *War Precautions Act Repeal Act 1920*. The Panel envisaged that, from time to time, other words may be protected for special events, such as 'Sydney 2000', clearly alluding to the Sydney 2000 Olympic Games, an issue at the time the Panel was deliberating. The Panel also considered that it may also be socially desirable to restrict the licensing of some objectionable words; however, it made no recommendation on the nature or extent of such restriction, if any.<sup>24</sup> The final policy (Policy No 2002-11) states that, as a general principle, the reserved list will only contain words and phrases that are restricted under Commonwealth legislation. Only those who can demonstrate a right to the word or phrase under Commonwealth legislation will be able to register the word or phrase as a domain name. Currently the list, available on the auda website, contains the words Anzac, Geneva Cross, Red Crescent, Red Cross, Red Lion and Sun, United Nations, University, Olympic(s), Olympiad(s) and Olympic Games. Currently the Reserved List also contains all Australian Geographic names but it is expected these will not be part of the List in the long term.

10.10 Any protection of word icons would have to address the issue of gaining protection for, or preventing registration of, domain names incorporating word icons or descriptions of image icons, at least at the level of ccTLDs. The fact that the domain name only has to be the name of something that has a close and substantial connection to the registrant may mean that icons could be registered as domain names by individuals. This would appear to be the case unless the icon was protected by Commonwealth legislation and therefore eligible for inclusion in the reserved list. Listing on the reserved list would not act against any conflicting registration that had already taken place, however, the requirement to meet the eligibility requirements for renewal every two years may mean that such registrations would not necessarily be ongoing.

10.11 In the case of gTLD names, which are registered by ICANN, it is not clear what influence the Australian government could bring to policy issues around their registration. It is the case that the Australian Government is taking a lead role in the resolution of the issues around gTLD names and has prompted a second round of negotiations on the issue by WIPO. These negotiations will be concerned only with international issues such as the treatment of trade names, pharmaceutical names and country names. It is highly unlikely

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<sup>24</sup> Ibid.

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that purely national issues would be considered at this stage of negotiations. In any case it is not clear that Australian icon protection would need to extend to the gTLD level given their national character even though gTLDs are, of course, used in the Australian jurisdiction.

## THE AUSTRALIAN NATIONAL ANTHEM (Attachment 2)

Mr Owen Malone  
Chairman  
Advisory Council on Intellectual Property  
PO Box 200  
WODEN ACT 2606

Dear Mr Malone

I am writing in connection with your Council's inquiry into the use of names that make up Australia's cultural identity. I understand that a working group of the Council is currently undertaking a scoping study of the issues that might be involved in identifying and protecting the use of the names.

This Department has responsibility on behalf of the Commonwealth for Australia's national symbols and has continuing difficulty with protecting some of the symbols from inappropriate use. A list of symbols that have been proclaimed and are thereby classified as national symbols is at Attachment A.

Of particular concern is inappropriate use of the Australian National Anthem. The issue was brought to a head with the use by Meat and Livestock Australia of the National Anthem in an advertisement to promote lamb in the weeks leading up to Australia Day 2002. The tune of the National Anthem accompanied by substituted words (see Attachment B) provoked a strong and adverse public reaction. The advertisement was subsequently taken off-air and replaced with a revised version again based around the tune of the National Anthem.

In essence, there is only a limited basis for restraining any inappropriate use of the National Anthem. Whilst legal advice suggests that the Commonwealth owns copyright in the words and tune of the National Anthem as proclaimed, it does not however own copyright in respect of the words and tune of the song *Advance Australia Fair* which was first published and performed during the latter half of the 19<sup>th</sup> Century. Because of similarities between the words and tune of the National Anthem and *Advance Australia Fair*, it is the view of the Australian Government Solicitor that it would be difficult for the Commonwealth to establish infringement of the National Anthem under the *Copyright Act 1968*.

A brief paper about the National Anthem is at Attachment C.

Similar issues arise from time to time in respect of the National Flag such as in the branding of products around the theme of *Buy Australian Made*.

The National Anthem consists of a tune and words. It is markedly different from a brandname or trademark but is recognised as a brandname or trademark of Australia's national identity and pride.

The Commonwealth actively promotes the use by the community of the National Anthem including by commercial organisations where the National Anthem is used as an expression of national pride in the form intended with respect and dignity and is not demeaned. In this context, the use of the National Anthem as Australia's foremost national icon by commercial organisations brings the issue within the scope of the Council's inquiry.

Because of the Prime Minister's interest in the issues likely to be considered by your inquiry, it would be appreciated if this Department could be provided with a copy of the Council's report. Alternatively, your minister may consider that a copy of the report or of its findings could be made available to the Prime Minister.

Yours sincerely

Assistant Secretary  
Awards and National Symbols  
April 2002

## **Australia's National Symbols**

The National Flag	(declared in the Flags Act 1953)
The Commonwealth Coat of Arms	(Granted by Royal Warrant 1912)
The National Anthem	(Proclaimed 1984)
Floral Emblem (Golden Wattle)	(Proclaimed in 1988)
National Colours (gold and green)	(Proclaimed 1984)
National Gemstone (opal)	(Proclaimed 1993)

**ATTACHMENT 2**

**Attachment 1B**

Meat and Livestock Australia (MLA) Australia Day 2002 lamb meat promotion advertisement screened on television in the lead up to Australia Day 2002.

The tune of the National Anthem was used with the following words:

Australians all let us rejoice  
for our lamb is young and lean  
When golden brown and enough for all  
our lamb is great to see.  
Our land abounds in tender lamb  
be it well done, medium or rare.  
In burgers, chops and shish kebabs  
our lamb is always there.  
In joyful strains then let us sing,  
Lamb's Australia's fare.

## ATTACHMENT 2

### Attachment 1C

## HISTORY OF THE AUSTRALIAN NATIONAL ANTHEM

The first recorded contest for an Australian national anthem or song was conducted by a private organisation in 1826. In 1973, the then Prime Minister announced in his Australia Day address that there was to be a national competition for a distinctively Australian national anthem and that *God Save The Queen* was to be retained for occasions where Her Majesty was present, or to acknowledge Australia's links with the Crown.

The Australian National Anthem Quest was conducted by the Australian Council for the Arts on the Government's behalf. This was done in two stages: first for lyrics and then for music and/or completed anthems. The lyrics section received more than 1,400 entries and the music section received 1,200 entries. However, it was the opinion of the judges that none of the entries met the high standards already set by the traditional songs, *Advance Australia Fair*, *Song of Australia* and *Waltzing Matilda*. The Council recommended that the final choice be made from these three songs.

In 1976 the next Prime Minister reinstated *God Save the Queen* as the national anthem. He stated that *Advance Australia Fair* or another song would be chosen to be used on ceremonial occasions when it was necessary to mark a separate Australian identity.

On 21 May 1977, a poll for a tune for a national song was conducted by the Australian Electoral Office in conjunction with a referendum. No special legislation was enacted for the conduct of the national poll, however, a machinery amendment was made to the *Referendum (Constitutional Alteration) Act 1906* in order for the ballot boxes and polling booths used for referendums to be used for the national poll.

The tune *Advance Australia Fair* was the preferred option and was chosen as was Australia's national tune.

The National Australia Day Committee proposed in February 1981 to change the words of *Advance Australia Fair* to remove any gender bias and delete the second and fourth verses.

In 1984, the Hawke Government, guided by the outcomes of the national poll, announced that the national tune together with the revised verses of the original Peter Dodds McCormick composition of *Advance Australia Fair* would become Australia's national anthem. On 19 April 1984 the Governor-General proclaimed *Advance Australia Fair* as Australia's national anthem and *God Save The Queen* as the Royal Anthem of Australia, which was to be used only in the presence of the Queen or a member of the Royal Family in Australia on an official visit.

In 1985, Government House announced that the Queen had decided that, on public engagements of Her Majesty in Australia, in addition to the playing of *God Save The Queen* at the beginning of the engagement, *Advance Australia Fair* should be played at the end. Government House announced it might be appropriate for both to be played at the beginning. This also applied to engagements undertaken in Australia by other members of the Royal Family. These arrangements are still in place today.

**ATTACHMENT 2**

The Australian Government Solicitor has advised the Department of the Prime Minister and Cabinet that the Commonwealth is likely to own any copyright in the words to the National Anthem.

There is no specific Commonwealth legislation relating to the National Anthem.

## ATTACHMENT 3

## ICONS TESTED AGAINST SEVERAL DEFINITIONS (Attachment 3)

ICON	Definition 1 Thing of such importance to Australian culture that <u>derogatory use</u> would have tendency to <u>lessen respect/dilute goodwill</u> in a substantial portion of community. Offence would result from <u>injured national identity &amp; pride</u>	Definition 2 Thing that has established <u>such recognition and/or respect</u> within the Australian Community that its protection as a national treasure would be <u>appropriate</u> .	Definition 3 Thing which has national recognition such that a substantial body of the Australian community would <u>respect it as a national icon</u> .	Definition 4 Thing recognised by the Australia community as <u>embracing or being recognisable as a nationally accepted icon</u> .	Definition 5 Thing which is recognised by a substantial body (substantially all?) of the Australian Community as being <u>entwined with, representing or capturing some part of (uniquely?) Australian spirit or culture</u> to an extent that it is now in the <u>public interest</u> to protect it as a national treasure/icon.	Definition 6/7 Thing which is recognised by a substantial body (substantially all?) of the Australian community as being now and in the foreseeable future entwined with, representing or capturing some part of <u>uniquely Australian heritage, spirit, character or culture</u> , to such an extent/to an extent sufficient for it to be in the <u>public interest</u> to recognise and appropriately protect it as a national treasure.	Definition 8 Thing which is recognised by a body of the Australian community as <u>representing or typifying</u> some part of valued Australian heritage, spirit, character or culture to an <u>extent that is now useful</u> to be recognised and appropriately protected as a national treasure.
Sir Donald Bradman	✗?	✓	✓	✓	✗	✗	✓
Vegemite	✗	✓	✗	✗	✗	✗	✗
Digeridoo	✗	✓	✗	✓	✗	✗	✓

