

Australian Intellectual Property Journal

Volume 32, Number 3

2022

EDITORIAL – *General Editor: David Brennan* 133

ARTICLES

Should the Australian Distinctiveness Test Focus More on Consumer Perception? Lessons from Geographical Trade Marks – *William van Caenegem and Kana Nakano*

In this article we explore the nature of the test of distinctiveness in Australian trade marks law by reference to its application in geographical trade mark cases. A “geographical trademark” is a registered standard mark that contains a geographical term with or without other elements, irrespective of whether that term is a registered geographical indication. We compare the Australian approach with the United States and European Union law and practice. We find that Australia has historically been at odds with those jurisdictions. We conclude that despite *Cantarella*, inconsistencies and uncertainty remain in the application of the distinctiveness test. We suggest that a more consumer-perception focused approach could improve consistency and clarity of the test, as well as aligning Australian law with the United States and the European Union. 134

Generic Trade Marks: Could Booking.com and the Goods/Services Dichotomy Create a New Generic Headache? – *Paul Nolan*

Generic trade marks have traditionally been those that have become generic over time. Put simply, they lost their necessary distinctiveness due to societal overuse. Most are familiar with the well-known cases involving common marks that have fallen into the everyday lexicon. There is a further category of trade mark that is registered (and remains registered) despite appearing to be generic *ab initio*. This was highlighted in the recent decision of *United States Patent and Trade Mark Office v Booking.com BV*. This latter category is more likely to impact on services as opposed to goods due to the proliferation of online services in an exponentially growing digital era. The dichotomy between goods and service will become blurred as the digital era continues to dominate. This article argues that today’s dynamic internet-reliant commercial environment means that genericness has far less time to develop than it formerly did. Further, evidence will be required to show that a generic .com mark has acquired enough distinctiveness to ward off a genericism challenge. Finally, whether service marks survive genericide threats in a digital era remains to be seen and will be decided, as always, on a case-by-case basis. 171

Civil Society’s Meaningful Engagement in the Patent System for a More Profound Real-World Impact – *Muhammad Zaheer Abbas*

The current COVID-19 pandemic has put the problem of equitable access to health technologies in the limelight. Patent exclusivities add to the cost of health care by allowing supra-competitive prices of protected technologies. Civil society organisations can make an enormous difference by successfully opposing questionable patents. Patent opposition is an administrative safeguard which procedurally enables community organisations to play

this crucial role as defenders of the public interest. This article supports the adoption of the patent opposition procedural safeguard as it provides civil society organisations with an affordable and practically feasible mechanism to challenge validity of questionable patents. This article draws upon real-world examples of prominent civil society organisations in order to highlight the potential role of community engagement in the patent system. This paper proposes the establishment of specialized civil society organisations which have requisite techno-legal capacity to harness full potential of meaningful community engagement in the patent system.