

# AUSTRALIAN INTELLECTUAL PROPERTY JOURNAL

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EDITORIAL ..... 69

## ARTICLES

### **The American experience with trademark anti-dilution law – *J Thomas McCarthy***

The question has recently been asked whether Australia should protect well-known or famous trade marks from being diluted. The United States has lived with a federal anti-dilution law for eight years. This has presented new and perplexing questions. Traditional trademark law rests primarily on a tort-like policy of protection of customers from mistake and deception. But anti-dilution law resembles an absolute property right in a trade mark. In 2003, the United States Supreme Court rendered its first interpretation of the federal anti-dilution law in the *Victoria's Secret* case. The United States experience is examined and discussed, with the goal of providing guidance for the future of Australian trademark law. .... 70

### **Geographical indications, WIPO and TRIPs – where to from here? – *Susan Farquhar***

Geographical indications have emerged in recent years as a significant and sensitive topic from both the intellectual property protection and the trade protection perspectives. The two key international fora responsible for debating and developing policy in these areas, the World Intellectual Property Organization and the World Trade Organization TRIPs Council, have devoted considerable resources and time to consideration of appropriate definition and treatment of this element of the intellectual property system. A major challenge has been to balance the political interests driving some aspects of the debate with the interests of maintaining coherence within the intellectual property system. .... 82

### **Trade-offs in trade mark protection – an economic analysis – *Alexandra Folie and Stephen P King***

Determining the optimal level of trade mark protection requires a careful balancing of market incentives. On the one hand, trade marks and branding provide valuable information to consumers, reduce search costs, enable high quality firms to signal their superiority to customers and create an incentive for firms to supply higher quality products. On the other hand, trade mark law may act as a barrier to entry for new firms, if it unreasonably restricts an entrant's ability to inform customers. This article surveys the economic literature on branding and incentives, drawing lessons for trade mark law. Specifically, it is suggested that the law should consider whether the firm accused of breaching a trade mark intended to legitimately inform customers, or intended simply to deceive. While no suggestions are given for the specific legal formulation of such a test, the article warns against the trend of continuing increases in trade mark protection. .... 87

### **National icons and the Trade Marks Act 1995 – Owen Morgan**

This article answers the question – should national icons be protected under the *Trade Marks Act 1995* (Cth)? In considering whether extended trade mark protection for national icons is justified, the public interest in access to a national icon must be balanced against the right of a specific person or group to restrict that access in order to preserve a “core message” associated with the icon. It is also a matter of assessing the harm that might arise as a consequence of not providing extended protection. The article concludes that the absence of specific protection under the Act has not resulted in a level of harm that would justify further restriction on the public’s access to national icons. The Act should not be amended. .... 94

### **Shape trade marks: The role and relevance of functionality and aesthetics in determining their registrability – Mark Davison**

This article identifies some of the problems with the Australian legislation and Australian case law concerning shape trade marks and makes some suggestions about how either the legislature or the courts should respond to those problems. It is limited exclusively to circumstances where the shape in question constitutes the shape of the actual goods in relation to which the shape trade mark is used and references to shapes and shape trade marks should be read as such. .... 106

### **Patterns of trademarking activity in Australia – Paul H Jensen and Elizabeth Webster**

Over the past quarter of a century, trade mark applications have grown by 2.3% per annum faster than real GDP in Australia. This article explores the factors associated with this growth. We find some evidence that the growth in trademarking has been associated with more inventive companies, the growth of the service sector, globalisation and industry based microeconomic reforms. There is provisional evidence that higher levels of real income per capita have supported some of these factors. .... 112

### **Trade marks in the future – an IP Australia perspective – Peter Tucker**

The topic of trade marks in the future was comprehensively dealt with through the Intellectual Property Research Institute of Australia’s timely conference on Trade Marks in the Future in Melbourne on 26 September 2003. The following paper highlights some of the emerging trends that will influence trade marks in the future. .... 128

## **NEWS AND CURRENT DEVELOPMENTS**

**News from IP Australia** ..... 132

**News from the Attorney-General’s Department** ..... 133

## **BOOK REVIEW**

***A Practical Guide to Protecting Confidential Business Information* by Margaret Jackson** ..... 136

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5. Austin, n 4, p 56.

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7. Sheehy et al, n 6 at 221.

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