## ATTACHMENT 3

ICON	Definition 1	Definition 2	Definition 3	Definition 4	Definition 5	Definition 6/7	Definition 8
	<p>Thing of such importance to Australian culture that <u>derogatory use</u> would have tendency to <u>lessen respect/dilute goodwill</u> in a substantial portion of community. Offence would result from <u>injured national identity &amp; pride</u>.</p>	<p>Thing that has established <u>such recognition and/or respect</u> within the Australian Community that its protection as a national treasure would be <u>appropriate</u>.</p>	<p>Thing which has national recognition such that a substantial body of the Australian community would <u>respect it as a national icon</u>.</p>	<p>Thing recognised by the Australia community as <u>embracing or being recognisable as a nationally accepted icon</u>.</p>	<p>Thing which is recognised by a substantial body (substantially all?) of the Australian Community as being <u>entwined with, representing or capturing some part of (uniquely?) Australian spirit or culture</u> to an extent that it is now in the <u>public interest</u> to protect it as a national treasure/icon.</p>	<p>Thing which is recognised by a substantial body (substantially all?) of the Australian community as being now and in the foreseeable future entwined with, representing or capturing some part of <u>uniquely Australian heritage, spirit, character or culture</u>, to such an extent/to an extent sufficient for it to be in the <u>public interest</u> to recognise and appropriately protect it as a national treasure.</p>	<p>Thing which is recognised by a body of the Australian community as <u>representing or typifying</u> some part of valued Australian heritage, spirit, character or culture to an <u>extent that is now useful</u> to be recognised and appropriately protected as a national treasure.</p>
Uluru	✘?	✓	✓	✓	✓	✓	✓
Ned Kelly	✘?	✓	✓?	✓	✘?	✘?	✓
Andy Thomas (Astronaut)	✘	✘	✘	✘	✘	✘	✘

## ATTACHMENT 3

ICON	Definition 1	Definition 2	Definition 3	Definition 4	Definition 5	Definition 6/7	Definition 8
	<p>Thing of such importance to Australian culture that <u>derogatory use</u> would have tendency to <u>lessen respect/dilute goodwill</u> in a substantial portion of community. Offence would result from <u>injured national identity &amp; pride</u>.</p>	<p>Thing that has established <u>such recognition and/or respect</u> within the Australian Community that its protection as a national treasure would be <u>appropriate</u></p>	<p>Thing which has national recognition such that a substantial body of the Australian community would <u>respect it as a national icon</u>.</p>	<p>Thing recognised by the Australia community as <u>embracing or being recognizable as a nationally accepted icon</u>.</p>	<p>Thing which is recognised by a substantial body (substantially all?) of the Australian Community as being <u>entwined with, representing or capturing some part of (uniquely?) Australian spirit or culture</u> to an extent that it is now in the <u>public interest</u> to protect it as a national treasure/con.</p>	<p>Thing which is recognised by a substantial body (substantially all?) of the Australian community as being now and in the foreseeable future entwined with, representing or capturing some part of <u>uniquely Australian heritage, spirit, character or culture</u>, to such an extent/to an extent sufficient for it to be in the <u>public interest</u> to recognise and appropriately protect it as a national treasure.</p>	<p>Thing which is recognised by a body of the Australian community as <u>representing or typifying</u> some part of valued Australian heritage, spirit, character or culture to an <u>extent that is now useful</u> to be recognised and appropriately protected as a national treasure.</p>
Waltzing Matilda	✓	✓	✓	✓	✓	✓	✓
ANZAC	✓	✓	✓	✓	✓	✓	✓
Digger (referring to returned soldiers)	✓ ?	✓	✓	✓	✓ ?	✓ ?	✓

## ATTACHMENT 3

ICON	Definition 1	Definition 2	Definition 3	Definition 4	Definition 5	Definition 6/7	Definition 8
	Thing of such importance to Australian culture that <u>derogatory use</u> would have tendency to <u>lessen respect/dilute goodwill</u> in a substantial portion of community. Offence would result from <u>injured national identity &amp; pride</u> .	Thing that has established <u>such recognition and/or respect</u> within the Australian Community that its protection as a national treasure would be <u>appropriate</u> .	Thing which has national recognition such that a substantial body of the Australian community would <u>respect it as a national icon</u> .	Thing recognised by the Australia community as <u>embracing or being recognisable as a nationally accepted icon</u> .	Thing which is recognised by a substantial body (substantially all?) of the Australian Community as being <u>entwined with, representing or capturing some part of (uniquely?) Australian spirit or culture</u> to an extent that it is now in the <u>public interest</u> to protect it as a national treasure/icon.	Thing which is recognised by a substantial body (substantially all?) of the Australian community as being now and in the foreseeable future entwined with, representing or capturing some part of <u>uniquely Australian heritage, spirit, character or culture</u> , to such an extent/to an extent sufficient for it to be in the <u>public interest</u> to recognise and appropriately protect it as a national treasure.	Thing which is recognised by a body of the Australian community as <u>representing or typifying</u> some part of valued Australian heritage, spirit, character or culture to an <u>extent that is now useful</u> to be recognised and appropriately protected as a national treasure.
National Anthem	✓	✓	✓	✓	✓	✓	✓
Last Post (not exclusively Australian)	✗	✗	✗	✗	✗	✗	✗
Coat-of-Arms	✓	✓	✓	✓	✓	✓	✓

## ATTACHMENT 3

ICON	Definition 1	Definition 2	Definition 3	Definition 4	Definition 5	Definition 6/7	Definition 8
	<p>Thing of such importance to Australian culture that <u>derogatory use</u> would have tendency to <u>lessen respect/dilute goodwill</u> in a substantial portion of community. Offence would result from <u>injured national identity &amp; pride</u>.</p>	<p>Thing that has established <u>such recognition and/or respect</u> within the Australian Community that its protection as a national treasure would be <u>appropriate</u>.</p>	<p>Thing which has national recognition such that a substantial body of the Australian community would <u>respect it as a national icon</u>.</p>	<p>Thing recognised by the Australia community as <u>embracing or being recognisable as a nationally accepted icon</u>.</p>	<p>Thing which is recognised by a substantial body (substantially all?) of the Australian Community as being <u>entwined with, representing or capturing some part of (uniquely?) Australian spirit or culture</u> to an extent that it is now in the <u>public interest</u> to protect it as a national treasure/icon.</p>	<p>Thing which is recognised by a substantial body (substantially all?) of the Australian community as being now and in the foreseeable future entwined with, representing or capturing some part of <u>uniquely Australian heritage, spirit, character or culture</u>, to such an extent/to an extent sufficient for it to be in the <u>public interest</u> to recognise and appropriately protect it as a national treasure.</p>	<p>Thing which is recognised by a body of the Australian community as <u>representing or typifying</u> some part of valued Australian heritage, spirit, character or culture to an <u>extent that is now useful</u> to be recognised and appropriately protected as a national treasure.</p>
Opera House	✗?	✓	✓	✓	✓?	✓?	✓
Parliament House	✗	✓	✓	✓	✓	✓	✓
Eureka Flag	✗?	✗?	✓	✓	✗	✗	✗

## ATTACHMENT 3

ICON	Definition 1	Definition 2	Definition 3	Definition 4	Definition 5	Definition 6/7	Definition 8
	Thing of such importance to Australian culture that <u>derogatory use</u> would have tendency to <u>lessen respect/dilute goodwill</u> in a substantial portion of community. Offence would result from <u>injured national identity &amp; pride</u> .	Thing that has established <u>such recognition and/or respect</u> within the Australian Community that its protection as a national treasure would be <u>appropriate</u> .	Thing which has national recognition such that a substantial body of the Australian community would <u>respect it as a national icon</u> .	Thing recognised by the Australia community as <u>embracing or being recognisable as a nationally accepted icon</u> .	Thing which is recognised by a substantial body (substantially all?) of the Australian Community as being <u>entwined with, representing or capturing some part of (uniquely?) Australian spirit or culture</u> to an extent that it is now in the <u>public interest</u> to protect it as a national treasure/icon.	Thing which is recognised by a substantial body (substantially all?) of the Australian community as being now and in the foreseeable future entwined with, representing or capturing some part of <u>uniquely Australian heritage, spirit, character or culture</u> , to such an extent/to an extent sufficient for it to be in the <u>public interest</u> to recognise and appropriately protect it as a national treasure.	Thing which is recognised by a body of the Australian community as <u>representing or typifying</u> some part of valued Australian heritage, spirit, character or culture to an <u>extent that is now useful</u> to be recognised and appropriately protected as a national treasure.
Southern Cross	✗	✓	✓	✓	✓	✓	✓
Aboriginal Flag	✗?	✓	✓?	✓	✓	✓	✓
Milla Milla Falls (Geographic feature)	✗	✗	✗	✗	✗	✗	✗

## ATTACHMENT 3

ICON	Definition 1	Definition 2	Definition 3	Definition 4	Definition 5	Definition 6/7	Definition 8
	<p>Thing of such importance to Australian culture that <u>derogatory use</u> would have tendency to <u>lessen respect/dilute goodwill</u> in a substantial portion of community. Offence would result from <u>injured national identity &amp; pride</u>.</p>	<p>Thing that has established <u>such recognition and/or respect</u> within the Australian Community that its protection as a national treasure would be <u>appropriate</u>.</p>	<p>Thing which has national recognition such that a substantial body of the Australian community would <u>respect it as a national icon</u>.</p>	<p>Thing recognised by the Australia community as <u>embracing or being recognisable as a nationally accepted icon</u>.</p>	<p>Thing which is recognised by a substantial body (substantially all?) of the Australian Community as being <u>entwined with, representing or capturing some part of (uniquely?) Australian spirit or culture</u> to an extent that it is now in the <u>public interest</u> to protect it as a national treasure/icon.</p>	<p>Thing which is recognised by a substantial body (substantially all?) of the Australian community as being now and in the foreseeable future entwined with, representing or capturing some part of <u>uniquely Australian heritage, spirit, character or culture</u>, to such an extent/to an extent sufficient for it to be in the <u>public interest</u> to recognise and appropriately protect it as a national treasure.</p>	<p>Thing which is recognised by a body of the Australian community as <u>representing or typifying</u> some part of valued Australian heritage, spirit, character or culture to an <u>extent that is now useful</u> to be recognised and appropriately protected as a national treasure.</p>
Kangaroos	✗	✓	✓	✓	✓?	✓?	✓
Australian National Flag	✓	✓	✓	✓	✓	✓	✓

