

Our Ref: GAS:LW:1213709
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Direct Line: 9926 0216



26 March 2004

Attention: Mr Jeff Roberts

The Secretary
Advisory Council on Intellectual Property
P O Box 200
WODEN ACT 2606

26/3/04
2.30

Dear Sir

**Re: A Review of the Relationship between Trade Marks and Business Names,
Company Names & Domain Names - Issues Paper**

Thank you for the opportunity to make a submission in relation to the Council's Issues Paper entitled "A Review of the Relationship between Trade Marks, Business Names, Company Names and Domain Names". The Issues Paper has been considered by the Business Law Committee of the Law Society ("Committee"). The Committee is comprised of senior commercial lawyers and its mission is to represent the Law Society and its members on all aspects of commercial law including those set out in the Issues Paper. The comments below are those of the Committee alone and the Committee submits for your consideration the following:

Business Names

The Committee does not consider that the *Business Names Act 1962 (NSW)* should be repealed.

In an earlier submission to the NSW Department of Fair Trading concerning the *Business Names Act*, the Law Society opposed the repeal of that *Act*, because it considered that the system of registration of business names has great practical worth.

The Committee therefore submits that the present system of registration of business names under the *Business Names Act* has great practical utility and should continue in its present form.

The Committee further submits that the various State and Territory Registrars of business and company names should be required to make a search of the trade marks register as a condition of the registration of a business or company name. The costs (if any) of the search could be included in the registration fees.

In the submission to the NSW Department of Fair Trading above referred to above, the Law Society also recommended that a Federal central register of Business Names be established. The Committee continues to believe this should be implemented.

The Committee suggests that it would be possible to provide for business names to be registered for specific States or Territories through such central register. This would enable small businesses to restrict registration to one State or Territory.

Following the establishment of a central business names register the possibility of merging or associating the central business names register with the central company names register could be considered.

Trade Marks

The ACIP Issues Paper of February 2002 "Review of Enforcement of the Trade Marks" said at page 4, "The recent move to restricted searching by class suggests that IP Australia is heading towards a system with a lower entry level. Based on its preliminary Consultations, ACIP has found that industry generally seems to prefer the more rigorous searching process associated with high entry threshold ..."

The Law Council of Australia in its submission to that Issues Paper stated that a two-tier trade mark system would be a retrograde step.

The Committee does not believe that a two-tier trade mark system should be introduced in Australia in order to address any misconception as to the nature of business and company name registrations.

However, the introduction of a second-tier system of trade marks involving a less rigorous examination process and restricted class searching could be acceptable where the trade marks are a short life cycle mark, like a fashion label.

It is submitted that legislation should be passed to enable the owner of a registered trade mark to challenge a business or company name registration.

The Committee agrees that the greatest advantage would be the possibility of dealing with conflicts at an early stage. It would reduce costs in infringement proceedings and any subsequent expense.

Domain Names

The Committee suggests that the test should be the same as that adopted by the au Dispute Resolution Policy ("au DRP") where there is conflict between a domain name registrant and the owner of a registered trade mark namely:

- (a) The registered business or company name is confusingly similar to the registered trade mark.
- (b) The registrant of the business or company name has no legitimate interests in the business or company name.
- (c) The company or business name has been registered in bad faith.

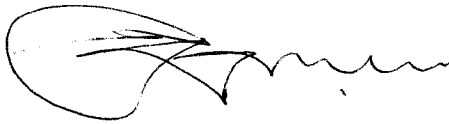
In relation to Domain Names, the Committee considers that tests for determining bad faith registration of a domain name provided by the au DRP are sufficient.

However at this stage the Committee is unable to comment on the effectiveness of au DRP which only came into operation in part on the 1st August 2002.

Should you have any queries in regard to this submission, please contact Laraine Walker, Executive Member of the Business Law Committee, on 9926 0256 or email: lxw@lawsocnsw.asn.au.

It would be appreciated if you could keep the Law Society informed of the progress of the Issues Paper.

Yours faithfully



Gordon Salier
President