

Julie Dennett, Committee Secretary  
Senate Legal and Constitutional Committees  
PO Box 6100 Parliament House  
Canberra ACT 2600  
Australia

September 2, 2011

Dear Secretary Dennett:

As a global organization of 5,700 trademark owners and professionals from over 190 countries, including 103 members from Australia, the International Trademark Association (INTA) greatly appreciates the opportunity to submit comments to the Senate Legal and Constitutional Affairs Committee on the Trade Marks Amendment Bill 2011, which accompanies the Tobacco Plain Packaging Bill 2011.

INTA commends the efforts of the Australian Government to address public health concerns. Although we take no position on the particular health issues that are the focus of these pieces of legislation, we strongly believe that the Trade Marks Amendment Bill 2011 poses a threat to the rights of trademark owners and frustrates the ability of trademark owners to operate with certainty regarding the state of trademark law in Australia.

The Trade Marks Amendment Bill 2011 would introduce new sections to the existing Trade Marks Act, including Section 231A(3):

- (3) Regulations made for the purposes of subsection (1):
  - (a) may be inconsistent with this Act; and
  - (b) prevail over this Act (including any other regulations or other instruments made under this Act), to the extent of any inconsistency.

The effect of this section is to allow Regulations made under the Plain Packaging Bill to amend the Trade Marks Act, even where they are inconsistent and to allow the Regulations to prevail.

As the Explanatory Memorandum to the Bill indicates, similar regulations are already in existence in relation to the implementation of the Madrid Protocol into the Australian Trade Marks Act. The Australian High Court has considered the constitutionality of such clauses (*Capital Duplicators P/L v Australian Capital Territory* (No.1) 177 CLR 248) and held that they are not unconstitutional as long as Parliament retains the right to repeal or amend the primary statute.

These previous clauses have applied across trademark owners without exception; however, the present legislation targets one industry in particular. Singling out one industry presents the danger that the government of the day can unduly burden these trademark owners with new and unexpected regulations and would be a deviation from good legislative practice. In previous submissions, INTA has noted that Regulations can be amended more easily than an Act and without the same parliamentary scrutiny required to amend an Act of Parliament. This Bill will provide the Minister of the day with an ability to alter regulations potentially without concern to the primary piece of legislation.

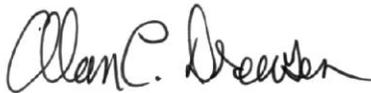
The primary issue this raises is the absolute lack of certainty for any manufacturer in this field as to the future of labeling requirements under the Regulations, thereby increasing business costs. This uncertainty can also affect the desirability of Australia as an investment location for IP owners.

Additionally, the precedent set by this Bill could pave the way for future legislation that will target other industries and causes unpopular with the government of the day, such as fast food or the “green” industry, and subject them to the uncertainties and burdens of potential ministerial fiat.

Because this legislation will place unprecedented burden on a single class of trademark owners without the fully considered scrutiny and review of Parliament, INTA therefore believes that this section should not be enacted into law.

This submission was prepared by INTA with the assistance of the Legislation and Regulation Committee as well as members of INTA’s policy staff. If you have any questions or concerns with this submission, please contact Mr. Seth Hays, External Relations Manager for Asia-Pacific, at [shays@inta.org](mailto:shays@inta.org).

Sincerely,

A handwritten signature in black ink that reads "Alan C. Drewsen". The signature is written in a cursive, flowing style.

Alan C. Drewsen  
Executive Director