## ATTACHMENT 3

ICON	Definition 1	Definition 2	Definition 3	Definition 4	Definition 5	Definition 6/7	Definition 8
	<p>Thing of such importance to Australian culture that <u>derogatory use</u> would have tendency to <u>lessen respect/dilute goodwill</u> in a substantial portion of community. Offence would result from <u>injured national identity &amp; pride</u>.</p>	<p>Thing that has established <u>such recognition and/or respect</u> within the Australian Community that its protection as a national treasure would be <u>appropriate</u>.</p>	<p>Thing which has national recognition such that a substantial body of the Australian community would <u>respect it as a national icon</u>.</p>	<p>Thing recognised by the Australia community as <u>embracing or being recognisable as a nationally accepted icon</u>.</p>	<p>Thing which is recognised by a substantial body (substantially all?) of the Australian Community as being <u>entwined with, representing or capturing some part of (uniquely?) Australian spirit or culture</u> to an extent that it is now in the <u>public interest</u> to protect it as a national treasure/icon.</p>	<p>Thing which is recognised by a substantial body (substantially all?) of the Australian community as being now and in the foreseeable future entwined with, representing or capturing some part of <u>uniquely Australian heritage, spirit, character or culture</u>, to such an extent/to an extent sufficient for it to be in the <u>public interest</u> to recognise and appropriately protect it as a national treasure.</p>	<p>Thing which is recognised by a body of the Australian community as <u>representing or typifying</u> some part of valued Australian heritage, spirit, character or culture to an <u>extent that is now useful</u> to be recognised and appropriately protected as a national treasure.</p>
State Flags	✓	✓	✓	✓	✓	✓	✓
CSIRO	✗	✓	✓	✓	✓	✓	✓

**POSSIBLE USES FOR PROTECTION OF NATIONAL ICONS OF CURRENT LEGISLATION,  
AMENDED CURRENT LEGISLATION AND SPECIFICALLY DESIGNED LEGISLATION (Attachment 4)**

<ul style="list-style-type: none"> <li>• <b>Current protection</b></li> <li>• <b>Effect of 'derogatory use' legislation</b></li> <li>• <b>Useful amendments to current law</b></li> </ul>	<b>Commercial use of icon by all allowable — no exclusive use available to one person or body</b>	<b>No commercial use of the icon</b>	<b>Commercial use restricted to one or more parties having a particular relationship with the icon</b>
<p><b>Current protection:</b></p> <ul style="list-style-type: none"> <li>• Current trade mark registrations are extant.</li> <li>• Common law trade marks possible and consequently passing off actions may be available.</li> </ul> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would protect against derogatory use of the words.</li> <li>• Would not prevent the possibility of passing off actions by one trade mark owner against another.</li> <li>• Would not prevent the registration of a trade mark for the words.</li> <li>• Would not prevent exclusivity through the registration of a company, business or domain name.</li> </ul> <p><b>Useful amendments to current law:</b></p> <ul style="list-style-type: none"> <li>• Listing under section 18 of the Trade Marks Act to prevent use as either a registered or common law trade mark - would not cover current trade marks (registered or common law). Would not allow use as a trade mark except to those with pre-existing rights.</li> <li>• New provision of the Trade Marks Act allowing the listing of 'non-exclusive trade marks'. Listing under such a provision would prevent registration of a trade mark containing or consisting of the icon and would also prevent passing off actions in</li> </ul>	<p><b>Waltzing Matilda (the words)</b></p>		

## ATTACHMENT 4

<p>common law. Amendment to the <i>Trade Practices Act 1974</i> would also need to be considered to prevent actions under sections 52 and 53 of the Trade Practices Act in respect of deceptive or misleading use of icons, as trade marks, in the course of trade. In effect, the word could be used as a trade mark but no rights would be enforceable against the use of the trade mark, as a trade mark, by others - all persons would have an equal right to use the term etc as a trade mark.</p> <ul style="list-style-type: none"> <li>• Listing as a mark notified by the International Union for the Protection of Industrial Property as not entitled to registration under international arrangements (ss 39(2) and reg 4.15(e) TM Act).</li> <li>• Prohibition as a business name.</li> <li>• Prohibition as a company name.</li> <li>• Prohibition as a domain name.</li> <li>• New provision of the TM Act prohibiting registration as a trade mark and the accruing of private rights as a trade mark — this would allow use as a trade mark but no private rights in the trade mark.</li> </ul>			
<p><b>Current protection:</b> Sufficient protection through:</p> <ul style="list-style-type: none"> <li>• <i>Protection of the word 'ANZAC' regulations.</i></li> <li>• Listed under section 39(2) of TM Act as a word not to be registered as a trade mark.</li> <li>• Prohibition as a company name.</li> <li>• Customs provisions.</li> <li>• Prohibition as a domain name — on the auDA Reserved List.</li> </ul> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would provide no substantial extension of protection.</li> <li>• Would not prevent commercial use through the registration of a business or domain name.</li> <li>•</li> </ul> <p><b>Useful amendments to current law:</b></p> <ul style="list-style-type: none"> <li>• Listing under section 18 of the Trade Marks Act to prevent use as either a</li> </ul>		ANZAC	

## ATTACHMENT 4

<p>registered or common law trade mark - already effectively achieved.</p> <ul style="list-style-type: none"> <li>• Listing as a mark notified by the International Union for the Protection of Industrial Property as not entitled to registration under international arrangements (ss 39(2) and reg 4.15(e) TM Act)</li> <li>• Prohibition as a business name — already effectively achieved.</li> </ul>			
<p><b>Current protection:</b> Probably sufficient through:</p> <ul style="list-style-type: none"> <li>• Prohibition as a company name.</li> <li>• Registration of a trade mark for some goods/services.</li> <li>• Section 52/53 of the <i>Trade Practices Act 1974</i> and state and territory fair trading acts.</li> </ul> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would provide effective extra protection.</li> </ul> <p><b>Useful amendment to current law:</b></p> <ul style="list-style-type: none"> <li>• Availability of Part D registration as a trade mark for all goods in all classes not covered by existing standard registered trade marks.</li> </ul>			<b>Bradman</b>
<p><b>Current protection:</b> No current legal protection. Probably not sufficient although public opprobrium effective.</p> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would provide effective protection.</li> </ul> <p><b>Useful amendments to current law:</b></p> <ul style="list-style-type: none"> <li>• Addition to the <i>Protection of the word 'ANZAC' regulations</i> and/or</li> <li>• Listing under section 18 of the Trade Marks Act to prevent use as either a registered or common law trade mark.</li> <li>• Listing as a mark notified by the International Union for the Protection of Industrial Property as not entitled to registration under international arrangements</li> </ul>		<b>Digger</b>	

**ATTACHMENT 4**

<p>(ss 39(2) and reg 4.15(e) TM Act).</p> <ul style="list-style-type: none"> <li>• Prohibition as a company name</li> <li>• Prohibition as a business name</li> <li>• Prohibition as a domain name</li> </ul>			
<p><b>Current protection:</b></p> <ul style="list-style-type: none"> <li>• Ineffective copyright protection</li> <li>• Proclamation as the national anthem which carries no protection with it.</li> </ul> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would provide effective protection against derogatory use.</li> </ul> <p><b>Useful amendments to current law:</b></p> <ul style="list-style-type: none"> <li>• Deeming the music and words, and any similar music and words, to be the property of the Commonwealth would give the Commonwealth more control over use.</li> </ul>	<p><b>National Anthem</b> (Words and music)</p>		
<p><b>No current protection</b></p> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would provide effective protection of the title, tune and performance.</li> <li>• Would not protect against use or registration as a trade mark.</li> <li>• Would not prevent use of the title as a company name.</li> <li>• Would not prevent use of the title as a business name.</li> <li>• Would not prevent use of the title as a domain name.</li> </ul> <p><b>Useful amendments to current law:</b></p> <ul style="list-style-type: none"> <li>• Deeming the music and words, and any similar music and words, to be the property of the Commonwealth would give the Commonwealth more control over use.</li> </ul>		<p><b>Performance of <i>The Last Post</i></b></p>	

ATTACHMENT 4

<p><b>Current legislation may not be sufficient:</b></p> <ul style="list-style-type: none"> <li>• Granted by Royal Warrant 1912</li> <li>• Prohibited from registration as a trade mark under ss 39(2) of the TM Act and regulation 4.15(c).</li> <li>• Section 53(c),(d) and (e) of <i>Trade Practices Act 1974</i>.</li> <li>• Section 68 of <i>Crimes Act 1914</i>.</li> </ul> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would provide effective protection.</li> </ul> <p><b>Useful amendments to current law:</b></p> <ul style="list-style-type: none"> <li>• None</li> </ul>		<p><b>Commonwealth Coat of Arms</b></p>	
<p><b>Current protection:</b></p> <ul style="list-style-type: none"> <li>• Representations in material form can be subject of copyright protection.</li> <li>• Trade mark registration available.</li> <li>• Can be the subject of a common law trade mark and passing off actions.</li> <li>• Actions under the <i>Trade Practices Act 1974</i> for conduct likely to deceive or cause confusion.</li> </ul> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would provide adequate protection for the purposes of national icon protection.</li> <li>• Would not protect against use or registration as a trade mark.</li> <li>• Would not prevent use of the title as a company name.</li> <li>• Would not prevent use of the title as a business name.</li> <li>• Would not prevent use of the title as a domain name.</li> </ul> <p><b>Useful amendments to current law:</b></p> <ul style="list-style-type: none"> <li>• None required.</li> </ul>	<p><b>Uluru</b> (name and images)</p>		
<p><b>Current protection:</b></p> <ul style="list-style-type: none"> <li>• Registered trade mark.</li> <li>• Famous trade mark.</li> </ul>			

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**ATTACHMENT 4**

<ul style="list-style-type: none"> <li>• Would have common law trade mark rights also - passing off action possible.</li> <li>• Section 52 of Trade Practices Legislation.</li> </ul> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would be effective against derogatory use.</li> </ul> <p><b>Useful amendments to current law:</b> None required.</p>			<p><b>Vegemite</b></p>
<p><b>Current protection:</b></p> <ul style="list-style-type: none"> <li>• Several trade marks already registered - some to the Sydney Opera House trust - others to members of the public who have no official connection to the Sydney Opera House.</li> <li>• Common law trade mark protection possible.</li> <li>• Copyright in design still current? Who owns it?</li> <li>• Copyright protection for any representation in material form that is not a copy of another such representation.</li> </ul> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would be effective against derogatory use.</li> </ul> <p><b>Useful amendments to current law:</b></p> <ul style="list-style-type: none"> <li>• May not be appropriate to deem copyright in a series of representations as there are so many ways to depict the Opera House that such deeming may be an ineffective exercise. However, it may be useful to deem copyright in some fairly straightforward representations. This may be impacted by any continuing ownership of the architectural plans by a party other than government, eg, architects.</li> </ul>	<p><b>Sydney Opera House</b></p>		
<p><b>Current protection:</b></p> <ul style="list-style-type: none"> <li>• Several trade marks already registered depicting the Parliament House, particular emphasis on flag pole. Common law trade mark protection possible.</li> </ul>			

