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Editorial

Intellectual Property law rarely stands still and in this edition of Inspire we explore a number of changes to Australia's IP landscape brought about by legislative reform, Judicial interpretation and articulation of IP Australia practice.

Andrew Massie provides an update on the Productivity Commission's IP inquiry, in particular the Government's acceptance of the recommendation to abolish the Innovation patent system. Innovation patents can be an invaluable tool for rights holders, and patent applicants are advised to consider whether they should seek such patents prior to the systems demise. Andrew also notes the prospect of yet further changes to the inventive step test on the basis of seeking even closer alignment with European practice.

The potential differences between the Australian and European law of obviousness are highlighted by the decision in *Nichia Corp v Arrow Electronic*. As Helen McFadzean explains, the Court found that while the claimed invention was an option that the skilled person would have been led to try, they would not have done so with the necessary expectation of a successful outcome. Unfortunately for the patentee, the patent was also found not to be infringed, in part due to a narrow construction given to the term 'contains' in the claims.

Mark Williams analyses the treatment of non-physical designs under Australian law including the recent Designs Office decision in *Re Apple Inc*. While the currently articulated office practice means that such designs are not validly registerable, the potential for future changes to the law means that such applications may still be worth filing.

Of course not all IP can be protected under a system of registration. Emma Mitchell discusses the need for businesses to identify and protect non-registerable IP in the form of trade secrets and confidential information.

Also in this edition, Marine Guillou looks at an attempt to stop sales of an Aldi brand lookalike product, Annabella Newton examines why Swiss type claims are not eligible for patent term extension, Rodney Cruise warns of fake IP invoices, and Margaret Ryan provides a reminder of the importance of conducting trade mark searches prior to adopting a new brand.



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POF welcomes two new team members: Mary Munroe and Helen McFadzean



POF is delighted to announce two new additions to the POF Group; Mary Munroe, Senior Associate, joining the Chemistry and Life Sciences team in our Sydney office, and Helen McFadzean, Associate, joining the Electronics, Physics and IT team in Melbourne.

Mary holds a first class honours science degree and a PhD focusing on bimetallic oxidation catalysts in asymmetric synthesis. Mary's IP experience is truly global as she is qualified to practice directly before the European, UK, Irish, Australian and New Zealand patent offices. Since 2006, Mary has been assisting clients protect their innovations by developing and managing global patent portfolios in the chemistry, chemical engineering, life sciences, pharmaceutical and medical technology areas.

Helen joined the profession in 2009, and has successfully obtained patents, trade marks and designs for many businesses in Australia and overseas. She has experience in a large number of technologies including automation, smart devices, medical apparatus, home appliances, manufacturing processes and equipment, subsea mining technology, automotive technology, audio signal processing, image processing, embedded software and control systems.

A warm welcome to both of our new team members.

Confidential information, know-how and trade secrets: which one is which?

Often the terms 'confidential information', 'trade secret' and 'know-how' are used interchangeably. However, each has a specific meaning which can affect the way an organisation controls and exploits that information.

'Confidential Information' is the overarching term for information which is confidential to an organisation.

'Know-how' is the knowledge of how to do something, and is usually acquired through experience. The Courts in Australia have recognised that know-how forms part of, and is inseparable from, an employee's acquired or inherent state of knowledge. Know-how travels with an employee. If an organisation wishes to restrain the use of 'know-how', contractual restraints are required.

'Trade secrets' are a more specialised type of commercially valuable information, regarded as being 'owned' by an organisation. Well known examples of trade secrets include the Google search algorithm and the recipe for Coca-Cola. Whether something rises to the level of a trade secret is indicated by factors such as:

- > the extent to which it was known outside the organisation
- > its value to the organisation and to competitors should they get hold of it
- > the measures taken to safeguard its secrecy.

There can be a very fine line between know-how and trade secrets.

There are a number of advantages to relying on and exploiting trade secrets, either as an alternative to, or to complement patent protection. These include where research or discovery does not result in a patentable invention, where patent rights have expired or been

invalidated, or where a patented invention can be more profitably used with additional information. At least in theory, trade secrets can be protected indefinitely as long as they are kept secret, however they do not protect against independent invention or reverse engineering.

The decision to rely on trade secrets or to seek patent protection should be made early, to ensure that the opportunity to obtain patent protection is not lost.

Organisations should ensure they have a good handle on what trade secrets, know-how or other confidential information is held by the organisation and its employees or consultants. This should be identified and captured like any form of intellectual property. Once it has been identified, it can be effectively exploited by way of licenses to use the information, and royalties or licence fees can be obtained.

POF can assist organisations to audit and identify their confidential information, draft contracts to restrain the use of know-how by employees, and license trade secrets and information to be used by third parties.



