

Registering Non-Traditional Signs as Trade Marks in Australia: A Retrospective



Centre for Transformative Innovation

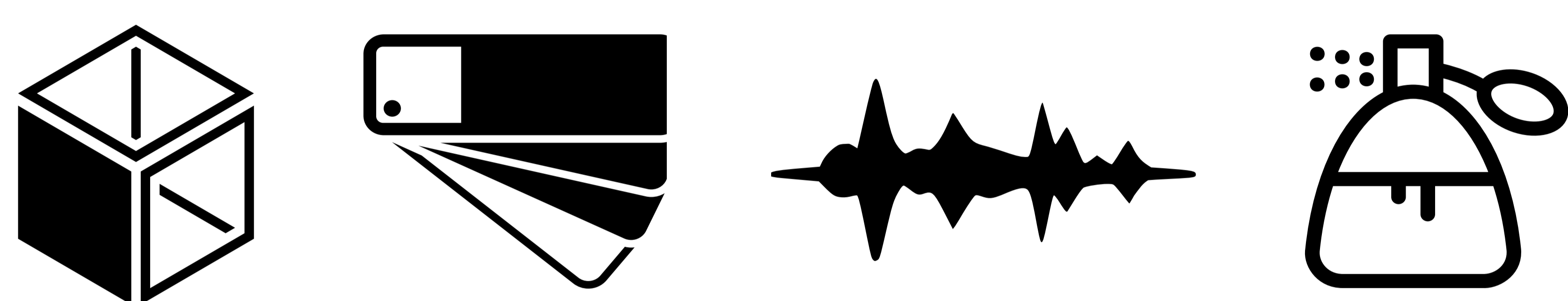
Full paper: bit.ly/non-traditional

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Background

This study provides a 20 year retrospective on non-traditional trade marks in Australia. It presents the initial findings from an empirical study on the application and registration of such trade marks in Australia, since the introduction of the *Trade Marks Act 1995* (Cth).

A trade mark is a broadly defined concept, consisting of a sign used to distinguish one person's goods and services from others.¹ While historically, trade marks were comprised of distinctive devices or signs, by the turn of the 20th century these signs had evolved to include brand names and fancy words.² In more recent times, it is largely accepted and understood that "almost anything at all that is capable of carrying meaning" can function as a trade mark.³ As such, the types of signs or subject matter capable of protection have been expanded to include all manner of indicia, including shapes, colours, sounds and scents.



20 Years of Shapes, Colours, Sounds & Scents

We studied data from IP Australia's Intellectual Property Government Open Database (IPGOD). Trade mark application data from 1 January 1996 (the date the 1995 Act came into effect) until 31 December 2015 was extracted from IPGOD. The 20 year dataset was then examined for applications for the different kinds of non-traditional trade signs, specifically being shapes, colours, sounds and scents (3,928 in total). The trade mark activity for these non-traditional signs were examined. Figure 1 shows the peaks and troughs of total applications over the 20-year period. As expected, the largest number of applications is in 1996, the first year during which the 1995 Act came into effect.

Not surprisingly, the majority of these applications were lodged by Australian applicants (around 40%). Applicants from the United States, Germany, France, the United Kingdom, and China also took advantage of the Australian trade mark system and applied for non-traditional marks. Taken as a whole however, there were more applications filed by foreign applicants, with 2,334 applications lodged (approximately 60%).

The most popular class of goods claimed for the non-traditional trade mark applications varied across each category of non-traditional trade marks. Table 1 shows comparisons between each category of marks.

