



Government  
of South Australia

Department of  
**Further  
Education  
Employment  
Science and  
Technology**

*Office of the Chief Executive*

FILE: CE2004/00158

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

Level 9, ANZ House  
13 Grenfell Street  
ADELAIDE SA 5000

GPO Box 1152  
Adelaide SA 5001

T 08 8226 3821  
F 08 8226 9533

Dear Mr Roberts

I refer to the letter dated 16 January 2004 from Professor Andrew Christie, Chair of the Advisory Council on Intellectual Property Working Group on Trade Marks and Business, Company and Domain Names.

The letter invited comment from my department on the Issues Paper prepared by the ACIP.

The opinions expressed in this letter should not be held to represent other agencies of the Government of South Australia. The Attorney-General's Department is responsible for administering the Business Names regime in this state and this agency will have its own opinion about the matters raised in the discussion paper, particularly those related to structural and legislative change such as the creation of a central register and the abolition of state based business name registers.

From the perspective of the Department of Further Education, Employment, Science and Technology, the issue of confusion between trade marks and business, domain and company names is less likely than for an ordinary citizen on the street. The department infrequently registers trademarks or company or business names, and uses a government domain for its websites. The department usually seeks the assistance of patent attorneys and lawyers when registering business names, company names and trademarks.

Departmental agencies, when registering domain names, may however be less cognisant of the potential to infringe on, for example, trademarks. This would require more detailed inquiry internally within my department to establish the extent any infringement may occur, if any.

In discussions held between officers of my department, the overall opinion was that much of the confusion surrounding the various registrable names and trademarks arose from a lack of understanding that was and is probably correctable through educative measures. An example would be providing more information and links to useful sites such as National Names Search and free trademark searches such as those provided by IP Australia on state government web sites and consumer information web sites.

As to the issue of both bad faith and good faith infringement of trademarks through registration of the various registrable names, I would caution against any extension of the ambit of the current law without first determining whether the extent of actions such as name "squatting" warrants legislative amendment. Other consumer protection laws such as State Fair Trading Acts and the Commonwealth Trade Practices Act may also offer some protection in certain cases.

If you wish to discuss any of the matters raised I would direct you in the first instance to contact Ms Carolyn Anderson, Director, Legal and Skills, Science Technology and Innovation Directorate on (08) 8303 2159.

Yours sincerely

A handwritten signature in black ink, appearing to read 'Greg Black', with a stylized flourish at the end.

Greg Black  
**CHIEF EXECUTIVE**

5<sup>th</sup> March 2004