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Innovation patent system to be abolished: results of the Productivity Commission inquiry



The Australian Government recently released its response to the Productivity Commission's (PC) inquiry into Australia's intellectual property (IP) system. These recommendations include the significant change of abolishing Australia's innovation patent system, further raising of the bar on the inventive step threshold for patents, and the replacement of existing exceptions to copyright infringement.

Abolishment of the innovation patent system

Innovation patents require a lower level of innovation compared to a standard patent, provide an eight year monopoly rather than 20 years, and give equal remedies to a standard patent. The lower requirement for validity makes innovation patents difficult to invalidate, and as a result they are a powerful tool for patent owners.

Despite this, the PC took the view that the innovation patent system produced low value patents that reduced the credibility of the broader patent system, creating uncertainty for innovators in relation to infringement of other party's patents. While the profession preferred that the system be reformed rather than abolished, the Government accepted the PC's recommendation.

The Government will now pursue amendments to the *Patents Act 1990* to abolish the innovation patent system, with appropriate arrangements being made to maintain existing rights. The Government indicates that it intends to explore mechanisms to assist SMEs to understand and leverage their IP, secure and utilise IP rights and access affordable enforcement. What form these mechanisms will take is uncertain.

The innovation patent system will remain available for now and innovation patents that are secured prior to abolition will remain in force. We recommend that clients give serious consideration to securing innovation patent protection before these changes.

Patent term extension provisions remain unchanged

There will be no significant changes to the patent term extension system for the foreseeable future.

The PC recommended rather drastic changes to the patent term extension provisions, including that extensions should only be available for patents covering an active pharmaceutical ingredient and that extensions should be calculated so that they only compensate the time taken by the Therapeutic Goods Administration for regulatory approval over and above one year. The Government noted these recommendations but has elected not to proceed with them. Recognising the importance of patent protection to the pharmaceutical industry, the Government will instead work with the sector and discuss ways to improve the patent term extension system.



Replacement of existing exceptions to copyright infringement

The most important change to copyright law the PC has proposed is to replace a number of existing exceptions to copyright infringement with an open-ended fair use defence, such as exists in the United States.

Currently the Australian Copyright Act contains many specific exceptions to copyright infringement including 'fair dealing' defences. For a 'fair dealing' defence to apply, the copyright use must be for one of a number of specified purposes, (e.g. 'research or study' or 'reporting the news'). In addition, the 'dealing' must be fair. In contrast, a fair use defence would be more flexible because it would not be confined to the specific purposes, and Courts could develop the law to meet new circumstances.

The Government has not yet decided to adopt this recommendation but will consult further in early 2018 in relation to more flexible copyright exceptions.

In order to strengthen the existing protections against infringement in the Copyright Act, the PC made another recommendation that:

- (a) parties would not be able to 'contract out' of the exceptions – i.e. include provisions in agreements that override copyright defences
- (b) consumers be allowed to circumvent technical protections in electronic copyright material for legitimate uses.

The Government has supported both of these recommendations in principle.

Assessment of inventive step to align with the European Patent Office

The PC has recommended that the assessment of inventive step in Australia be fully aligned with the standard of the European Patent Office. The PC also recommended the introduction of a requirement for applicants to disclose the technical feature of their invention in the claims.

The Government has agreed with both of these recommendations, recognising the PC's findings that while the inventive step threshold in Australia and Europe is similar most of the time, there are still some differences. At present, the legislative amendments relating to these issues are intended to be included in a Bill for introduction to Parliament in 2018. The wording of the legislative change and explanatory memorandum will be the subject of further public consultation.



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Moroccanoil vs Aldi: injunction obtained for Aldi's lookalike products

Moroccanoil Israel Ltd (MIL) successfully obtained injunctions restricting the sale of some of the supermarket chain Aldi's lookalike products in the recent case of *Moroccanoil Israel Ltd v Aldi Foods Pty Ltd* [2017] FCA 823. Aldi's conduct was found to be misleading and deceptive in relation to claims regarding the performance benefits of the argan oil used and natural content of the products.

MIL is considered a market leader in oil treatment products for hair. Under the brand name MOROCCANOIL, it markets and sells hair and beauty products containing oil extracted from the nut of the argan tree, a tree native to Morocco, reputedly rich in antioxidants, fatty acids and vitamin E.

In 2012, Aldi launched a range of hair care products using the terms 'Moroccan Argan Oil', among other brands. MIL commenced proceedings against Aldi, alleging trade mark infringement, passing off, as well as a breach of Australian Consumer Law (ACL).

Shown below is a side-by-side comparison of selected MIL and Aldi products.