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**ATTACHMENT 4**

<ul style="list-style-type: none"> <li>• Copyright in design still current? Who owns it?</li> <li>• Copyright protection for any representation in material form that is not a copy of another such representation.</li> </ul> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would be effective against derogatory use.</li> </ul> <p><b>Useful amendments to current law:</b></p> <ul style="list-style-type: none"> <li>• May not be appropriate to deem copyright in a series of representations as there are so many ways to depict the Parliament House that such deeming may be an ineffective exercise. However, it may be useful to deem copyright in some fairly straightforward representations. This may be impacted by any continuing ownership of the architectural plans by a party other than government, eg, architects.</li> </ul>	<p><b>Parliament House</b></p>		
<p><b>Current protection:</b></p> <ul style="list-style-type: none"> <li>• Several trade marks already registered that incorporate the Eureka Flag.</li> <li>• Common law trade mark protection possible.</li> <li>• Copyright protection available for any representation in material form that is not a copy of another such representation.</li> </ul> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would be effective against derogatory use.</li> </ul> <p><b>Useful amendments to current law:</b></p> <ul style="list-style-type: none"> <li>• Listing under section 18 of the Trade Marks Act to prevent use as either a registered or common law trade mark - would not cover current trade marks (registered or common law).</li> </ul>	<p><b>Eureka Flag (Image)</b></p>		

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**ATTACHMENT 4**

<ul style="list-style-type: none"> <li>• Listing as a mark notified by the International Union for the Protection of Industrial Property as not entitled to registration under international arrangements (ss 39(2) and reg 4.15(e) TM Act)</li> </ul>			
<p><b>Current protection:</b></p> <ul style="list-style-type: none"> <li>• Very many trade marks already registered that incorporate the words or image, or both, of the Southern Cross.</li> <li>• Common law trade mark protection possible.</li> <li>• Copyright protection available for any representation in material form that is not a copy of another such representation.</li> </ul> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would be effective against derogatory use.</li> </ul> <p><b>Useful amendments to current law:</b></p> <ul style="list-style-type: none"> <li>• Listing under section 18 of the Trade Marks Act to prevent use as either a registered or common law trade mark - would not cover current trade marks (registered or common law).</li> <li>• Listing as a mark notified by the International Union for the Protection of Industrial Property as not entitled to registration under international arrangements (ss 39(2) and reg 4.15(e) TM Act)</li> <li>• Prohibition of the words as a company name — (already effective as registered as a company name).</li> <li>• Prohibition of the words as a business name.</li> <li>• Prohibition of the words as a domain name.</li> </ul>	<p><b>Southern Cross Constellation (Image and words)</b></p>		
<p><b>Current protection:</b></p> <ul style="list-style-type: none"> <li>• Copyright owned Mr Harold Thomas, a Luritja man, originally from Central Australia. Mr Thomas designed the flag in 1971.</li> <li>• The Aboriginal flag is increasingly being flown by both Aboriginal and</li> </ul>			

## ATTACHMENT 4

<p>non-Aboriginal people. In view of its increasing importance in Australian society, the Government initiated steps in 1994 to give the flag legal recognition. After a period of public consultation, the Government made its own decision in July 1995 that the flag should be proclaimed a "Flag of Australia" under section 5 of the <a href="#">Flags Act 1953</a>. The flag was so proclaimed by the Governor General of Australia, William Hayden, on 14 July 1995.</p> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would be effective against derogatory use.</li> </ul> <p><b>Useful amendments to current law:</b></p> <ul style="list-style-type: none"> <li>• Listing under section 18 of the Trade Marks Act to prevent use as either a registered or common law trade mark - would not cover current trade marks (registered or common law).</li> <li>• Listing as a mark notified by the International Union for the Protection of Industrial Property as not entitled to registration under international arrangements (ss 39(2) and reg 4.15(e) TM Act)</li> </ul>			<b>Aboriginal Flag</b>
<p><b>Current protection:</b></p> <ul style="list-style-type: none"> <li>• Several trade marks already registered that incorporate the words 'Ned Kelly' and/or the image of Ned Kelly and/or his armour.</li> <li>• Common law trade mark protection possible.</li> <li>• Copyright protection available for any representation in material form that is not a copy of another such representation.</li> </ul> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would be effective against derogatory use - but would it be appropriate given the ambiguous nature of the character?</li> </ul> <p><b>Useful amendments to current law:</b></p>	<b>Ned Kelly</b>		

**ATTACHMENT 4**

<ul style="list-style-type: none"> <li>• None.</li> </ul>			
<p><b>Current protection:</b></p> <ul style="list-style-type: none"> <li>• Huge variety of registered trade marks incorporating a huge range of representations of kangaroos and/or emus.</li> <li>• Common law trade mark protection possible.</li> <li>• Copyright protection available for any representation in material form that is not a copy of another such representation.</li> </ul> <p><b>Effect of 'derogatory use' legislation:</b></p> <ul style="list-style-type: none"> <li>• Would be effective against derogatory use.</li> </ul> <p><b>Useful amendments to current law:</b></p> <ul style="list-style-type: none"> <li>• None.</li> </ul>	<p><b>Kangaroos</b> <b>Emus</b></p>		

## PROPOSED SYSTEM FOR NATIONAL ICON SELECTION

### (Attachment 5)

#### **1 Proposed system for national icon selection**

1.1 It is essential that any process of selection of national icons has the full confidence and support of the general Australian population. To be acceptable and gain the respect of the community the process of selection would need to be a transparent, equitable and rigorous process that results in consistent, broadly accepted outcomes. A system for icon selection, whatever the regime of protection applied, would need to consist of processes for:

- decision making
- nomination of icons
- developing criteria for listing and any consultation processes involved
- penalties for misuse
- review of icon status

#### 1.2 Decision making

1.2.1 In view of the requirements that icon selection must be transparent and the results acceptable to the population as a whole, ACIP considers that a decision making body would be required to support the decision making process along the same lines as the current Australian Honours system would be appropriate. Just as for the honours system, the Governor General would be the appropriate person to make decisions relating to nationally important symbols such as the granting of icon status. It is suggested a panel of eminent Australians be appointed to advise the Governor General on what names, images etc he/she should grant national icon status.

1.2.2 Such a body would be similar in concept to the Council for the Order of Australia (the COA). The COA is an independent advisory body that meets twice a year to consider *every* nomination made for an Order of Australia award and which makes recommendations to the Governor General on who should receive the awards. Part of the Council's responsibility is to also recommend the level of the award.

1.2.3 The COA consists of 19 members from across Australia and includes a number of public office holders, representatives from each state and territory, and eight community representatives who are appointed by the Governor General on the recommendation of the Prime Minister. Its diversity is considered to give the COA a national perspective and its independence is considered to remove the selection process from political patronage.

1.2.4 In the Order of Australia system the Governor General's role, under the constitution of the Order of Australia is to administer the system and authorise, acting on the advice of the COA, the giving of the awards.

14.2.5 The COA is supported by the Honours Secretariat which thoroughly researches the achievements and community contribution of the nominees, including contacting all referees listed in the nomination. It is envisaged that a similar Secretariat would be necessary to support an icons listing process. The role of such a Secretariat would be, broadly, to receive nominations on behalf of the Governor General, research all nominations thoroughly, co-ordinate any public consultation processes involved, monitor use of icons and deal with complaints about their use, including passing on any complaints to the appropriate legal authority. An icons secretariat may initially have a large workload as the first flush of nominations are made but, given the relatively rare nature of national icons, the ongoing work of the secretariat would be expected to relate mainly to its monitoring and review tasks.

1.2.6 A set of selection criteria would need to be developed for use by nominators and for the guidance of the panel in their decision making. They would set a suitably high standard for the granting of icon status and would lead to results broadly acceptable to the community as a whole. The criteria would have to be specific enough to enable transparent and, as far as possible, clear-cut decisions to be made. It is suggested that, in light of the above aims, the criteria should be developed after public submissions and consultation with particular interest groups such as heritage organisations, intellectual property owners and professionals and broad based community organisations.

### 1.3 Nomination process

1.3.1 It would be very important for the success of an icons system that the process is accepted as being a fully democratic one in which *all* Australians have the right to participate. To that end it would be appropriate, as for the Australian Order of Australia nomination process, to allow nominations from *any* member of the public, including from groups and organisations. A nomination would, however, need to set out, against the criteria for icon status, why the nominator considers that the nomination should be given icon status. Nominations which fail to do this would be rejected at the lodgement stage and would not be considered by the panel or Governor General. It is suggested that assistance in the form of a comprehensive information package could be made available to prospective nominators.

1.3.2 If the ability of any person to nominate was considered too open because of the amount of work it might generate for the panel, some limiting factor such as a requirement that a petition containing a threshold number of signatures would be needed to start the nomination process, could be instituted.

1.3.3 Notwithstanding the development of rigorous and widely accepted criteria, the results of particular decisions, whichever way they are decided, might still cause controversy. It is clearly a risk that such controversy could, itself, have a detrimental effect both on the icon under consideration and the process of icon selection itself. Putting into place measures to prevent acrimonious and damaging debate about listing is a major consideration in the development of such a process.

1.3.4 In view of this, a measure that may lessen negative feelings would be the inclusion of an extensive period and process of public consultation after the panel has made a preliminary decision to recommend the listing of an icon to the Governor General, ie, prior to the panel making its final recommendation. This should help to reduce negative impacts that a particular decision may have. It would also assist in the consideration of the rights of other parties and possible unintended consequences that might arise from protection. In contrast to the Order of Australia awards system, any person or body associated with the nominated icon would need to be included in the consultation processes.

1.3.5 As for the Order of Australia awards, it is not considered appropriate to allow appeal mechanisms once a final decision by the Governor General to grant icon status or not to do so is made. The public consultation phase should be sufficient to bring to light any possible unintended or otherwise negative consequences of listing for consideration by the panel before their final recommendation to the Governor General is made.

