



**CHARTERED SECRETARIES
AUSTRALIA**

Keeping good companies

15 March 2004

Jeff Roberts
Secretariat
Advisory Council on Intellectual Property
IP Australia
Ground floor, Discovery House
47 Bowes Street
WODEN ACT 2606

jroberts@ipaaustralia.gov.au

Dear Mr Roberts

**Submission to the Advisory Council on Intellectual Property
Re "A review of the relationship between trade marks and business names,
company names and domain names"**

Chartered Secretaries Australia Limited (CSA) is Australia's peak membership body for corporate governance and compliance, and considers itself fully qualified to respond to this matter. In Australia, CSA has over 8000 members and affiliates representing the majority of public companies listed on the Australian Stock Exchange (ASX). Members of CSA regularly deal on a day-to-day basis with the ASX, the Australian Securities and Investment Commission (ASIC) and the Australian Competition and Consumer Commission (ACCC) and have a thorough working knowledge of the operations of the markets, the needs of investors and the law and regulation relating to market practices and independence.

In addition to the above, in many organisations, Company Secretaries have primary responsibility for company names and ASIC compliance, trade marks and business names registration

CSA considers that there is a need to improve the relationship between trade marks, business names, company names and domain names.

The confusion that exists as a result of:

- a lack of centralised name registration system and
- the different rights conferred by the registration and use of each type of name

highlight the need for greater clarity in the registration process to ensure that applicants understand the options for protecting product and business names.

CSA is supportive of proposals to streamline registration processes and simplify the means of addressing possible conflicts between or objections by applicants and registered holders of names. In particular we would welcome mechanisms that would enable simpler correction of bad faith registrations.

In response to the issues raised by the Advisory Council on Intellectual Property CSA makes the following comments:

1. CSA supports any measures to improve education in this difficult and misunderstood area of corporate administration.
2. We support the establishment of a central register for business and company names, trade marks and domain names. We note that currently searches on the ASIC website disclose like company and business names, as both are administered by ASIC either at National or State levels. As the business names are available on the national website, we suggest that there is no justification for continuing the separate state based registers. This would have the added advantage of establishing common re-registration practices eg Queensland annually, others three-yearly. The inclusion of trade mark and domain names will require co-operation from the relevant authorities.
3. We do not support a two-tier registration system for trade marks as it is likely to cause confusion. The registration system is already cumbersome and lengthy without further complications.
4. As a matter of education we suggest that application forms and certificates issued for company names and business names should clearly indicate that no proprietary rights are created by the registration of the name.
5. Application forms for business names and company names registration should alert applicants to the need to undertake a search of trade and service mark registers to ensure that their business or company name does not potentially conflict with a registered trade mark. Attention should be drawn to the various classes of marks.
6. Federal legislation should be enacted to allow for a business, domain or company name registration to be challenged prior to registration. In the past ASIC / ASC would advise holders of like names of applications for company names that could conflict. This practice ceased some years ago, resulting in a large number of potential conflicts, particularly in similar business areas. Bringing the registration of company, business and domain names and trademarks under a common central register would do much to overcome the current bad faith conflict between the various types of name.

In closing please note that CSA is willing to assist the Council by providing sessions educating the business community in this important area of administration.

If you would like to discuss our comments in any further detail please do not hesitate to contact me on 02-9223-5744.

Yours sincerely,



Tim Sheehy
CHIEF EXECUTIVE