

## 1. Reform of the business name system

The state based business name system is in need of reform. There is overwhelming anecdotal evidence business name registrations are being used as de facto trade mark registrations. This is primarily caused through lack of awareness of the primary function of business name registrations being to provide a public registry of the names of all businesses that carry on businesses within a certain state or territory.

There is also considerable tension between federal Trade Mark legislation and State Business Names offices allowing business name registrations which prima facie may infringe existing trade mark rights.

Regulation and an education process is required to reduce confusion. The ACIP's suggested solution regarding having information in relation to trade mark registrations available through ASIC and the State business names offices and other cross links available to registered advisors would be of assistance. Prerequisite clearance searching of the Trade Marks register for business and company name registration may well remove most tension. I understand some Business Names offices are currently training their staff with respect to this matter however, a more coordinated approach may well be necessary.

## 2. ICAAN UDRP

ICANN dispute resolution process for hearing cyber squatting cases in relation to .com, .net and .org should be available in Australia. Again prerequisite searching of the trade marks register or proof of proprietorship of trade mark before domain name registration should relieve tension here.

## 3. Disclaimers

The absence of mandatory disclaimers since the introduction of the Trade Marks Act 1995 has lead to a degree of uncertainty as to the extent of protection in many trade mark registrations. The non-distinctive elements of the trade mark applied for should be disclaimed prior to acceptance to provide a greater clarity. The inclusion of mandatory disclaimers would enable any person searching the trade marks register to establish the degree of protection offered by a trade mark registration.

## 4. Provision of Statement of Use on Renewal

The provision of evidence of use possibly through submission of a statutory declaration evidencing use in Australia within 3 years prior to the 10 year renewal deadline would not appear to the author to be an unduly onerous requirement for the trade mark owner in return for the grant of monopoly of use. Further, this requirement may well also relieve the register of trade marks no longer used and free these marks for use by other future trade mark users.

## 5. Integrity of Present Trade Marks Register

It is important to maintain and if possible to further improve the integrity of the Trade Marks Register. If the register is allowed to be undermined by "cheap and imprecise

registrations" the extent of protection will inevitably require future clarification and definition through the Courts. This may well disadvantage small business funding court actions.

Further, one trade mark register offers greater certainty regarding rights and enforceability and is preferable to the US system of principal register and supplemental register. One register is easier to search and offers owners more confidence that marks are protected against infringement. Still further it is questionable whether a two tier system offering a cheaper low entry threshold of registration would encourage any greater participation in the trade marks systems. Greater public education as to the benefits of trade mark registration is all that is required.

The present problem of "more speed less cost" appears to have occurred due to IP Australia's attempt to address a problem caused by the inadequate recruitment of staff numbers over the last few years. Examination time exploded (now currently stands at about 5 months) but at some stages over the last two years had blown out to 9 months (and this was pre Madrid Protocol). This may have been the consequence of budget cuts to the recruitment levels of trade mark office examiners between 1999 and 2001. Examination time must be brought back to under a three month period, however, not at the expense of a robust trade marks system which registers identifiable, a valid and enforceable rights. The reintroduction of expedited examination fees should also be considered for those who wish, because of commercial consideration to achieve rapid protection.

Although the above will undoubtedly be more expensive for the Government to fund, the greater the certainty of the registration process the less need there will be for trade mark system participants to establish their rights through Courts of law.

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