MIL



Aldi



Trade mark infringement findings

MIL is the proprietor of the following two trade marks registered in relation to a range of goods including hair care products.



No limitation as to the colours turquoise, orange and white was recorded in the Register. A trade mark registered without colour limitations is taken to be registered for all colours and therefore, the question of colour was found not to be relevant.

The Court held that 'Moroccan Argan Oil' as used on the Aldi products was not deceptively similar to either trade mark, taking into account that MIL's trade marks were composite marks and included 'Moroccanoil' as well as a capital 'M' letter as prominent features. Aldi's products did not feature the capital 'M' letter.

According to the Court, 'Moroccan Argan Oil' was used as a badge of origin on Aldi's products, and together with other trade marks such as Protane Naturals,



there was no real, tangible danger that an ordinary or reasonable consumer with an imperfect recollection of the marks or the name 'Moroccanoil', would wonder whether the Aldi products were associated with MIL's marks.

Findings on passing off and contravention of Australian Consumer Law

In relation to the passing off claim, the Court accepted that MIL had a substantial and valuable reputation and that Aldi had modelled the get up of some of its products on MIL's get up, and sought to appropriate some of the reputation of MIL's products to its own benefit.

However, that was not sufficient in itself for a finding of misleading or deceptive conduct. The Court noted differences which were held to sufficiently distinguish Aldi's products, such as the presence of house brands, the lack of the prominent capital 'M' letter, and the fact that Aldi never used the text 'Moroccan Argan Oil' vertically.

The Court also took into account the fact that MIL's products are marketed as a 'salon only' brand at trade fairs and in fashion magazines, whereas Aldi's products are sold in the supermarket chain. It also noted that there was vast disparity in the prices at which the respective products are sold.

Findings on 'naturals' and performance representations

The Court agreed that the use of the word 'naturals', on the Protane Naturals Moroccan Argan Oil products and packaging represented that they were made, either wholly or substantially from natural ingredients.

However, the decision emphasised the very small percentage of 'natural' ingredients (they were mainly synthetic) apart from water, such that they were not substantially made up of natural ingredients. In the circumstances, the Court found that it was misleading and deceptive for Aldi to call its product range 'naturals'.

Based on MIL's scientific evidence, the Court held that Aldi had represented to consumers that argan oil made a material contribution to the performance benefits of its products (such as help strengthen hair) in circumstances where the amount of argan oil was so small that it could not make a material contribution to the properties promoted.

Conclusion

The case provides an interesting insight into Aldi's business practices and its marketing strategy as described in their slogan 'Like Brands. Only cheaper'. In the present instance, sufficient differences were identified between the respective products to avoid trade mark infringement or passing off. Aldi was still required to stop selling the goods because of the potential for consumers to be misled by the 'natural' claim and product performance representations. The decision is presently subject to an appeal.

“... there was no real, tangible danger that an ordinary or reasonable consumer with an imperfect recollection of the marks or the name 'Moroccanoil', would wonder whether the Aldi products were associated with MIL's marks.”



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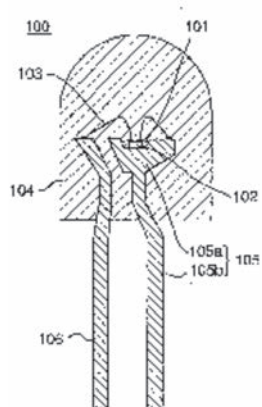
Federal Court casts white LED light on the meaning of 'contains'

The infringement case in *Nichia Corporation v Arrow Electronics Australia Pty Ltd (No. 4)* [2017] FCA 864 turned on the meaning of 'contains' and illustrates the importance of such terms in claim construction under Australian practice.

Background

Nichia is the patentee of Patent No. 720234 filed on 29 July 1997 in relation to a light emitting device (Patent). Nichia sued Arrow for infringement of claim 3 (dependent on claim 1) with regards to LED products manufactured in Taiwan, and imported/sold by Arrow in Australia. Arrow counterclaimed seeking revocation of the Patent on various grounds including obviousness.

The specification describes a light emitting diode comprising a phosphor which converts the wavelength of light emitted by a light emitting component, and emits white light.