1.3.6 Where the panel decides not to recommend an icon for listing and the Governor General does not list it, the Governor General would inform the nominator of the decision and, possibly, the reasons for the decision, however, no further debate on the issue would be entered into. Therefore, as for decisions to grant icon status, the panel would make its recommendations to the Governor General and the Governor General's decision would be final and not appealable.

#### 1.4 Penalties

1.4.1 It would appear that in all cases of inappropriate or unauthorised use of an icon the desired relief is that the problem use should stop. It would therefore appear that injunctive relief to prevent or stop the behaviour, or if the case required to order certain other behaviour, would be the most appropriate type of penalty for misuse of an icon. Civil penalties in the form of civil fines may also be appropriate and consideration could be given to other penalties such as public apologies for the misuse. ACIP considers, however, that criminalisation of inappropriate behaviour would be likely to carry a strong risk of being viewed as overbearing and a disproportionate response to the issues involved.

1.4.2. It would be necessary for the icons secretariat to monitor the use of icons and deal with complaints by the public regarding alleged misuse. It is also suggested that the Prime Minister, possibly on the recommendation of the Secretariat would make recommendations to the Attorney-General requesting the Attorney to investigate the matter and, if he or she considers it appropriate, the Attorney would institute civil action against a person misusing a national icon.

1.4.3 Where a body or person particularly associated with an icon had the exclusive right to use the icon in, eg, a commercial context such as with the *Bradman* name, consideration should be given as to whether the person or body having that right should have the responsibility of taking action against any misuse.

## 1.5 Review of icon status

1.5.1 Clearly there will be a need for icon status to be reviewed and a decision made as to whether the icons listed should retain the status or be removed from the list of icons. There is a real possibility that icons, particularly those associated with people, could lose their status in the eyes of the public. A number of factors could lead to this, such as the subsequent behaviour of a person related to an icon, previous behaviour that was not public knowledge at the time icon status was granted, shifting community values or simply that the passing of time rendering the icon irrelevant or of less importance than it was in a previous time. The review process would need to be flexible and could take place:

- on a regular basis, eg, at least every 5 years;
- at any time on the basis of a request for review by a person aggrieved; and/or
- at any time on the basis of a decision by the panel to review the status because of the circumstances at the time.

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1.5.2 The review could be carried out by a similar process to the initial listing and could include public consultation as an important element. Once the panel had decided, after a reconsideration of the icon criteria vis a vis the icon in question, that it had come to a preliminary view to either retain or delist the icon, a public consultation phase would be advisable to further gauge the icon's value in the public's mind. The panel would make its final recommendation to the Governor General based on its own deliberations and the issues that arose in the public consultations.

## CONSTITUTIONAL ISSUES (Attachment 6)

### 1 Introduction

1.1 Whether the protection of icons is achievable purely by Commonwealth Government legislation will depend on whether sufficient authority can be found for it under the Constitution of the Commonwealth of Australia (the Constitution). This will depend on what protection is required and the means available to support such protection. The Constitution does not confer on the Commonwealth Parliament the power to make laws on all subjects. Instead, it lists the subjects about which the Commonwealth Parliament can make laws (the enumerated powers). Most of these are listed in sections 51 and 52. The subject matter the Commonwealth may legislate on include, eg, taxation (para 51(ii)); interstate and international trade (para 51(i)); foreign, trading and financial corporations (para 51(xx)) and copyrights, patents of inventions and designs and trade marks (para 51(xviii)).

1.2 In as far as any icon protection can be achieved by use of current intellectual property rights such as trade marks, copyright or designs, the Commonwealth is, subject to the other provisions of the Constitution, free to legislate as it sees fit regarding such rights under paragraph 51(xviii). However, where such protection cannot be characterised as one of the intellectual property rights included under the terms of paragraph 51(xviii), other heads of power will have to be called on to render the provisions constitutional. The other powers that could be useful in such an exercise would include:

- the executive power of the Commonwealth in section 61 combined with the 'incidental' power in paragraph 51(xxxix);
- the interstate and overseas trade and commerce power (paragraph 51(i));
- the postal, telegraphic, telephonic and other like services power (paragraph 51(v));
- foreign corporations, and trading or financial corporations power (paragraph 51(xx)); and
- the territories power (section 122)

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1.3 Such powers can only be exercised to the extent possible under the Constitution itself. For example, the above powers are subject to paragraph 51(xxxi) requiring that any acquisition of property by the Commonwealth must be on just terms. They are also subject to the implied freedom to discuss political and governmental matters.

1.4 The executive power of the Commonwealth in section 61, combined with the 'incidental' power would, if it applied, provide comprehensive constitutional authority. If it does not apply, then the corporations and other powers mentioned in the above dot points would allow substantial coverage but may leave some gaps, eg, the use of icons by individuals in some limited instances may remain unaffected by any legislation, even though use by corporations could probably be effectively controlled.

## 2 The executive and incidental powers

2.1 Section 61 of the Constitution provides that the executive power of the Commonwealth extends to the execution and maintenance of the Constitution and the laws of the Commonwealth. In order to assist the prosecution of the executive's aims, the Commonwealth Parliament may use its powers in paragraph 51(xxxix) to make laws with respect to:

Matters incidental to the execution of any power vested by this Constitution in the Parliament or in either House thereof, or in the Government of the Commonwealth, or in the Federal Judicature, or in any department or officer of the Commonwealth.

2.2 As stated by Mason J in *Victoria v The Commonwealth and Hayden*<sup>25</sup> the combined effect of these powers (the 'combined executive power') is that:  
.... There is to be deduced from the existence and character of the Commonwealth as a national government and from the presence of ss 51(xxxix) and 61 a capacity to engage in enterprises and activities peculiarly adapted to the government of a nation and which cannot otherwise be carried on for the benefit of the nation.

2.3 In *Davis v Commonwealth*<sup>26</sup>, following on from Dixon J in the *Australian Communist Party* case,<sup>27</sup> three of the judges considered that there was a further implied 'nationhood' power separate from the 'combined executive power'. Such a 'nationhood' power would go beyond the specific powers conferred upon the Parliament and include such powers as may be deduced from the establishment and nature of the Commonwealth as a polity. It is not considered necessary to discuss this question any further as it is very doubtful whether the argument about whether there is a 'nationhood' power or not has any substantive impact on the question at hand.

2.4 In *Davis* all members of the court agreed that the combined executive power would allow the Commonwealth to make laws facilitating the commemoration of the bicentennial of the settlement of Australia. Commemoration of the Bicentenary was considered pre-eminently the business and the concern of the Commonwealth as the national government — it was considered to fall full square within the combined executive power.

2.5 However, in *Davis*, the court found that the major provisions of the *Australian Bicentennial Authority Act 1980* had to be struck down because the provisions were not constitutional. This is because they were not proportionate to the legitimate aims and objectives of the legislation. The court found that:

...Although the statutory regime may be related to a constitutionally legitimate end, the provisions in question reach too far. This extraordinary intrusion into the freedom of expression is not reasonably and appropriately adapted to achieve the ends that lie within the limits of the constitutional power.

<sup>25</sup> (1975) 134 CLR 338 at 397; 7 ALR 277.

<sup>26</sup> (1988) 166 CLR 79.

<sup>27</sup> *Australian Communist Party v The Commonwealth* (1951)

2.6 Because the legislation restricted people's right to use very common terms such as each of 'Sydney', 'Melbourne', '1788', '1988' in combination, the legislation was found to be beyond the scope of constitutional power. For example, the court found that an advertisement for the Family Law Conference in Melbourne in 1988 would have contravened the legislation. This was clearly beyond what was necessary to protect the integrity of the Bicentennial celebrations.

2.7 *Davis* indicated that if a regulatory provision is reasonably incidental, or proportionate to the Commonwealth's legitimate purpose, the provision can be validly enforced by a penal sanction. However, this view has been questioned in *R v Hughes*<sup>28</sup> where the criminal sanctions included in the then Corporations Law, a co-operative Commonwealth/State scheme, were seriously questioned. Justice Kirby, eg, questioned whether the execution of executive power could give a firm enough foundation of constitutional authority to support criminal liability and punishment provisions. If an icons protection scheme were to be introduced, and penal provisions required, the question as to whether criminal sanctions would be constitutional would have to be thoroughly investigated.

2.8 Whether icons protection could be supported by the combined executive power will depend primarily on whether such protection could be characterised as an enterprise or activity peculiarly adapted to the government of a nation and which could not otherwise be carried on for the benefit of the nation (see *Victoria v Commonwealth* above). An alternative formulation would be whether icons legislation would be considered pre-eminently the business and the concern of the Commonwealth as the national government. Such a judgement would require some consideration of what a national government's purpose is and the benefit to the nation that might be gained from such legislation. If the protection of icons could be equated in national significance to the celebration of the Bicentennial, then the combined executive power may well support such legislation. However, it is suggested that the character of the icons to be protected may well have to be of overwhelming national significance to attract constitutional support. If a proposal to protect icons goes further this issue will need more detailed consideration including, it is suggested, the opinion of constitutional experts.

2.9 As an interesting aside, in a discussion in the *Tasmanian Dams* case,<sup>29</sup> justices Wilson and Deane expressed their view that the appropriation power (section 81, the Constitution) or the nationhood power, or some combination of them could be used for a wide range of purposes relating to the 'protection, preservation or promotion' of some 'particular physical property or artistic, intellectual, scientific or sporting achievement or endeavour'. This discussion was in the context of protection by legislation of World Heritage sites under an international convention. They commented, however, that although they considered the scope of the power to be wide, the legislative use that could be made of the power would be limited. It could not, they considered, allow the Commonwealth to arrogate to itself control of such property, achievement or endeavour. The power is essentially 'facultative'.

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<sup>28</sup>

<sup>29</sup> *Tasmania v Commonwealth* (1983) 158 CLR 1.

2.10 If the combined executive power is not available for the protection of icons, other heads of power would give partial coverage. That coverage may be sufficient to give *effective* coverage even though it is not *comprehensive*.

### **3 Corporations power**

3.1 Paragraph 51(xx) of the Constitution allows the Commonwealth Parliament to make laws in respect of 'foreign corporations, and trading or financial corporations formed within the limits of the Commonwealth.' This power has been interpreted to allow the Commonwealth to control only those companies that were already formed at the date of Federation. It does not allow the Commonwealth to legislate for companies formed after this, neither does it give the Commonwealth the power to regulate the incorporation process. These severe limitations on Commonwealth power have been overcome, until 2001, by a Commonwealth/State scheme of co-operative uniform corporations legislation referred to as the Corporations Law. Because the efficacy of that scheme was itself brought into question by the High Court, the States and Territories referred their powers regarding corporations to the Commonwealth under paragraph 51(xxxvii) of the Constitution in 2001. The last of the provisions of the new *Corporations Act 2001* (Corporations Act) to come into operation on 11 March 2001.