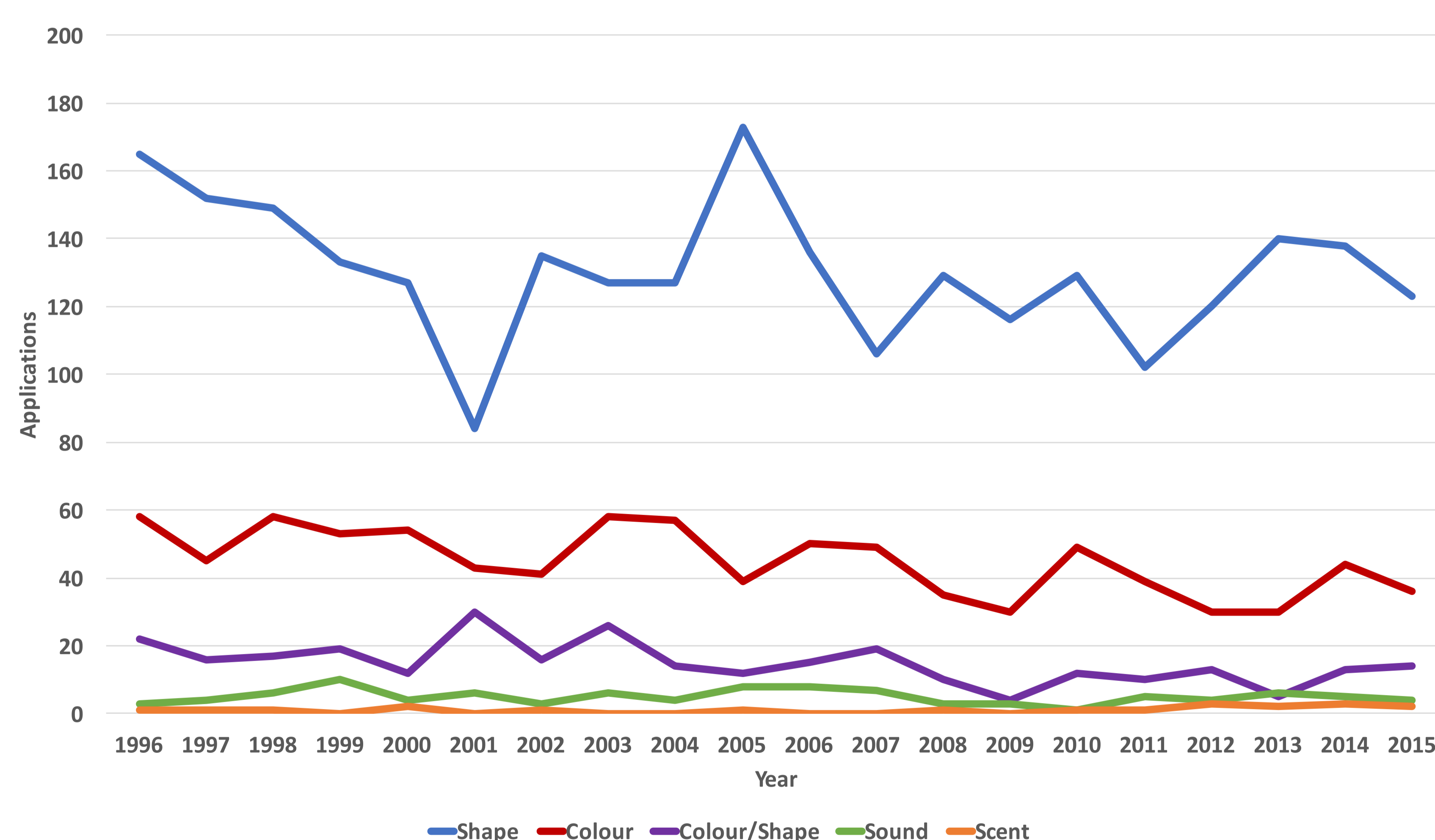


Figure 1: Proportion of Non-traditional Trade Mark applications from 1996 to 2015.

Type	Shapes	Colours	Colours/Shapes	Sounds	Scents
Applications Received	2611	898	299	100	20
Currently Registered	32%	26%	30%	52%	5%
Number Renewed	294	92	31	23	0
Most Popular Nice Classes	33, 30, 3, 32, 9	35, 9, 7, 16, 6	3, 33, 35, 5, 1	9, 35, 41, 42, 38	5, 3, 30, 34, 28

Table 1: Simple statistics for Non-Traditional Trade Mark Applications from 1996 to 2015.

Shapes Dominate

Shape marks were the most popular of the non-traditional marks. To date, 975 shape trade marks have been registered (37.3% of the total shape mark applications) and 821 are currently registered. Of the shape trade marks having been registered in the first 10-year period, 294 shape trade marks were renewed (58.2% of those marks available for renewal). On average these registered shape marks would take longer to pass examination than traditional marks (Figure 2).