The relevant portions of claims 1 and 3 are:

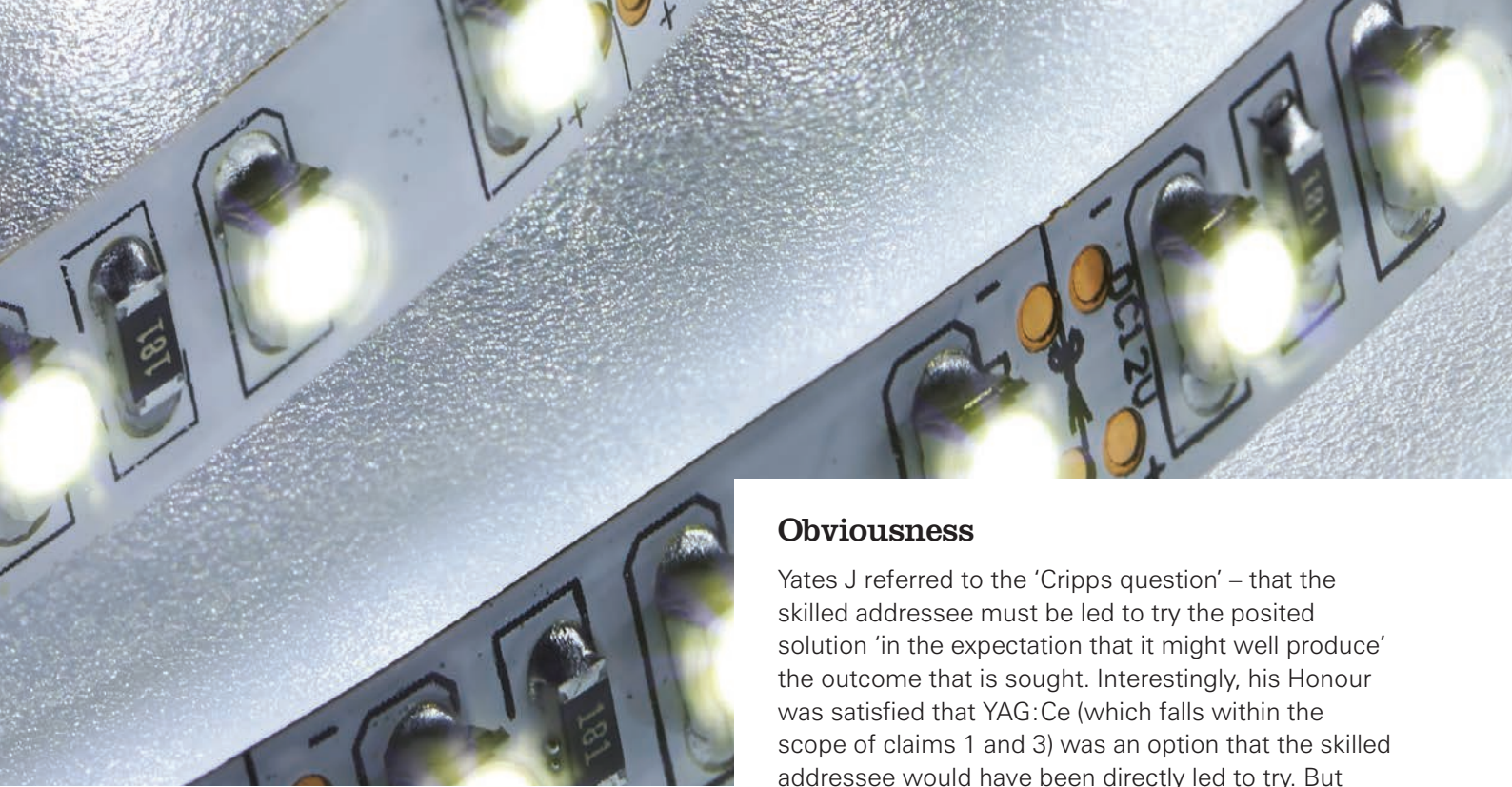
1. A light emitting device, including
...
a phosphor ...
wherein ... said phosphor contains a garnet fluorescent material including at least one element selected from the group consisting of Y, Lu, Sc, La, Gd and Sm, and at least one element selected from the group consisting of Al, Ga and In, and being activated with cerium.
3. A light emitting device according to claim 1, wherein the phosphor **contains** fluorescent material represented by a general formula $(\text{Re}_{1-r}\text{Sm}_r)_3(\text{Al}_{1-s}\text{Ga}_s)_5\text{O}_{12}:\text{Ce}$... **(emphasis added)**.

Earlier proceedings

In 2014, Nichia sought an injunction to restrain Arrow from infringement of its Patent.¹ It was found that as the selection of Lu, Sc and In (recited in claim 1) was not disclosed in the priority documents, claim 1 defined multiple forms of the invention and was attributed multiple priority dates. Claim 3 defined a specific fluorescent material that did not include Lu, Sc and In, and was entitled to the earliest priority date of 29 July 1996.

Infringement and the meaning of 'contains'

The Court interpreted 'contains' in an exhaustive sense such that the phosphor as claimed was a single fluorescent material represented by the general formula of claim 3, and not that fluorescent material with one or more other fluorescent materials.



