

Please consider the following to be my submission to the Advisory Council on Intellectual Property regarding the Review of the Relationship between trade marks and business names, company names and domain names.

Around 1995 I was commissioned by IP Australia (then AIPO) to write the brochure mentioned in the Issues Paper to explain the differences between trade marks and business and company names. As I understood it, this brochure was then supplied to business names offices as well as Australian Securities and Investments Commission (ASIC) offices around the Australia.

I discovered many years later that this brochure had eventually been replaced by and reduced to a one or two line statement on the business names application forms in most states and territories.

I now run a successful intellectual property services firm, IP Wealth™ Pty Ltd, with business clients who have a combined annual turn-over of around 1.5 billion and growing every year. Some of my clients are first time entrepreneurs and others are highly successful, seasoned business people with decades of business experience under their belt. In my role as the primary intellectual property resource speaker for the prestigious members only network of CEOs and other business leaders, The Executive Connection, I also train men and women who head up businesses with annual turn-overs ranging from a minimum of \$5 million to several hundred million dollars. And as a Queensland selector for the popular Yellow Pages® Business Ideas Grants since 2000, I am asked every year to speak about basic intellectual property issues at an information night usually attended by over one hundred potential grant applicants - mainly inventors and first time business people.

And yet no matter their years in business or how many millions their business turns-over, it amazes me that most business people do not understand the crucial differences between trade marks and all other business names, including domain names.

Today in fact, I received a phone call from a businessman with an existing highly successful financial company who had just paid the fees to register a new company with ASIC. He had been referred to us by a colleague, and phoned so that I could conduct a trade mark search on his new company name. Within a couple of seconds I discovered exactly the same name in the Australian Trade Marks Online Search Service (ATMOSS) for exactly the same services in which he intended to conduct business in. When I explained to him that this existing registered trade mark on the face of it precluded him from conducting business with his new company name in the same area of services, he was quite simply stunned. His comment to me, verbatim was, “You mean I have just given my money to ASIC for nothing?”

Unfortunately, I have witnessed this scenario hundreds of times – while conducting intellectual property training, from enquiries to our business, and simply in conversations with other business people.

And here’s why: people go to their local business names office or ASIC to name their new business or company, just as people go to the Births, Deaths and Marriages Office to name their new baby.

One does not choose a name for a business to act as an internal moniker, nor do people name their baby and then keep it as a family secret. The child goes out into the world with its name, and a business enters the Australian marketplace with a chosen business or company name. So it comes as a great shock to realise that having named one's business is not enough, now one needs to secure a registered trade mark. Unfortunately this leap of understanding appears illogical to the Australian public, and apparently to the citizens of many other countries, as the Issues Paper attests.

One solution: Therefore, in my view, one way of alleviating this confusion is to offer trade mark registrations which can be identified as a business or company name; and business names offices and ASIC would only provide registration numbers.

So in practice, an applicant would still use the Nice Classification system to nominate classes of products and/or services, but would also be able to 'tick the box' if the name is to be used as the business's or registered company's trading name. This would mean that people who satisfy either or both entities's statutory requirements would be given registration numbers by the (currently known) business names offices and by ASIC (which already provides number only registration), and then would move on to secure names from one central names registration body – IP Australia.

The names applicant would then use the search services of a specialist in the field (like an IP services firm) or conduct their own searches. Once they had narrowed down their options to names which are not also existing registered trade marks, they could make an immediate application and secure a priority time and date for eventual registration.

And just as the situation exists today: the business person could choose to use a specialist to determine appropriate classes, provide professionally written specification of goods and/or services and file on their behalf to secure the name, or they can self-file and undertake the process on their own. Trade Mark Office examiners would still examine for many of the same compliance related issues, i.e. right class, right specification, etc.

However, what they would need to do very little of is cite trade mark applications for infringing existing registered trade marks, because a requirement to search (not a suggestion that one search) should eliminate much of the wasted applications where no search has been conducted.

Also important would be a warning to the business person to hold off on using their chosen name until such time as the trade mark has at least successfully covered the hurdle of not being similar or identical to a currently registered mark in the same class or classes.

When the change-over between the current confusing system occurred to this new proposed system, there would be a well publicised amnesty to enter the new system for existing business owners relying on unregistered trade marks. They would be given the opportunity to:

1. apply for their own trade mark registration (and have their name examined on its merits and against existing applications and registrations), and supply evidence of honest and concurrent use
2. oppose accepted trade marks (within the mandatory 3 month opposition period)
3. act to remove registered trade marks for non-use (and await the results of the evidentiary process)
4. and essentially deal with the issue that they may in fact be infringing a currently registered trade mark.

This change in approaches could also greatly lift the general profile of registered trade marks to help educate business people about the need to secure registrations for names of products and services, which are not also business names. And in turn, this would also help to eliminate clashes between the trade marks which are say, purely for a product or service, and those which are granted for a business's name, but effectively land in the same class, and therefore can trigger legal action for infringement.

I personally feel the above suggested change from several name based systems which are inherently confusing, to one streamlined name system is an opportunity to eliminate so much of the confusion and terrible risk to businesses and livelihoods that so many business people face and have faced.

I thank you for the opportunity to provide this submission and hope that the Council can help our country lead the world in finding a solution to the troublesome relationship between trade marks and business names, company names and domain names.

Sincerely,

Alicia Beverley

IP Auditor, IP Trainer,

IP Author, IP Strategist

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