The majority of applications for shape marks are categorised as device marks (1,919 applications), followed by those shape marks categorised as composite marks (692 applications). In terms of registrations, only 22% of all device shape marks and 57% of all composite shape marks are currently registered. Interestingly there has been a gradual decline in applications for device marks and a steady rise in composite marks indicating a possible intersection in the future (see Figure 3). A gradual decline was also observed in applications for device colour trade marks (see Figure 4).

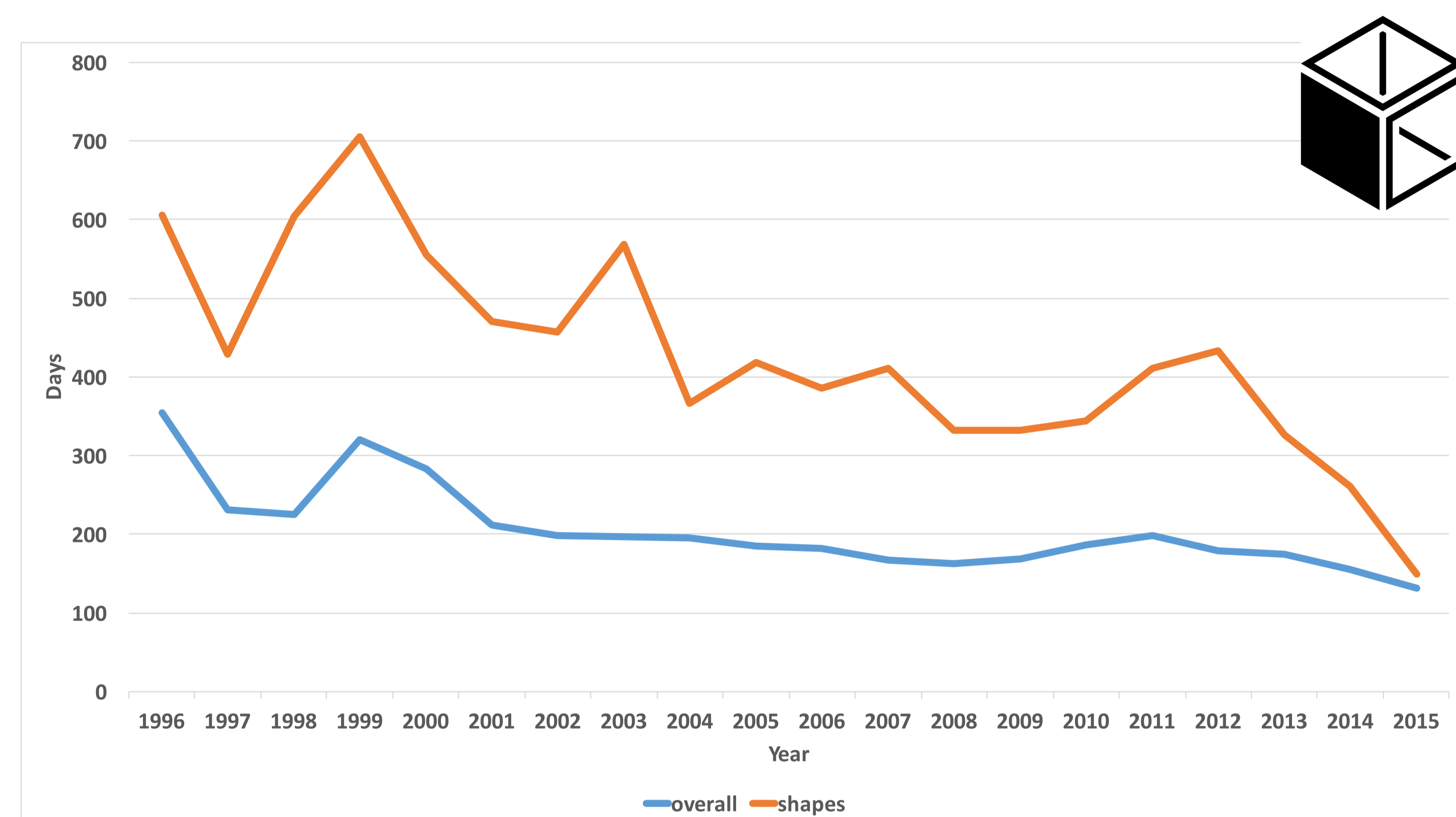


Figure 2: Average number of days registered shape trade marks are out to examination compared to all trade marks from 1996 to 2015.