Yates J considered the problems described in the specification regarding the deterioration of the fluorescent materials used in conventional LEDs, and concluded that the fluorescent material characteristics were important. His Honour referred to the specification which listed requirements including high luminescence, low light intensity deterioration, and light emission efficiency in order to achieve an 'object' of the invention. Although these requirements were described as preferred, his Honour concluded that they should be considered essential features.

Interestingly, it was noted that:

- > the specification described that aspects of the invention included a phosphor containing two or more garnet fluorescent materials
- > Claim 6 is dependent on claim 3, and defines that the phosphor contains two or more fluorescent materials
- > the specification describes 'Embodiment 2' in which two or more kinds of phosphors could be used.

Nevertheless, Yates J found that whilst some embodiments containing more than one fluorescent material were described, the specification did not describe that the YAG phosphor (i.e. a fluorescent material of the general formula in claim 3) could be used together with a different fluorescent material. His Honour found that the specification makes clear that Embodiment 2 uses two YAG phosphors rather than a YAG phosphor with another fluorescent material.

As Arrow's products included a fluorescent material which is within the general formula of claim 3 with other fluorescent material that is not within the general formula, no infringement was established.

Obviousness

Yates J referred to the 'Cripps question' – that the skilled addressee must be led to try the posited solution 'in the expectation that it might well produce' the outcome that is sought. Interestingly, his Honour was satisfied that YAG:Ce (which falls within the scope of claims 1 and 3) was an option that the skilled addressee would have been directly led to try. But this was not enough. It was required that the skilled addressee try YAG:Ce with the requisite expectation of success – which was not proven. Consequently, obviousness was not established.

Conclusion

When adapting foreign specifications to Australian practice, it is common to include express definitions for terms like 'comprising' to reduce the risk of the claimed integers being interpreted in an exhaustive sense. However, as this case illustrates, the construction of a claim will ultimately be considered in light of the specification as a whole. It can therefore be useful to describe alternative embodiments of the invention, which may not necessarily embody the commercial product, to support a broader scope of protection. A Notice of Appeal was filed on 19 September 2017.

Reference

1. *Nichia Corporation v Arrow Electronics Australia Pty Ltd* [2015] FCA 699.



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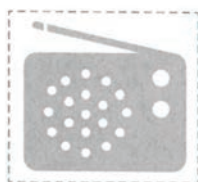
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A (non-physical) Apple spoils the bunch? A potted history of non-physical designs in Australia

The Registrar of Designs in *Apple Inc* [2017] ADO 6 ruled that a design for a display screen is not a new and distinctive design because the display screen at rest, that is in the powered-off state, is simply a blank representation which therefore cannot be new or distinctive.

The decision has formalised what was a previously little-known Designs Office work-around to prevent virtual (i.e. non-physical) designs from certification.



The Design



How the Designs Office interprets the design



The Prior Art

Apple Inc, the applicant, attempted to argue that changes in technology over time has led to images that appear on display screens becoming visual features of the screens. The applicant further argued that most display screens are marketed in shops in their 'ON' state and, in use, many display screens (typically with

mobile devices) are in a standby mode and rarely if ever 'at rest'.

The Registrar of Designs in revoking the design, disagreed saying "that an image that appears on a display screen would not be considered to be a quality or attribute of a display screen per se". This is in contrast to, for example, a new and distinctive shape of a display screen or a new and distinctive permanent pattern or ornamentation applied to a display screen.

A potted history of non-physical designs in Australia

Those in the ICT space know all too well the trouble that the law has in keeping up with technology. Designs Law in Australia has struggled with designs in the digital realm since the late 1980s, although non-physical designs have been registrable and uncontroversial with a number of Australia's large trading partners for a long time.

Since the late 1980s, Australian Design applicants have sought to register designs in respect of screen displays with limited success.

The first major test of the registrability of a non-physical design was in the early 1990s under the then *Designs Act 1906* in *Comshare Incorporated* (1991) 23 IPR 145. The applicant, Comshare, attempted to

register a number of icons for display on a computer screen. The registrar held that since Comshare's designs are displayed on a computer screen, the designs are transitory and are not actual visual features of the display screen. This decision has dictated Australian Designs Office practice ever since.

Since then, the *Designs Act 1906* was repealed and the *Designs Act 2003* came into force in early 2004. Among other changes, this Act changed the Australian designs system into a two stage registration regime:

- 1) Registration (essentially a formalities check).
- 2) Certification (an optional stage – essentially substantive examination of the application).

In 2011, a Designs Office decision in *Somfy SAS* [2011] ADO 4 found that an LCD screen was registrable, but would be unlikely to survive certification.

