

INNOVATIONS



LEGAL UPDATE

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.eu – the new internet fixture

Do you have brand presence in Europe, a registered office there or planning to launch into Europe?

Key message

The European Union has recently become an internet fixture, which means the .eu domain is now available for registration.

You may already have a .com or .com.au domain registration. No doubt you see these registrations as important avenues for company and brand exposure and capturing on-line revenue. But have you considered registration in the most recent cyber place?

The European Union recently became an internet fixture with the launch of the .eu domain. Previously there have only been country-specific domains throughout Europe. Now the launch of the .eu domain means that you or your company may have one domain that covers the whole region and the ever-growing number of countries that are members in the EU.

Unlike the .com domain, the .eu ending aims to maintain its European Union identity with one of the prerequisites for registration being that a business applicant has its headquarters, administration or main office in the EU, and, for individual applicants, that they must be resident within the EU.

In the hope of being able to discourage cyber-squatting, registration for .eu domains has also been strictly controlled with domain registrations being released in several phases. The first phase, described as the first sunrise period has been reserved for public bodies, registered trade mark holders and geographical areas.

Confirming the fierce demand for .eu domains, during the first phase, approximately 180,000 requests have been made for 131,000 domain names. According to the .eu registry, EURid, within the first hour 23 applications had been made for 'sex.eu', 15 for 'schumacher.eu' and 12 each for 'realestate.eu' and 'business.eu'.

In anticipation of several claims being made for ownership in the same name, PricewaterhouseCoopers has been appointed by EURid as the validation agent. Competing claims based on legal rights of ownership in a name, are subject to careful scrutiny and require validation before being accepted for registration.

Like other domain name registrations, applications are considered on a first-come, first-serve basis. EURid will receive applications through some 779 registrars around the world including in Australia. As a result, should you have a presence in the EU then we recommend that you seek to register a .eu domain name. We are able to provide you with further information on applying for a .eu domain name and we are able to register your .eu domain names on your behalf.

The Copyright Amendment Bill 2006: Exceptions and other Digital Agenda review measures

Recordings of radio and television broadcasts

Did you know that the recording of television or radio broadcasts is unlawful under the Copyright Act 1968 (Cth) (the Act)? Fortunately this will no longer be the case when Federal Parliament passes the amendments foreshadowed in the Copyright Amendment Bill 2006. The amendments permit individuals to make recordings of television and radio broadcasts for private use at a later time, provided the recording is made on domestic premises and is solely for private and domestic use. The recordings no longer need to be deleted after the first use, which was to be the case under the proposed amendments earlier in the year. Nonetheless, the amendments prohibit the long-term retention of recordings and the building of a personal 'library' of recorded broadcasts. The amendments also prohibit the distribution of the recording for the purposes of trade or otherwise, unless that distribution is to a member of the lender's family or household.

Reproduction of copyright material in a different format for private use

Under the amendments, the owners of authorised books, newspapers or periodical publications can copy the work into a different format for private use at a later time by either themselves, a member of their family or a member of their household, provided the person who copied the work retains the book, newspaper or publication from which the copy was taken. This means you will be able to download a newspaper article and save it to your PDA or scan a book

and read it on your PC. The restrictions on copying are similar to those for recordings of television and radio broadcasts, so that the sale, hire or distribution for the purposes of trade or otherwise are again prohibited.

Copying of sound recordings in a different format for private use

The amendments will also provide relief for users of mp3 devices, such as iPods and iRivers. It will no longer be unlawful to copy your own CDs or other sound recordings from one format to another, provided you retain the original copy of the sound recording. This means you can now lawfully copy your CD collection to your iPod. Again, the sale and hire of the copy is prohibited, as is the distribution of the copy to any person who is not a member of your family or household. Persons wishing to take advantage of the amendments should keep in mind that the copying of a sound recording in the same format, for example CD to CD, is still prohibited under the Act.

Copying of videotape in analogue form to electronic form

Under the amendments you can also copy your own authorised versions of videotapes to electronic form, provided you retain the original authorised videotape. The same prohibitions in relation to the sale, hire and distribution of the copies apply. Persons should note that the amendments do not appear to permit the copying of electronic films, such as DVDs, to a different format.