3.2 It would appear to be within the Commonwealth's corporations power to control the use made, by constitutional corporations, of specific icons in the course of, or for the purposes of, their trading or financial activities. Such activities are at the core of the constitutional power. A constitutional corporation would include a foreign corporation, a trading corporation, a financial corporation or a body corporate that is incorporated in a Territory. The corporations power would not be able to regulate the use of icons by individuals or bodies, such as associations or partnerships, that were not constitutional corporations. However, further coverage could be achieved by the trade and commerce, postal and territories powers.

### **4 Trade and Commerce power**

4.1 Paragraph 51(i) of the Constitution allows the Commonwealth Parliament to make laws in respect of '... trade and commerce with other countries, and among the States'. This would allow control of the use of icons for the purposes of constitutional trade or commerce. Constitutional trade or commerce would include:

- trade or commerce between Australia and a place outside Australia;
- trade or commerce between the States;
- trade or commerce within a Territory, between a State and a Territory or between two Territories; and
- supplying goods or services to the Commonwealth, a Territory, or to an authority or instrumentality of the Commonwealth or a Territory

4.1 This power does not cover trade and commerce within a state (intrastate trade). The term 'Trade and commerce' is given a very wide ambit and would exclude only matters preparatory to trade such as manufacture, production and mining. It is considered

## ATTACHMENT 6

that icons protection legislation purporting to control the use of icons in the course of trade and commerce would be allowable under this provision of the Constitution.

### **5 Postal, telegraphic, telephonic and other like services power**

5.1 Paragraph 51(v) of the Constitution allows the Commonwealth Parliament to make laws in respect of '...postal, telegraphic, telephonic, and other like services'. This head of Commonwealth power would enable Commonwealth legislation controlling the use of icons in relation to radio, television, postal, telephone and (presumably) internet advertising.

### **6 The Territories power**

6.1 Section 122 of the Constitution allows the Commonwealth to make laws for the government of any Territory. This head of Commonwealth power would support legislation controlling the use of icons by any person in a Territory. However, the Commonwealth is generally extremely reluctant to legislate 'over the top' of Territory governments, preferring to allow Territories the same level of independence as States. However, if the issue is of high enough priority, such as euthanasia — one of the few examples in recent years — the Commonwealth will legislate for the Territories, even to the extent of overturning legislation passed by Territory governments.

### **7 Freedom of political communication**

7.1 A very important consideration in the development of any icons protection is that such protection must not contravene the implied freedom of political communication contained in the Constitution. The High Court has found that the text and structure of the Constitution, in particular the provisions which create a system of representative and responsible government, (ss 7, 24, 64 and 128) give rise to an implication that there is an absolute freedom to discuss political and governmental matters. In deciding whether the freedom is contravened the court will first ask whether the law effectively burdens the freedom of communication about government or political matters in its terms, operation or effect. If it does, the court will then ask whether the law is reasonably appropriate and adapted to serve a legitimate end, the fulfilment of which is compatible with the maintenance of the constitutionally prescribed system of representative government and the procedure prescribed by section 128 for submitting a proposed amendment of the Constitution to the informed decision of the people. If the answer to the first question is 'yes' and the second 'no', then the person allegedly contravening the law will be immune from it.

7.2 Although the *Davis* case was decided prior to the finding of the freedom of political communication, it is clear that the legislation in that case was contrary to such a freedom. In that case an Aboriginal person used some of the prescribed symbols as a protest against, or comment on, the effects of white settlement on Aboriginal society. It is clear that the absolute prohibition on the use of the common terms in that legislation would, today, clearly be found invalid with respect to Mr Davis due to the effect of the legislation contravening the freedom of political communication.

## **8 Conclusion**

8.1. If it was to apply, the combined executive power would provide a comprehensive power supporting icon protection legislation. As stated above, the question as to whether it would apply would depend on whether such a law could be characterised as an enterprise or activity peculiarly adapted to the government of a nation and which could not otherwise be carried on for the benefit of the nation (see *Victoria v Commonwealth* above). An alternative formulation would be whether icons legislation would be considered pre-eminently the business and the concern of the Commonwealth as the national government. A judgement on whether icons legislation could be so characterised may be more possible once the parameters of the protection are more defined than currently.

8.2 If the combined executive power could not support such legislation then a fairly comprehensive support for such legislative protection would be able to be achieved from a combination of the other provisions mentioned (sections 9.3-9.6). The legislation would be able to control use by constitutional corporations, a person in the course of constitutional trade or commerce, a person using postal, telegraphic or telephonic (including internet) services and, although not discussed above, a person in the course of the business of banking or insurance. The main gap here would be that individuals not doing any of the above could not be controlled as to their use of protected icons. The effect this gap would have on any proposed legislation would need to be considered in the context of the coverage required, once this is more defined.

**TRADE MARK APPLICATIONS FOR, AND REGISTRATIONS OF,  
WALTZING MATILDA (Attachment 7)**

**Waltzing Matilda**

**Status of trade mark applications, oppositions and registrations  
and lapsed applications**

1/11/2002

**187615**

**Waltzing Matilda**

**Owner**

WM Productions

**Status**

Registered

**Filed**

8 May 1968

**Goods and services**

25

Articles of clothing

**Assignments**

Owner on 19/1/1990

Tamar Knitting Mills Pty Ltd- Launceston Tasmania

15/8/1996 to

to Gia Pty Ltd

12/7/20021

to Gina Boon- Elizabeth Bay NSW

22/1/2002

to **WM Productions**

**Amendments to Goods and services**

None

**Other Action Taken**

***Non-use action***

Filed 25/1/1995 by Retusa Pty Ltd Withdrawn 14/3/1995

Filed 17/12/1998 by Jolly Swagman Pty Ltd

*Gina Boon v Jolly Swagmen Pty Limited* [2001] ATMO 103 (25 October 2001)

Dismissed 20/12/2001

## 218783 Waltzing Matilda

**Owner**

WM Productions

**Status**

Registered

**Filed**

29 April 1968

**Goods and services**

32

All goods in class 32 (This is the class 32 class heading: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages)

**Assignments**

Original owner not available by electronic means

29/6/1987	to Tooth and Co.
5/4/1993	to Lindemans Wines
3/4/1995	<b>to Winton Shire Council</b>
30/7/1996	<b>to Southcorp Wines</b>
19/4/2000	<b>to Jolly Swagman Pty Ltd</b>
20/3/2002	<b>to WM Productions</b>

**Amendments to Goods and services**

None

**Other Action Taken**

*Non-use actions*

16/9/1999	by Jolly Swagman Pty Ltd
31/1/2000	Trade mark removed for non-use (owned at time by Southcorp wines)
22/3/2000	TM restored- non-use action and tm assigned to Jolly Swagman
31/7/2000	filed by Waltzing Matilda Centre
22/2/2002	Hearing decision handed down

- Hearing Officer determined that the applicants for non-use action (Winton Shire Council and Waltzing Matilda Centre) were not persons aggrieved within the meaning of s92 of the Act *Jolly Swagman Pty Ltd v Waltzing Matilda Centre [2002] ATMO 17* (22 February 2002)

**Further action is pending**

**228232**  
**Waltzing Matilda**

**Owner**

WM Productions

**Status**

Registered

**Filed**

23 April 1969

**Goods and services**

33

Wines, spirits and liqueurs

**Assignments**

30/7/1987

to Lindemans Wines

27/4/1995

to **Winton Shire Council**

15/8/1996

to Southcorp Wines

7/4/2000

to **Jolly Swagman Pty Ltd**

20/3/2002

to **WM Productions**

**Amendments to Goods and services**

None

**Other Action Taken**

*Non use Action*

Filed 23/9/1999

by **Jolly Swagman**

Filed 8/8/2000

by **Waltzing Matilda Centre**

22/2/2002

Hearing decision handed down

Hearing Officer determined that the applicant for non-use action (Winton Shire Council and Waltzing Matilda Centre) were not persons aggrieved within the meaning of s92 of the Act *Jolly Swagman Pty Ltd v Waltzing Matilda Centre [2002] ATMO 17* (22 February 2002)

*Further action pending*

**336891**  
**Waltzing Matilda**

**Owner**

Dalsonware Pty Ltd

**Status**

Registered

**Filed**

23 Aug 1979

**Goods and services**

11

Barbecues, parts thereof and accessories therefore, all being goods in this class

**Assignments**

Owner at 17/7/1986 Dalstonware Pty Ltd

14/4/1988 to Canterbury Hall Pty Ltd

31/12/1991 to Perental Pty Ltd

15/8/2000 to Dalsonware Pty Ltd

**Amendments to Goods and services**

None

**Other Action Taken**

None

**490630**  
**Waltzing Matilda**

**Owner**

Perental Pty Ltd

**Status**

Registered

**Filed**

7 July 1988

**Goods and services**

6

Moneyboxes of metal; containers made of metal; metal trays; waste paper bins of metal.

**Assignments**

Original Owner

31/12/1991

Canterbury Hall Pty Ltd

to Perental Pty Ltd

**Amendments to Goods and services**

None

**Other Action Taken**

None

## 749100 Waltzing Matilda

**Owner**

Brenda Mauriceen Lomas

**Status**

Opposed-

Court Action- single judge handed down decision in March 2002  
Court Action Full Bench scheduled for 11/11/2002 File number Q98/02

**Filed**

20/11/1997

**Registration opposed**

**Goods and services**

NOTE; amendments to classes 29, 30 and 42 directed by the courts to enable registration. The amendments have not yet been actioned. Those goods and services to be deleted are underlined.

29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats; foodstuffs and prepared foods included in this class

30

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery; biscuits and cakes; ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice; foodstuffs and prepared foods included in this class

31

Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt

35

Services in class 35 namely, advertising; business management and administration; accountancy; franchising and licensing services including the appointment of franchises and licensees and the conduct and management of same; retail and wholesale services relating to acquisition, supply and sale of foodstuffs, beverages and groceries; statistical analysis; information surveys and marketing research; publicity press releases and supervision of promotional campaigns; consultancy services in regard to the above services

42

Services in class 42 namely, the establishment, operation and conduct of outlets, venues and facilities for the supplying and provision of meals and refreshments, including restaurants, cafes, food outlets, meal rooms, dining venues, eateries, cafeterias, canteens, snack bars, takeaway stores and fast-food outlets; providing foodstuffs and beverages to the said outlets, venues and facilities; catering services; advisory and consultancy services pertaining to the said services

**Assignments**

None

**Amendments to Goods and services**

Single Federal Court judgement ordered amendments to specification of goods and services in order to allow registration. The goods and services to be deleted have been underlined above..