Then, in early 2012, concerns were raised about the effectiveness of the designs system and whether it was meeting its original objectives. As a result, the now defunct Advisory Council on Intellectual Property (ACIP) released a report which recommended that protection should be available for at least some virtual or non-physical designs, given the increasing focus of design efforts on software elements of products.

The ACIP report, in combination with the *Somfy SAS* decision, led to a spike in non-physical design filings, largely relating to mobile handsets and tablets. Importantly, the vast majority of these designs were only in the registration stage (stage 1).

In 2013, a handful of non-physical designs were certified – notably Apple Inc's application for the GUI of their Garageband software, and Labstyle Innovation's Glucose meter GUI, which led to a view that there was a policy shift at the Australian Designs Office.

However, the decision in *Registrar of Designs in Apple Inc* [2017] ADO 6 indicates that there is no longer to be any shift in that direction until the *Designs Act 2003* is changed.



Apple Inc Garageband Design



Labstyle Innovation's Glucose meter GUI

The future

In 2016, a Productivity Commission Inquiry Report into Australia's Intellectual Property Arrangements recommended that treatment of virtual or non-physical designs be reconsidered.

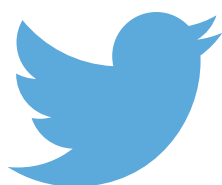
Given that Australia has a two stage design registration and certification system, and most non-physical designs will pass the first registration test, applicants may be advised to continue filing for non-physical designs and perhaps request certification when Australian Designs law is overhauled in the near future.



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Federal Court denies patent term extensions for Swiss type claims

The Full Federal Court of Australia has overturned an earlier decision of the Administrative Appeals Tribunal (AAT) and ruled that Swiss style claims relating to pharmaceutical substances produced using recombinant DNA technology are not eligible for patent term extension.

The decision in *Commissioner of Patents v AbbVie Biotechnology Ltd*¹ relates to Patent Nos 2012261708, 2013203420 and 2013257402. These three patents all claim the use of a pharmaceutical substance called adalimumab in the manufacture of a medicament for the treatment of a different medical condition (ulcerative colitis, Crohn's disease and rheumatoid spondylitis, respectively). Adalimumab is produced by recombinant DNA technology and is sold under the brand name HUMIRA™.

Claims of the format of 'use of substance X in the manufacture of a medicament for treatment of condition Y' are generally known as Swiss type claims and are a way of claiming a second medical use of pharmaceutical substance X.

For most pharmaceuticals, a patent term extension is available only if a relevant claim of a patent covers the pharmaceutical substance *per se*. In other words, a new use of a known pharmaceutical substance protected by a patent claim is generally not extendible beyond the standard 20 year term. Under s 70(2)(b) of the Patents Act, an extension is also available where a claim or claims of a patent disclose a pharmaceutical substance 'when produced by a process that involves the use of recombinant DNA technology'.

In their prior decision, the AAT reasoned that s 70(2) does not indicate that Swiss type claims are to be excluded from eligibility for extension and concluded that, "... eligibility for extension of a patent would be applied to product claims and to process claims but only where such claims were made in respect of a substance produced by a process of recombinant DNA technology."²

The Commissioner appealed the AAT decision and this has provided the first occasion on which the construction of s 70(2)(b) has been considered by the Federal Court. Interestingly, AbbVie declined to participate in the proceedings and so there was no contradictor to the Commissioner's case.

In considering the appeal, the Full Court focused on the meaning of pharmaceutical substance within the context of both s 70(2)(a) and s 70(2)(b). They were clear that the provisions of s 70(2) are concerned with inventions that are products, not inventions that are methods or processes, and also not additional or other matters concerning or involving the use of pharmaceutical substances. The Court referred also to the specific acknowledgement in the Explanatory Memorandum to the Patents Act that claims to pharmaceutical substances, when used in new and inventive methods of treatment, are not intended to be part of the extension of term regime.



The Court went on to state that Swiss type claims are not claims to pharmaceutical substances at all, but rather method or process claims which are fundamentally different to the scope of the claims addressed by s 70(2).

The Court also found that the claims in suit were not directed to adalimumab produced by recombinant DNA technology. The Court held that, firstly, the claims in suit are to a method or process in which adalimumab is used to produce a medicament, and secondly, they are directed to a medicament containing adalimumab that is to be used for specific therapeutic purposes. The Court concluded that the claims in suit were of an entirely different scope to those addressed in s 70(2)(b), reasoning that the fact that, "... the claims in suit are in the form of Swiss type claims necessarily means that the pharmaceutical substance in question (adalimumab) does not in substance fall within the scope of the claim or claims of the specifications in suit"³

This decision underlines the fact that second medical use claims, whether Swiss style or method of treatment, are not eligible for patent term extension in Australia because they are process claims rather than product claims and therefore do not fulfil the requirements of s 70(2).