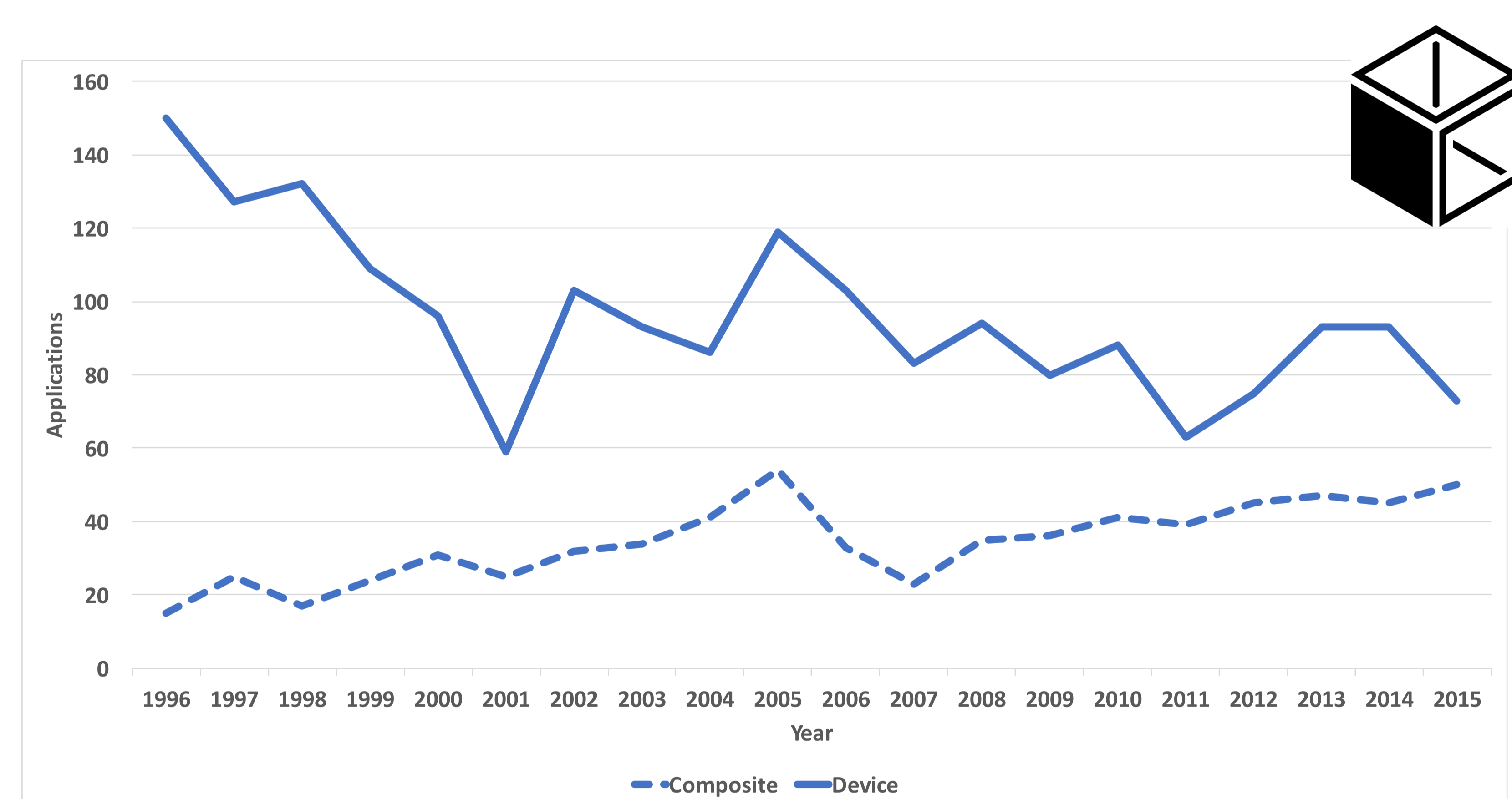


Figure 3: Applications for shape trade marks from 1996 to 2015 categorised as device and composites.