**Other Action Taken**

**Opposition**

**23/9/1999**

**Opposed by Winton Shire Council and Waltzing Matilda Centre**

*Winton Shire Council and The Waltzing Matilda Centre v Brenda Mauriceen Lomas* [2000] ATMO 90 (17 August 2000)

Opposition dismissed on grounds that:

- There was no offer of trade by the opponent (Winton Shire Council and Waltzing Matilda Centre) at the time
- There is no suggestion that there is any inherent affiliation between the goods and services on offer and Winton Shire Council or the Waltzing Matilda Centre
- There is unlikely to be any confusion given the goods and services in question

**25/2/2002**

**Opposed by Jolly Swagman-**

*Jolly Swagmen Pty Ltd v Brenda Mauriceen Lomas* [2002] ATMO 19 (25 February 2002)

Dismissed on grounds that:

- goods were not of the same description

**Court Action**

*Winton Shire Council v Lomas* [2002] FCA 288(20 March 2002)

- There is no connotation that goods bearing the mark Waltzing Matilda would be assumed to have some connection with or endorsement from Winton
- No intention to use mark on various other goods including clothing, spoons, tea towels, magnets, placemats, food packaging.
- Waltzing Matilda Centre have shown some prior use of the mark in relation to foodstuffs and restaurant services
- Only s58 made out for a limited range of goods and services

*Winton Shire Council v Lomas* [2002] FCA 696 (31 May 2002)

Argument in regard to orders heard by Spender J and allowed in part. The application can proceed to registration on amendments to classes 29, 30 are carried out and class 42 is deleted.

**Appeal to Full Bench of Federal Court pending and set down for hearing on 11/11/2002.** File number Q98/02.

# 768214

## Waltzing Matilda

**Owner**

WM Productions Pty Ltd

**Status**

Registered

**Filed**

23/7/1998

**Registration advertised**

26/9/2002

**Goods and services**

9

Cinematographic goods in this class including films, motion pictures and slides; computer programs; but excluding videos, videotapes, cassettes, recording discs, CDs, audio/visual tapes, cassettes, and discs

41

Film production, production of motion pictures, videotapes, CDs, cassettes, records, radio and television programmes, production of shows; publication of books, texts; movie studios; rental of motion pictures, videos, cinema-films; entertainment services

**Assignments**

20/3/2002

to **WM Productions from Jolly Swagman**

**Amendments to Goods and services**

As a result of an opposition proceeding, class 9 was amended to exclude videos, videotapes, cassettes, recording discs, CDs, audio/visual tapes, cassettes, and discs which were determined to be deceptive by the Hearing Officer.

**Other Action Taken**

**Opposition**

Lodged by Winton Shire Council and Waltzing Matilda Centre

*Waltzing Matilda Centre Limited v Jolly Swagman Pty Ltd* [2001] ATMO 93 (3 October 2001)

11/9/2002 Opposition dismissed

On grounds that

- there is no general understanding in the marketplace of the Winton connection with the song;
- there is no evidence of trade mark use of the mark on the part of Waltzing Matilda Centre or Winton Shire Council; and
- The Hearing Officer found that there was a likelihood of deception and confusion if the trade mark was to be used on tapes etc and the trade mark specification of goods should be amended accordingly.

## 799002 Waltzing Matilda

**Owner**  
WM Productions

**Status**  
Opposed

**Filed**  
30/6/1999

**Acceptance advertised** 17/8/2000

### Goods and services

2

Paints, varnishes, lacquers; colorants, dyes, inks in this class; mordants; metals in foil and powder form for painters, decorators, printers and artists; preservatives against rust and against deterioration of wood; raw natural resins

3

Toiletries, perfumery, cosmetics, essential oils, skin care, body care and hair care preparations in this class; dentifrices; soaps; bleaching preparations and substances for laundry use; cleaning, polishing, and scouring and abrasive preparations

5

Pharmaceutical, veterinary and sanitary preparations; nutritional foods, supplements and additives in this class, dietetic preparations for medical and therapeutic purposes, food for babies, vitamin preparations, mineral supplements, herbal preparations in this class; disinfectants; fungicides, insecticides, herbicides, vermin destroying preparations; plasters, materials for dressings; dental wax

12

Vehicles; apparatus for locomotion by land, air or water; and parts and fittings in this class for the aforementioned goods

14

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes including objects of imitation precious metals in this class; ornaments, figurines, statuettes, badges and medals in this class; jewellery, precious stones; souvenir items and other goods in this class used for character merchandising and promotional purposes; horological and chronometric instruments

15

Musical instruments

18

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks, luggage, bags including travelling bags, cases; umbrellas, parasols and walking sticks; whips, harness and saddlery

22

Ropes, string, nets, tents, hammocks, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials

23

Yarns and threads, for textile use

28

Toys, games and playthings, dolls, toy action figures, and accessories in this class therefor; toy jewellery in the nature of novelty items; electronic games within this class; decorations for Christmas trees; gymnastic and sporting articles not included in other classes

32

Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages

33

Alcoholic beverages (except beers)

34

Tobacco; smokers' articles; matches

42

Licensing of intellectual property; hotel, motel, and other lodging services, temporary accommodation services; medical, health, hygienic and beauty care; child care services; computer software, computer services in this class; on-line and Internet services within this class including the provision of access by electronic networks to news and information; fan club services within this class

**Assignments**

Original applicant **Jolly Swagman**  
20/3/2002 to **WM Productions from Jolly Swagman**

**Amendments to Goods and services**

Goods and services amended to enable acceptance

**Other Action Taken**

*Opposition*

7/12/2000

Ongoing

by Waltzing Matilda Centre and Winton Shire Council  
evidence in answer due 22/10

**807387**  
**Waltzing Matilda**

**Owner**

WM Productions

**Status**

Opposed

**Filed**

16/9/1999

**Registration advertised**

Acceptance advertised 6/7/2000

**Goods and services**

39

Arranging of travel, tours, and cruises, escorting of travellers, transport of passengers, travel and transport reservation, travel agency services in this class; conducting sponsored tours; transport services; storage and packaging services in this class; including the aforesaid services provided online, via the internet and the electronic media

**Assignments**

20/3/2002

**to WM Productions from Jolly Swagman Pty Ltd**

Other Action Taken

*Opposition*

26/10/2000

**by Winton Shire Council and Waltzing Matilda Centre**

*Hearing on Opposition matters set down for 18/11/2002 in Canberra*

## 808060

**Owner**

The Waltzing Matilda Centre Limited

**Status**

Under Examination- Deferred

**Lodged**

23/9/1999

**Registration advertised**

Not applicable

**Goods and services**

16

Paper, cardboard and goods made from these materials, printed matter, photographs, stationery, books, magazines, calendars, postcards, graphic reproductions, paper, cardboard and goods from these materials not included in other classes; stickers, advertising and promotional materials, food packaging and labels, reference guides, catalogues, newsletters, periodicals, pamphlets, books, trading cards, pencil cases, activity books, address books, boxes for books, children's story books, crayons, notebooks, diaries, scrap books, souvenir booklets, memo pads, markers, pens, pencils, pencil cases and pencil tins, pencil erasers, pencil sharpeners, photo albums, playing cards, folders, school kits containing markers, pens, pencils, rulers, erasers and notepads, stickers, sticker albums, wall posters, poster books, envelopes

18

Bags, backpacks, gym bags, garment bags, book bags, travel bags, school bags, leather and imitations of leather and goods made of these materials including trunks and travel bags, purses, handbags, travel goods, money belt, bum-bags, backpacks, carry bags, key holders, tote bags, sports bags, pouches

25

Clothing including skirts, T-shirts, pants, jackets, vests, jeans, shorts, rompers, sweaters, sweat pants, sweat shirts, headgear including hats, footwear, sports clothing, sandals, scarfs, singlets, underclothing, waterproof clothing, wind resistant clothing

35

Business management, business administration and office functions relating to the management and operation of wholesale, retail and Internet services; providing information on a global computer network; wholesale and retail services in this class including retailing of paper and cardboard articles including stationery and publications, video tapes, magazines, books, calendars, postcards and photographic prints, giftware and novelty items, articles of clothing and retail services offered by electronic or ordinary mail order; art gallery services and the services of providing facilities for exhibitions; advertising and promotions and public relation services, Internet wholesale and retail services, tourist promotion; franchising services; marketing, promotions and advertising services provided over a global computer network

41

**ATTACHMENT 7**

Arranging and conducting instructional lectures, seminars and presentations; educational and training programs; lending libraries, publication of books and instructional materials; production of radio and television programs for educational and teaching purposes; publication of texts; competitions and exhibitions for cultural and educational purposes relating to Waltzing Matilda and Australian history in the form of static and moving displays and video and projected reproduction and simulated entertainment; publication of information on- line; publication of information in electronic form; entertainment services in this class, amusement facilities, exhibitions, live performances, recreation facilities

42

Provision of food and drink; restaurant services; takeaway food services; and cafes being services in class 42; licensing services; operation of internet services and providing information on a global computer network; development, operation and conduct of venues and facilities for providing food and drink including restaurant and bar services, takeaway food services and cafes; catering services; development and consulting services; information services

**Assignments**

None

**Amendments to Goods and services**

None

**Other Action Taken**

Adverse first report citing trade marks 187615, 218783, 228232, 749100, 768214, 799001, 799002 as prior marks.

808076



**Owner**

Waltzing Matilda Centre

**Status**

Under examination- deferred

**Filed**

23/9/1999

**First report issued** 10/7/2000

**Goods and services**

35

Business management; business administration and office functions; franchising and licensing services; retail and wholesale services in this class; support and management services; promotions, advertising, marketing, Internet wholesale and retail services and consultancy services

42

Provision of food and drink; restaurant services; takeaway food services; and cafes being services in class 42; franchising and licensing services; operation of Internet services and providing information on a global computer network' development, operation and conduct of venues and facilities for providing food and drink including restaurant and bar services, takeaway food services and cafes; catering services; development and consulting services; marketing, promotions and advertising services provided over a global computer network; information services

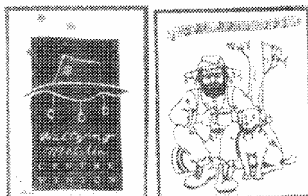
**Assignments**

None

**Other Action Taken**

First adverse report citing; 187615, 218783, 228232, 578161, 578162, 749100, 768214, 799001, 799002 as prior marks.