References

1. *Commissioner of Patents v AbbVie Biotechnology Ltd* [2017] FCAFC 129.
2. *AbbVie Biotechnology Ltd Commissioner of Patents* [2016] AATA 682 (5 September 2016), at [69].
3. *Commissioner of Patents v AbbVie Biotechnology Ltd* [2017] FCAFC 129, at [61].



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Be aware – IP owners targeted by scammers

Owners of patents, trade marks and registered designs are increasingly being targeted by unscrupulous organisations with fake invoices and unethical business practices. It is important that you and your accounting teams are alert to this.

Check that invoice!

Being an IP owner means that you will be required to pay annuities. These are payable every year for patents and every 10 years for trade marks. Increasingly, we are seeing pseudo (unsolicited) invoices being sent directly to rights holders, and it is important that these are not paid. If annuities are handled by your attorney, you should alert them directly to the receipt of these invoices. If you inadvertently pay these invoices, it may result in duplicate payments by your authorised agent (your attorney). The worst case scenario is that if you pay one of these invoices, you may find that subsequent annuity payments are not processed and your rights may cease.

Organisations that have been known to be active in this area include:

- > Commercial Centre for Industry and Trade (Switzerland)
- > Company for Economic Publications Ltd (Austria)
- > Company for Publications and Information Anstalt (Liechtenstein)
- > Edition The Marks KFT (Hungary)
- > European Institute for Economy and Commerce (Belgium)
- > FOIP Federated Institute for Patent and Trademark Registry (USA)
- > Globus Edition SL (Spain)
- > INFOCOM (Switzerland)
- > Institute of Commerce, Trade and Commerce (Switzerland)
- > International Patent and Trademark Agency (Czech Republic)
- > International Patent and Trademark Register (Germany)
- > IP Data s.r.o (Czech Republic)
- > IPT Patents
- > IT & TAG (Switzerland)
- > Objective Concept (France)
- > Patent & Trademark Office Pty Ltd (Melbourne, Vic., Australia)
- > Patent & Trademark Organisation LLC (based in the USA with a street address in Melbourne)
- > Register of International Patents and Trademarks TM Collection (Hungary)
- > TM-Edition Ltd. (Hungary)

- > TM Worldwide (Hungary)
- > Trade Mark Publishers (based in Austria with a street address in Sydney)
- > Trademark & Patent Publications (based in Poland with a street address in Sydney)
- > UPTS – Universal Patents and Trademarks Service s.r.o (Czech Republic)
- > World Patents Trademarks WIPT s.r.o (Czech Republic)
- > ZDR-Datenregister GmbH (Germany)
- > WORTA – World Organization for Trademarks

Below is an example of an invoice from Patent & Trademark Office Pty Ltd.

Pending Trademark CANCELLATION BY IP AUSTRALIA

Your Trademark is about to expire.

<p>1. Correspondence address:</p> <p>Apco Service Stations Pty. Ltd. 343-353 Thompsons Road, NORTH GEELONG VIC 3215 AUSTRALIA</p>	<p>2. Graphic representation:</p> 
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IMPORTANT TRADEMARK RENEWAL OFFER

3. Trademark Name: EASY SHOP	7. Trademark Number: 804502
4. Mark Type: Composite	8. Number of Classes: 1
5. Registration date: 20-08-1999	9. Classes: 35
6. Status: Registered/Protected	10. Renewal process starts: 20-08-2017

11. ORDER FORM

Please return this signed document if you would like to renew your trademark. Your trademark will be renewed for the period of another ten (10) years. The renewal fee is 1285 AUD for one class and 550 AUD for each additional class. You will receive an invoice from us after we have received this signed document from you. By signing this document you automatically and irrevocably agree with the terms and conditions of this document. Furthermore, by signing this document you empower Patent & Trademark Office Pty Ltd to renew the trademark on your behalf. The main aim of Patent & Trademark Office Pty Ltd is to remind companies about the dates when their trademarks are due for renewal. Note that trademarks may be lost if they are not renewed in time. This renewal is optional and only acts as a reminder. We would like to inform you that we are not IP Australia, and this is not a bill. You can also contact your representative or lawyer in order to assist you with the renewal process. If you have any questions regarding your renewal, please contact us via e-mail info@office.org or phone + 61 7 3987 8915 or fax + 61 3 9923 6363.

