

DENTONS

Intellectual property

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Intellectual property

In Australia, intellectual property rights are protected mainly by federal legislation and the common law.

1. Trade marks

Australia has a system for registering trade marks for names, logos, devices, colours, sounds, shapes and smells that distinguish the goods or services of the owner from those of other businesses.

Registered trade marks are regulated by the federal Trade Marks Act. Prior registration of a trade mark is strongly recommended for those seeking to enter the Australian market using that mark.

A registered trade mark provides its owner with the exclusive rights to use, license and assign it. The owner must actually use the trade mark in the course of trade or the trade mark risks being removed from the register on the grounds of non-use.

It takes about seven to 12 months for a trade mark to be registered from the date of application and initial registration of a trade mark lasts for 10 years. The registration can be renewed for successive periods of ten years in perpetuity assuming it continues to meet ongoing use requirements.

Only registered trade marks may use the ® symbol. By placing the ® symbol immediately next to the registered trade mark, other businesses are put on notice of that registered trade mark right.

In Australia, the common law protects the use of unregistered trade marks used to distinguish the source or origin of goods or services by allowing an action for passing off provided they meet the criteria for protection. Trade mark owners frequently take action against infringers for “passing off” - often accompanied by an action under provisions of the Australian Consumer Law which prohibit persons (including businesses) from engaging in misleading or deceptive conduct (or conduct that is likely to mislead or deceive) in the course of trade.

Unregistered marks can be denoted as such by use of a ™ symbol.

Australia is a signatory to an international treaty known as the Madrid Protocol for International Trade Marks (Madrid Protocol). The Madrid Protocol enables trade mark applicants to seek protection in all or any of the countries that are signatories to the Madrid Protocol by filing a single application in Australia.

An international application under the Madrid Protocol must be based on an underlying Australian application.

There are strict regulations covering commercial agreements under which a licensee is granted a right to operate a business associated with a trade mark owned by a licensor where monies are paid and it is important to obtain advice on whether the particular commercial arrangement is within the scope of these strict relationship laws before the agreement is signed (as noted above in “Expansion into Australia via distributors, agents, licensees or local operations”).

2. Copyright

In Australia, there is no system of registration for copyright works. Copyright instead subsists in an original work from the time the work is created.

For literary, dramatic, musical or artistic works, sound recordings, films, television and sound broadcasts, copyright subsists for the life of the author plus 70 years. For published editions of works, copyright subsists for 25 years after first publication.

Australia’s Copyright Act provides the owner of the work with a number of exclusive rights. Those rights may be licensed or assigned.

The Copyright Act confers moral rights on authors, giving creators of certain works rights of attribution and to prevent unfair treatment of those works. Moral rights are not assignable but consent may be obtained from the author to infringe their moral rights.

A copyright notice is not necessary in Australia, but it is recommended as it puts the public on notice that copyright in the work is claimed.

Australia is a signatory to various international conventions that deal with copyright. In particular, under the Berne Convention, works created in countries which are also signatories to the Convention will be treated as if they were created in Australia for the purposes of Australian copyright protection.

Various copyright collecting societies administer certain uses of copyright materials for their members and are authorised to collect fees for uses of the copyright materials, which they redistribute to copyright owners.

3. Patents and inventions

Inventions for new, useful and inventive products, substances, methods and processes may be registered for protection as a patent in Australia.

Australia is a signatory to the Patent Cooperation Treaty (PCT), which allows an applicant to file a single international application filing date listing Australia which then enters into the national phase to proceed towards examination for grant under Australian law.

Once registered, an Australian patent allows the owner to prevent any unauthorised persons or businesses from exploiting a product, substance, method or process that embodies the patented invention.

Patents are regulated under the federal Patents Act and must be examined by IP Australia prior to grant and before they can be enforced by the patent owner or, in some cases, by its licensee.

Patents in Australia are protected for a term of up to 20 years (with extensions of up to five years for pharmaceutical patents).

4. Designs

Design rights are able to be registered in Australia to protect the overall visual appearance of new and distinctive products. The overall visual appearance can be a combination of visual features including shape, colour, configuration, pattern and ornamentation. The primary legislation which governs the Australian design rights system is the federal Designs Act. A design right initially lasts for five years from the date of application for registration and the owner may choose to renew it so that it lasts for a further five years. It can only be renewed once.

Australia is a signatory to the International Convention for the Protection of Industrial Property (the **Paris Convention**). Australia is not a contracting party and cannot accept applications under the Hague System for the International Registration of Industrial Designs.

5. Domain names

The .au Domain Administration (auDA) is the administrator for the .au country code top level domain (ccTLD). Such domain names and other Australian domain names (such as the '.au' direct domain namespace e.g. domain.au) can be registered for renewable one to five year periods for eligible registrants.

To register a '.com.au', '.net.au' or '.au' domain name, the applicant must meet eligibility criteria.

Domain names are granted to eligible registrants who meet the criteria on a first come, first served basis. Where someone has registered a domain name without a legitimate business interest, the domain name may potentially be transferred to a party with a legitimate interest in the domain name following resolution of the matter under the .au Dispute Resolution Protocol (for .au domain names), or the Uniform Dispute Resolution Protocol (for most other domain names).

A domain name licence can be obtained for a licensing period of up to five years and may be renewed before the licence expiry date or the short grace period.



6. Plant breeder's rights

Regulated by the federal Plant Breeder's Rights Act, plant breeder's rights protect new plant varieties and their reproductive material. The owner of those rights is exclusively entitled to produce, reproduce, commercially exploit or market the new plant variety.

Only new or recently exploited varieties can be registered. If registered, the Act confers protection for up to 20 or 25 years (dependent on plant type) subject to compliance with renewal processes.

7. Circuit layout rights

The federal Circuit Layouts Act provides for protection of certain original layouts for integrated circuits which have the purpose of performing an electronic function integrally formed in or on a piece of material, where the criteria for protection are met. The criteria for protection include the requirement that the representation of the circuit layout must have been made by Australians or other eligible persons or first commercially exploited in Australia or in eligible foreign countries.

Protection of eligible layout rights are for between 10 and 20 years, depending on the circumstances.

8. Trade secrets and confidential information

Trade secrets and other confidential information are protected generally with confidentiality agreements. Australia does not have a specific legislative regime for the protection of trade secrets or confidential information (although there are various laws which protect against the disclosure of confidential information through imposing an obligation of confidence, such as workplace laws, the privacy laws and laws imposing duties on directors or officers of a company). The common law covers infringement of trade secrets and breaches of confidentiality obligations. To be protected under the common law, the information must meet certain minimum criteria.

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