

22 September 2021

Paula Adamson
Registrar of Trade Marks
IP Australia
47 Bowes St
PHILLIP ACT 2606

By email: paula.adamson@ipaaustralia.gov.au

Dear Registrar Adamson,

Submission to the Registrar of Trade Marks: Recent Change to the Official Journal of Trade Marks

1. The Intellectual Property Committee of the Business Law Section of the Law Council of Australia (the **IPC**) is writing in relation to the determination made by you in your capacity as Registrar of Trade Marks on 7 June 2021 that ‘for the purposes of subsection 226(1) of the *Trade Marks Act 1995* (**TMA**) the Official Journal of Trade Marks is the Australian Trade Mark Search portal’. From 8 June, it appears that IP Australia is no longer publishing the Official Journal of Trade Marks as a stand-alone document.
2. The IPC is concerned about the effect of the above determination.
3. Under s 226(1) of the TMA, the Registrar of Trade Marks ‘must issue (electronically or otherwise) at regular intervals, as determined by the Registrar, an Official Journal of Trade Marks containing: (a) the matters that are required under this Act to be advertised in the Official Journal’.
4. The IPC is aware that in June 2021 the Institute of Patent and Trade Mark Attorneys (**IPTA**) sought advice from counsel as to the 7 June determination. This advice was provided to IPTA by Ed Heerey QC on 13 July, and has been shared with the IPC.
5. Ed Heerey QC’s view is that the 7 June determination does not comply with the requirements of s 226 of the TMA. More specifically, his view is that ‘a Court is unlikely to accept that an online database which also constitutes the Register of Trade Marks satisfies the requirement of the “Official Journal” which the Registrar must “issue” at regular intervals under s 226 so as to “advertise” certain information as required by the other sections of the TMA’ (para 59).
6. The IPC is aware that IPTA also asked for advice as to ‘the consequences in relation to any action, including a trade mark registration issued, which is required to be published after 9 June 2021’. Ed Heerey QC’s view as to such consequences is as follows:

63. As a matter of generality, any failure of the Registrar to comply with the requirements of the TMA is clearly a serious matter, and ought to be rectified urgently. However, it is more difficult to predict how it will affect the rights of particular parties in specific situations.

64. As to the advertisement of a trade mark registration, it would seem that the validity of the rights granted to the trade mark owner under s 20 would not be undermined. However, the Registrar's failure to advertise the fact of registration in the Official Journal in compliance with ss 71(a) and 226 of the TMA might complicate the enforcement of the owner's rights against third parties under s 120, if those parties are otherwise unaware of the registration.

65. Another more immediate problem that arises from the Registrar's failure to comply with s 226 is the potential for disputes as to when deadlines apply for filing various types of notices of opposition, on the basis that there has not been a valid advertisement in the Official Journal to trigger the relevant deadline.

7. The IPC agrees with the views expressed in Ed Heerey QC's opinion, and is aware that IPTA also agrees with such views, and will be making a separate submission to you to this effect.
8. The IPC is generally supportive of IP Australia seeking to use new technologies to fulfil the Registrar's statutory obligations and to improve users' access to information. However, the IPC's concern is that the 7 June determination, and the cessation of the publication of a stand-alone Official Journal from 8 June, are not in compliance with the Registrar's obligations under the TMA.
9. The IPC would be grateful for an opportunity to meet with you, ideally together with representatives from IPTA's Trade Marks Subcommittee, to discuss possible solutions to the problem outlined above and in Ed Heerey QC's advice.
10. Pending such a meeting, we would urge you to commence publishing, at least weekly, a simple compilation of all changes that have occurred since the last Journal, and to have that available for online searching and viewing, and for download as a searchable pdf file.

Conclusion and further contact

11. The IPC would be pleased to discuss any aspect of this submission.
12. Please contact the chair of the IPC, Matthew Swinn on 0411 349 242 or at matthew.swinn@au.kwm.com, if you would like to do so.

Yours faithfully



Greg Rodgers
Chair, Business Law Section