<p>12. Renewal fee</p> <p>One class Renewal Fee: \$ 1,285</p> <p>Each subsequent class: \$ 0</p> <p>TOTAL Fee: \$ 1285</p>	<p>13. SIGN AND RETURN IN THE ENCLOSED ENVELOPE:</p> <p>Name, Last name: _____</p> <p>Position: _____</p> <p>E-mail: _____</p> <p>Date and Signature: _____</p>
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14. Select your payment method:

Cheque

Electronic invoice (via e-mail, with instructions for payment)



15. The renewal process looks as follows:

1. You receive the Order Form from Patent & Trademark Office Pty Ltd;
2. You submit signed Order by e-mail or by mail;
3. Receive an invoice and Order confirmation from Patent & Trademark Office Pty Ltd that we received your application within the deadline;
4. Upon receipt of all the fees the trademark renewal documents will be submitted by our expert to the IP Australia;
5. After procedure conclusion Patent & Trademark Office Pty Ltd will send the confirmation.

Monitoring services

Another area where organisations are active is in supposed 'monitoring services', which include requests that offer to 'monitor' your IP right. For example, they may offer to monitor whether your trade mark is being used as a domain name or whether identical trade mark applications are made in particular countries. These services may indeed be commercial and legitimate offerings however, many are not.

You may also receive requests to monitor and alert you when renewals on particular patents or trade marks are due. Again, some services may be legitimate but many are not. If your IP is being managed by an attorney firm, they will have a sophisticated annuity reminder system that is tied in with your entire IP portfolio.

Additional registers

We have also seen an increase in offers to list your IP on a 'register'. These supposed 'registers' are usually based outside of Australia and make elaborate claims about the 'need' to be listed on these 'registers' to effectively protect your IP.

These additional 'registers' are simply money making exercises and provide no additional legal protection. Once you have registered your IP in another country, it will exist on that country's publicly accessible official register. This is automatic and a standard part of the patent or trade mark application process.

Domain names

If you are the owner of a registered trade mark, you may receive unsolicited letters alerting you to domain names which contain your registered trade mark. The letters often request that you engage them to undertake investigations or to acquire the alleged domain names. While domain names may be an important part of your trade mark strategy, it is important not to react to these alleged threats. If such domain name registrations exist and affect your rights, there may be other avenues available to stop or secure the domain name.

Protect yourself from scams

As official registers of IP rights are publicly available around the world, unscrupulous organisations can mine the information and create mass mail outs offering bogus or worthless services. The only way you can protect yourself is to be vigilant and ensure that those who handle IP correspondence in your organisation, particularly accounting teams, are aware of these scams. If you receive any of these correspondences, please contact your attorney who will be able to advise you further.



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The importance of searches before adopting a trade mark

The case of *Pham Global Pty Ltd v Insight Clinical Imaging Pty Ltd* [2017] FCAFC 83 shows the importance of a thorough search of the names and marks of potential competitors before adopting a new trade mark.

The facts

Pham Global was sued by Insight Clinical for using the words 'Insight Radiology' and a similar logo to Insight Clinical's registered trade mark. Pham Global tried to defend the case, in part, on the basis that it had adopted and used its name and logo honestly.

Mrs Pham gave evidence that she conducted business name, company, trade mark and Google searches for the words 'Insight Radiology' (and later other terms), but admitted that she could not actually remember doing these searches and was reconstructing what had happened. She also corrected her evidence twice. Insight Clinical provided expert evidence that if Mrs Pham had conducted Google searches, they would have revealed Insight Clinical's website.

The law

Honesty can operate as a defence to trade mark infringement in some circumstances but it is not sufficient just to be ignorant of the rights of the earlier trade mark owner. The law expects businesses to be careful before starting to use a new trade mark and make sure that they will not infringe someone else's rights. This means they must do searches that include:

- > Internet search engines such as Google
- > registered business and company names
- > trade journals and telephone directories
- > the Trade Marks Register.

The trial judge considered that Mrs Pham's searching was not sufficiently careful and therefore held that Pham Global had not been honest in adopting and using its name and mark.

Take home message

1. When adopting a new trade mark, a business should carry out the searches set out above.
2. Searching the Trade Marks Register is not as easy as it seems. For example, if someone currently searches just for the words INSIGHT RADIOLOGY they will not locate a prior registration for INSIGHT CLINICAL IMAGING even though both relate to radiology services. Professional searching services can often locate prior conflicting marks that may not be picked up in a lay search and can avoid the expense of a dispute with another trade mark owner.
3. When conducting Google and other searches, it is very important to keep copies of the search results, either in electronic or paper form and file them where they can be easily accessed later. If, several years later, your use of a trade mark is challenged, you do not want to be in the position of Mrs Pham, who had to try and recall what searching she had done years before and explain why her searches had not revealed Clinical Imaging.



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