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Proposition 1: A trademark is defined as ‘ a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.’ Trade Marks Act 1995 (Cth) s 17.

Additionally, trademarks are acknowledged as a form of personal property. Trade Marks Act 1995 (Cth) s 21(1).

Proposition 2: At one time, a trademark could not consist of entirely of the shape of a product, but must have been capable of being separately described. *Coca-Cola Co. v. All-Fect Distributors Ltd* (1999) 96 FCR 107, 116. This was later refined to the idea that a trademark cannot consist of entirely the shape of the product to the extent that the shape is integral to the function of the product. *Koninklijke Philips Electronics NV v. Remington Products Australia* (2000) 100 FCR 90; *Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks* (2002) FCAFC 273.

Proposition 3: Other aspects of a product that can function as a trademark include colour, sounds, and scent. Trade Marks Act 1995 (Cth) s 6.

Proposition 4: Under the new Trade Marks Act, there exists a presumption of registrability. Trade Marks Act 1995 (Cth) s 33 (1). This has been commonly interpreted to mean that in situations of doubt regarding the registration of a mark before the trademark Registrar, the matter is to be found in the favour of the trademark applicant. Michael Handler and Robert Burrell, ‘ Rethinking the Presumption of Registrability in Trade Mark Law’ (2012) 38 *Monash University Law Review* 148, 164.

Proposition 5: A common grounds for rejecting a trademark registration is that the trademark fails to distinguish the applicant’s goods and services

from those of others. Trade Marks Act 1995 s 41.

Distinctiveness is shown through a three part test. First, it is questioned whether the trademark is inherently adapted to distinguish. If this alone is not enough, the consideration must further include the use or intended use of the mark. Finally, even if the mark does not have an inherent adaption to distinguish, if it can be shown that the mark does in fact distinguish that is sufficient for registration. Trade Marks Act 1995 ss 41 (3), 41 (5), 41 (6).

Proposition 6: Intent to use a trademark for registration must not be dependent on specific market conditions, Rawhide Trademark (1962) RPC 133, and must be an objective intent, Johnson and Johnson v. Unilever Ltd Aust Ltd (1994) AIPC 91-038.

If the use is by someone other than the trademark owner, to be sufficient for registration specific authorization and control requirements must be met. Trade Marks Act 1995 (Cth) s 27 (1).

Proposition 7: Use as a trademark is a three-step analysis. First, it involves looking at the nature and purpose of how the mark was used under the facts at issue. Second, the court must examine if the use at issue is among the ways trademarks are commonly used in the trade involved in that particular case. Thirdly, an analysis of the manner of display of the mark in relation to the product or service is appropriate. Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd, (1963) 109 CLR 407.

## **Bibliography**

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