

## Article Information

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## Trade Mark Protection and the Australian Border Force

**Part 13 of the Trade Marks Act 1995 (Cth) (TMA) authorises the Australian Border Force (ABF) to seize goods being imported into Australia if the goods infringe, or appear to infringe, a registered trade mark. However, the TMA places the onus on registered trade mark owners and authorised users to take active, positive steps to access this powerful protection.**

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### Overview of Part 13 of the *Trade Marks Act 1995 (Cth)*

The primary purpose of Part 13 of the TMA is to protect registered trade marks from the importation of goods that infringe upon the trade mark into Australia.<sup>[1]</sup> It does this by giving registered trade mark owners the right to request the ABF to seize goods at the border if the goods have a sign that is ‘*substantially identical with, or deceptively similar to, a notified trade mark*’.<sup>[2]</sup>

Importantly, this protection only extends to ‘*notified trade marks*’.<sup>[3]</sup> In other words, the registration of a trade mark alone is insufficient to attract protection by the ABF. A registered trade mark only becomes a ‘*notified trade mark*’ when written notice is given to the ABF objecting to the importation of infringing goods.<sup>[4]</sup> This notice can be given at any time by the registered trade mark owner,<sup>[5]</sup> or under limited circumstances, an authorised user (**objectors**).<sup>[6]</sup> Unless revoked, notices remain in force for a period of 4 years.<sup>[7]</sup>

### Process

Notice is provided by way of lodging a no-cost Notice of Objection with the ABF. This authorises the ABF to temporarily seize suspected infringing goods. The owner is also required to lodge a “Deed of Undertaking”, which is a formal agreement to repay the ABF’s costs resulting from the seizures, such as transportation, storage and destruction costs.

### Seizure of Goods

Upon seizure, the ABF will provide notice to both the objector and the owner of the goods.<sup>[8]</sup> This notice will set out a period within which the goods can be claimed by the owner.<sup>[9]</sup> If the goods are not claimed within this period, they will be forfeited to the Commonwealth.<sup>[10]</sup>

The seizure notice will also set out a period within which an objector may commence an action for infringement.<sup>[11]</sup> If an action for infringement is not commenced within this period, the goods will be returned to the owner.<sup>[12]</sup>

Once an action for infringement has commenced, the goods can only be released in limited circumstances, such as when the objector consents.<sup>[13]</sup>

### Benefits of Part 13 of the TMA to Objectors

The obvious benefit of protection under Part 13 of the TMA is that the ABF will monitor imports and seize potentially infringing goods on behalf of objectors. Unless an action for infringement is commenced, an objector is only required to pay for the expenses incurred by the Commonwealth to seize the goods.<sup>[14]</sup> Therefore, this regime represents an efficient, cost effective means through which trade mark rights can be protected.

The TMA also provides the ABF with a number of discretionary powers that may be invoked to facilitate the fact-finding process, and to assist an objector to determine whether to bring an action for infringement. This includes the power to:

1. allow the objector and owner to remove one or more samples of the seized goods for inspection;[\[15\]](#) and
2. provide information that has the purpose of identifying and locating either the importer of the goods or any other person that made arrangements for the goods to be brought to Australia.[\[16\]](#)

### **Recommendations/Takeaways**

Part 13 of the TMA can provide powerful protections for registered trade marks against the importation of potentially infringing goods. However, this regime leaves the onus on registered trade mark owners and authorised users to secure this protection by requiring that they:

1. give notice to the ABF objecting to the importation of infringing goods; and,
2. bring an action for infringement within the action period.

It should also be noted that the *Copyright Act 1968* (Cth) (CA) provides for a similar seizure regime to that of the TMA. Section 135 of the CA imposes a restriction on the importation of copies of infringing copyright material,[\[17\]](#) permitting the owner of copyright material to file a similar Notice of Objection with the ABF for the seizure of infringing goods.[\[18\]](#)

This provides further options for intellectual property owners to protect their rights against the importation of infringing goods.

Piper Alderman has a nationally recognised practice in intellectual property enforcement and protection, with experience in all jurisdictions. Please contact Tim O’Callaghan and his team if you require intellectual property advice.

[\[1\]](#) *Trade Marks Act 1995* (Cth) s 131 (“TMA”).

[\[2\]](#) *Ibid* s 133(2)(a).

[\[3\]](#) *Ibid* ss 6, 133(2).

[\[4\]](#) *Ibid* s 132(1).

[\[5\]](#) *Ibid*.

[\[6\]](#) *Ibid* ss 132(2)-(3).

[\[7\]](#) *Ibid* s 132(4).

[\[8\]](#) *Ibid* s 134.

[\[9\]](#) *Ibid* s 134(3)(a).

[\[10\]](#) *Ibid* s 136A(1).

[\[11\]](#) *Ibid* s 134(3)(b).

[\[12\]](#) *Ibid* s 136D(3).

[\[13\]](#) *Ibid* s 136D(1).

[\[14\]](#) *Ibid* ss 133(3)-(3A), 141A.

[\[15\]](#) *Ibid* ss 134A(1)-(2).

[\[16\]](#) *Ibid* 134(4).

[\[17\]](#) *Copyright Act 1968* (Cth) s 135.

[\[18\]](#) *Ibid* s 135AC.