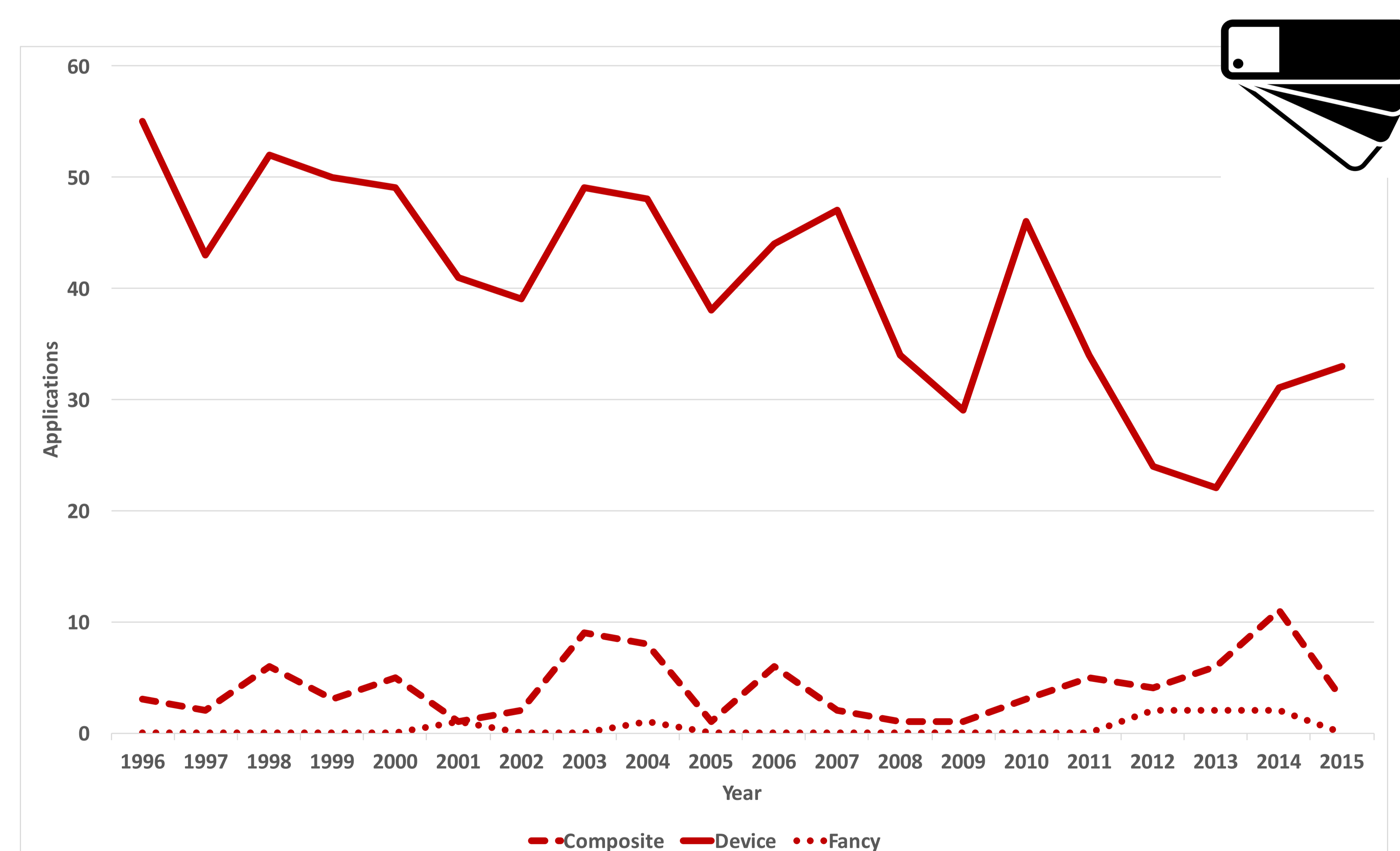


Figure 4: Applications for colour trade marks from 1996 to 2015 categorised as device and composites.

Conclusion

While the data shows that shape and colour trade marks remain popular subjects of trade mark applications, sounds and scents have yet to live up to the hype or pose the kinds of controversies that these categories of marks were anticipated to present.

1. *Trade Marks Act 1995* (Cth) s 17.
2. Amanda Scardamaglia, "The Colonial Trade Mark Regime: Opening up the Australian Archives on Colonial Trade Mark Registrations" (2013) 23 AIPJ 222, 242-246.
3. *Qualitex Co v Jacobson Products Co* 514 US 159 (1995), 162.