808179



BANJO'S BEER

**Owner**

Waltzing Matilda Centre

**Status**

Under examination- deferred

**Lodged**

23/10/1999

**Registration advertised**

First adverse report 10/7/2000

**Goods and services**

32

Beer, porter, lager, bitter, ale, stout, mineral and aerated waters and other non-alcoholic drinks

42

Brewing, provision of food and drink including take away services; operation of licensed premises

**Assignments**

None

**Amendments to Goods and services**

None

**Other Action Taken**

First adverse report cites 218783, 228232, 492377, 492378, 749100, 799001, and 799002 as prior marks.

**843288**  
**Waltzing Matilda**

**Currently owned by**  
WM Productions

**Status**  
Opposed

**Filed**  
20/7/2000 based on an earlier mark #799002 giving a priority date of 30/6/1999

**Registration advertised**  
23/5/2002

**Goods and services**

25  
Clothing, footwear, headgear

**Assignments**  
Original owner  
20/3/2002

**Jolly Swagman**  
**to WM Productions**

**Amendments to Goods and services**  
Classes 29,30,31, 42 deleted prior to acceptance to overcome citations.

**Other Action Taken**  
First adverse report cited 187615, 336891, 749100, 808060, 808076, and 840486.

**Opposition**  
23/8/2002      Winton Shire Council and Waltzing Matilda Centre

*Extension of time granted for filing opposition*

**856692**  
**Waltzing Matilda**

**Owner**

WM Productions

**Status**

Registered

Provisions of s44 (4) applied

**Filed**

10/11/2000

**Registration advertised**

20/9/2001

**Goods and services**

25

Articles of clothing, headgear

**Assignments**

Original owner

12/7/2001

Jolly Swagman

to WM Productions

**Other Action Taken**

None

**901920**  
**Waltzing Matilda**

**Owner**

WM Productions

**Status**

Under examination

**Lodged**

31/01/2002 based on priority application 799001 giving a filing date of 30/6/1999

**Registration advertised**

First adverse report 23/5/2002

**Goods and services**

16

Paper, cardboard, and goods made from these materials not included in other classes; printed matter including books and printed publications; stationery; postcards, posters, calendars, playing cards; pictures, photographs; graphic representations, lithographs, engravings; souvenir items in this class

25

Clothing; footwear

35

Retailing and wholesaling of clothing, footwear, headgear, textile goods, stationery, paper and cardboard goods, books, printed matter, fashion goods, jewellery, cosmetics, toiletries, body care preparations, games, sporting goods, toys, playthings, souvenirs, food, beverages, leather goods, bags, motion pictures, films, videos, cassettes, tapes, recording discs, CDs, cinematographic goods, and other merchandise used in promotional activities and/or associated with character merchandising; advertising services including radio and television advertising, television commercials, film advertising; business management; marketing services; publicity services, and publication of publicity texts

**Assignments**

Original owner  
18/2/2002

Jolly Swagman  
to WM Productions

**Amendments to Goods and services**

None

**Other Action Taken**

First adverse reports issued citing 808060, 808076

# 911431

## Waltzing Matilda

**Owner**

WM Productions

**Status**

Under examination

**Lodged**

2/5/2002 claiming divisional status of 20/7/2000 on 843288

**Registration advertised**

First adverse report 12/8/2002

Goods and services

29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats

30

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice

31

Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

42

Provision of food and beverages including restaurant, cafe, cafeteria, snack bar, food outlet services; cocktail lounge services

**Assignments**

None

**Amendments to Goods and services**

None

**Other Action Taken**

First adverse report cited 749100, 808060, 808076

## Lapsed applications filed by Winton Shire Council

647844

Lodged 6/12/1994



Lapsed 15/8/1996

Did not respond to the first adverse report

16

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; photographs; stationery; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards and all other goods in class 16

Did not respond to the first adverse report (Myer marks plus others cited against this application)

647845



Lodged 6/12/1994

Lapsed 15/8/1996

Did not respond to first adverse report

41

Education, providing of training, entertainment, sporting & cultural activities including (without limitation) amusements, camp services, competitions, exhibitions, festivals, live performances, museum facilities, music halls, publication of literature, radio & television, other media & multi-media programmes, recreation facilities & information, seminars, teaching & all other services in this class

**647846**

Waltzing Matilda Centenary

Lodged 6/12/1994

Lapsed 15/8/1996

Did not respond to first adverse report. One cite and a disclaimer

4

Industrial oils and greases; lubricants; fuels (including petrol and other motor spirits) and all other goods in class 4

**647847**

Waltzing Matilda Centenary

Lodged 16/12/94

Lapsed 15/8/1996

Did not respond to first adverse report

16

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; photographs; stationery; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards and all other goods in class 16

**647848**

Waltzing Matilda Centenary

Lodged 16/12/94

Lapsed 15/8/1996

Did not respond to first adverse report

Class 21

Household or kitchen utensils and containers (not of precious metal or coated therewith); steel work; unworked or semi-worked glass (except glass used in building); glassware; porcelain and earthenware not included in other classes and all other goods in class 21

**647849**

Waltzing Matilda Centenary

Lodged 16/12/94

Lapsed 15/8/1996

Did not respond to first adverse report

Class 41

Education, providing of training, entertainment, sporting & cultural activities including (without limitation) amusements, camp services, competitions, exhibitions, festivals, live performances, museum facilities, music halls, publication of literature, radio & television, other media & multi-media programmes, recreation facilities & information, seminars, teaching & all other services in this class

ATTACHMENT 7

649729



Lodged 23/12/94  
Lapsed 27/6/1996  
Did not respond to first adverse report

Class 4  
Industrial oils and greases; lubricants; fuels (including petrol and other motor spirits) and all other goods in class 4

649730



Lodged 23/12/1994  
Lapsed 27/06/1996  
Did not respond to first adverse report

Class 16  
Paper, cardboard and goods made from these materials, not included in other classes; printed matter; photographs; stationery; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards and all other goods in class 16

649731



Lodged 23/12/1994  
Lapsed 27/06/1996  
Did not respond to first adverse report

Class 21  
Household or kitchen utensils and containers (not of precious metal or coated therewith); steel work; unworked or semi-worked glass (except glass used in building); glassware; porcelain and earthenware not included in other classes and all other goods in class 21

ATTACHMENT 7

649732



Lodged 23/12/1994  
Lapsed 27/06/1996  
Did not respond to first adverse report

Class 25  
Clothing, footwear, headgear and all other goods in class 25

649733



Lodged 23/12/1994  
Lapsed 27/06/1996  
Did not respond to first adverse report

Class 41  
Education, providing of training, entertainment, sporting & cultural activities including (without limitation) amusements, camp services, competitions, exhibitions, festivals, live performances, museum facilities, music halls, publication of literature, radio & television, other media & multi-media programmes, recreation facilities & information, seminars, teaching and all other services in this class

649894  
Waltzing Matilda Centenary

Lodged 3/01/1995  
Lapsed 27/06/1996  
Did not respond to first adverse report  
Class 8  
Teaspoons & all other goods in class 8

ATTACHMENT 7

649895



Lodged 03/01/1995  
Lapsed 27/06/1996  
Did not respond to first adverse report

Class 8  
Teaspoon & all other goods in class 8

652796



Lodged 13/02/1995  
Lapsed 18/07/1996  
Did not respond to first adverse report

32  
Beer and all other goods in this class

**Other Applications**

**Registrations for *Waltzing Matilda* that have been removed**

128494

owned by Myer Emporium  
Registered from 1956 to 26/8/1999  
class 28

128495

Owned by Myer Emporium  
Registered from 1956 to 26/8/1999  
class 19

240442

Owned by Myer Emporium  
Registered from 1956 to 26/8/1999  
class 20

240443

Owned by Myer Emporium  
Registered from 1956 to 26/8/1999  
class 21  
(These trade marks were prior marks to the first Winton Shire Council marks and were cited against those applications)

## Other lapsed applications

**650398**

Waltzing Matilda

Owner Retusa Pty Ltd  
Lodged 11/01/1995  
Lapsed 30/01/1997

Class 25

Clothing, footwear, headgear and all other goods in this class

**799001**

Waltzing Matilda

Owner Jolly Swagman  
Lodged 30/6/1999  
Lapsed 14/3/2002  
Adverse report cited 187615, 749100

**817508**

waltzingmatilda. 

Owner Humpin' the Bluey Pty Limited  
Lodged 16/12/1999  
Lapsed 10/1/2002  
Did not respond to first adverse report

Class 16

Post card

**840486**

Waltzing Matilda

Owner Brenda Mauriceen Lomas  
Lodged 28/06/2000  
Lapsed 30/05/2002  
Did not respond to first adverse report

32

Beers; mineral and aerated waters and other non-alcoholic drinks, carbonated and non-carbonated soft drinks and cordials; fruit drinks, fruit juices and fruit juice concentrates; syrups, concentrates, powders, flavourings, and other preparations for making beverages

33

Alcoholic beverages (except beers); wines, spirits and liqueurs

**Information on historical registrations of Waltzing Matilda from Trade Marks 'dead' files database that have been removed or never registered**

**Trade marks appearing on the Dead trade mark register**

153686

Australasian Conference Association  
class 29  
Filed 4/5/1959  
Removed 24/7/1994

160046

Australasian Conference Association  
class 30  
Filed 4/5/1959  
Removed 24/7/1994

367316

James Gregory McLaughlin  
Filed 27/10/1981  
Registered  
Removed 5/12/1988 for non payment of renewal.  
Class 18

386064

McCasker Nominees  
Lodged 12/1/1983  
Never registered  
Class 14

471836

Hattori Pty Ltd  
Lodged 31/8/1987  
Removed 6/10/1994 for non payment of renewal fees

**Very old marks for which no information is available on-line**

160787

No information available

194703

No information available

333450

No information available

333451

No information available

333452

No information available

333453

No information available

333454

No information available

333455

No information available

333456

No information available

333457

No information available