Penalties

The amendments also incorporate tougher penalties for copyright pirates. Police now have powers to issue on the spot fines and customs have increased seizure powers. The amendments also incorporate a change in presumptions in litigation, which will make it easier for copyright owners and prosecutors to establish piracy.

The government is continuing to update intellectual property laws in order to keep up with consumers needs and the advances of technology. However, the government must continue to monitor technological advances to ensure that the law keeps up with these changes.

Amendments to the Customs provisions in the *Trade Marks Act 1995 (Cth)*

*Since its introduction in 1995, the **Trade Marks Act 1995 (Cth)** (the Act) has remained in force relatively unchanged. In recent years, the Government has reviewed the Act in light of current legislative policy and industry practice. As a result, the **Trade Marks Amendment Bill 2006** (the Bill) was introduced into Parliament in June 2006 and passed by the Legislative Council on 17 August 2006.*

The amendments aim to improve Australia's system of trade mark registration and protection by enhancing public confidence in the system and reducing the administrative and financial burden experienced when registering and protecting trade marks. Some of these amendments will assist brand owners with respect to their Custom programs and the financial burden associated in setting up these systems.

Currently, registered trade mark owners can request that Customs identify the arrival into Australia of goods which infringe their trade marks by providing a written notice of objection along with a \$10,000 bond. This notice remains in effect for 2 years.

The proposed changes will now make it easier for you to protect your registered trade marks. Notices requesting that

Customs seize infringing goods will stay in effect for 4 years instead of 2 which reduces the time and burden of having to renew your Customs Notice each two years. This change came into effect on 23 October 2006.

Furthermore, the burdensome up-front payment of a \$10,000 cash bond or bank guarantee is intended to be replaced by a written undertaking to repay the Commonwealth the cost of seizing the goods. This reduces the financial burden placed on you in having to put up security in the form of cash or bank guarantee in the sum of \$10,000. This change will come into effect on 23 April 2007.

We are able to provide you with further information on setting up and running a Customs Program on your behalf in order to assist in protecting your brand against counterfeiters.

Have you sought registration of your trade marks in New Zealand?

There are many Australian traders who forget to seek registration of their trade marks in New Zealand when they are conducting business in the territory. A number of Australian traders also believe that their Australian Trade Marks provide them with trade mark protection in New Zealand when this is not the case.

Key message

Australian trade mark protection may not be enough to safe guard you in New Zealand.

If you conduct business in New Zealand then it is imperative that you seek trade mark protection by registering New Zealand Trade Marks otherwise other traders may register your marks and then prevent you from carrying on business in New Zealand.

The process of seeking trade mark registration in New Zealand is relatively inexpensive. In New Zealand, there is only one fee payable to the Intellectual Property Office of New Zealand being NZ\$100 per class at the time when the trade mark is filed. This fee includes the application fee and the fee for the first 10 years of registration for the trade mark. Once the trade mark is filed there are no further fees payable to register the trade mark. The next time that any fees are payable to the Intellectual Property Office of New Zealand is when the trade mark is renewed.

At this stage, New Zealand is not a signatory to the Madrid Protocol. However, if a New Zealand Trade Mark Application is filed within 6 months of filing an equivalent Australian Trade Mark Application, then the New Zealand Trade Mark Application is afforded the earlier priority date. It is important to secure the earliest possible priority date for your trade mark in New Zealand to ensure that other traders do not register your trade mark in New Zealand before you do.

Even if you have not started using your trade mark in New Zealand, you are still able to file a trade mark application if you have an intention to export products sometime in the near future to New Zealand which feature the trade mark. Even though you may not currently be using your trade mark in New Zealand, the fact that you have a real intention to use the trade mark in New Zealand in the near future is enough for you to seek registration of the trade mark in New Zealand.

However, if you do not use the trade mark in New Zealand within three years from the date of filing the New Zealand Trade Mark Application, then the trade mark may be the subject of a removal application based on non-use. Despite this, if you have an intention to use your trade mark in New Zealand then we recommend that you file a trade mark application in New Zealand as quickly as possible in order to secure the earliest possible priority date.

It is important that you consider filing trade mark applications in New Zealand when you file the equivalent trade mark application in Australia. If you do not then you may be prevented from trading in New Zealand by reference to your trade marks if another trader registers the same trade mark or a similar mark in New Zealand before you do.

Further information

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