

Australian Manufacturers' Patents, Industrial Designs,
Copyright & Trade Mark Association

31st March, 2005

Mr Jeff Roberts
Secretariat
Advisory Council on Intellectual Property
PO Box 200
WODEN ACT 2606

Dear Jeff

**Re: Relationship between Trade Marks, Business Names, Company Names and
Domain Names**

We respond to ACIP Issue Paper on the above topic and thank you for accepting our late response.

Having considered the ACIP paper and various submissions made to date may we comment as follows:

1. AMPICTA considers that the law, as it presently stands, satisfies Australia's obligation under Article 8 of the Paris Convention for the Protection of Industrial Property and that no further changes are needed for this purpose at present.
2. The present educative measures about the legal nature of business and company names as discussed in paras 3.2.1 and 3.2.2 of the Issues Paper, do not work as intended; nor is it considered that educative measures alone can adequately address the misconception. If meaningful changes are considered desirable then they should be the subject of a separate and detailed study and report.
3. AMPICTA does not consider that the various business names registers should be abolished. These registers provide important information to the community as to who it is dealing with when businesses trade under names different to those of the proprietors of the business.

Furthermore, AMPICTA does not consider that the adoption of the UK system would constitute any significant improvement to the current system of business name registers.

4. The present Register of Trade Marks should not be changed in any way. Particularly, it should not be merged with any of the National Names Register, the State business names registers or the ASIC corporations register. It serves a purpose quite different from any of these registers which must not be tainted by any merger whether partial or total.
5. The National Names Register as accessed from the ASIC website should be amended so as to provide a more extensive names search at no charge to the community. Unlike ATMOS, the present search does not provide a proper part name search; nor does it provide details as to the type of business carried on by those that are registered or the names of the proprietors if registered as a business name.

At the present time, this information is only available if the search is carried out via an ASIC provider for which both ASIC's and the providers' fees are payable. AMPICTA is strongly of the view that this information is public, it is maintained for the benefit of the public and should be made available to the public free of charge. There is precedent for this approach in the decision of IP Australia when it made its Registers available to the public free of charge because the information belongs to the public.

Adopting this approach would make the information on the National Names Register more meaningful to an enquirer and more likely to indicate a possible conflict as well as reducing the ever-increasing burden of costs on business, particularly SMEs.

6. A mandatory trade mark register search is not considered desirable. The only reason such a search might be carried out would be to ascertain the likelihood or otherwise of trade mark infringement. This is a question of law which ultimately is for a court to determine; however, unless a formal opinion was obtained from a lawyer or a trade mark attorney, then its value is doubtful. In any event, a search without the accompanying opinion would be so heavily disclaimed that its value would be dubious.

In any event, a search with or without a formal opinion would be expensive if carried out by a professional.

7. Any search less than a proper infringement search, whilst useful, is inconclusive. It would be more beneficial to increase the emphasis on the differences between trade marks on the one hand and business, company and domain names on the other and the desirability of self filers seeking professional advice.
8. The foregoing, in AMPICTA's view, takes the issue back to the educative role of government. Whilst the issues under consideration in the ACIP paper cannot be completely resolved by education of the public, an increase in emphasis on

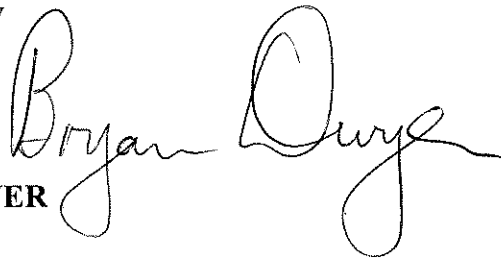
education is not only desirable, but is attainable at relatively low cost. We are happy to discuss opportunities in this regard if you wish.

AMPICTA is happy to provide further information if you so desire and/or discuss any aspects of this submission with you.

Please do not hesitate to contact Brian Jones on telephone (02) 9869 7394 or by email jonesbf@optusnet.com.au

Once again, our thanks for accepting our late response.

Yours sincerely

A handwritten signature in black ink that reads "Bryan Dwyer". The signature is written in a cursive style with a large, looped 'B' and 'D'.

BRYAN DWYER
President