

Trade marks and online enforcement update

CPD unit: Substantive Law

PREPARED BY

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DATE

12/03/2026

AGENDA

- Hot off the press
- The pub test – honest!
- Strategies for mitigating risk
- Recent Trade Marks Office decisions on distinctiveness and conflict of marks
- Recent developments in domain name and online enforcement.



Hot off the press



When is "honesty" relevant?

Acceptance of trade mark

- Honest concurrent use

Infringement defences

- "Good faith" defences
- "Would have obtained registration" defence

Exercise of discretion

- Rectification
- Non-use

The pub test pop quiz - honest!

Is it honest to register a trade mark that is similar to a mark you know is likely to be used by another trader for the same goods?

- What if your mark is your own name?
- What if you used the mark first?
- What if the similar name is used by an internationally famous pop star and you heard "I kissed a girl" on the radio before you filed your initial trade mark application?



Taylor v Killer Queen LLC [2026] HCA 5

The pub test pop quiz - honest!

If you file a trade mark application and receive an examination report citing a prior similar mark before you commence use, is it honest to proceed with use?

- What if you conducted pre-filing Internet searches that did not identify the cited mark?
- What if you didn't read the examination report?



*Firstmac Limited v Zip Co Limited [2025]
FCAFC 30*

The pub test pop quiz - honest!

Would it be honest to adopt a trade mark that you believed was different to the other party's trade mark?

- What if your mark included two words in the same order as the other party's trade mark?
- What if there was clear evidence that you knew about the other party's branding before you adopted your mark?
- What if the other party was the incumbent market leader for +40 years?
- What if your mark included your company's house mark?



Bed Bath 'N' Table Pty Ltd v Global Retail Brands Australia Pty Ltd [2025] HCA 50

The pub test pop quiz - honest!

Would it be honest to adopt a trade mark if you had a search conducted and were advised the mark was not available for use as a standalone mark?

- What if the lawyer's advice was that use of the mark with other elements was a lower risk option?
- What if you went ahead and used the standalone mark anyway?
- What if you still believed use of the mark would not infringe?

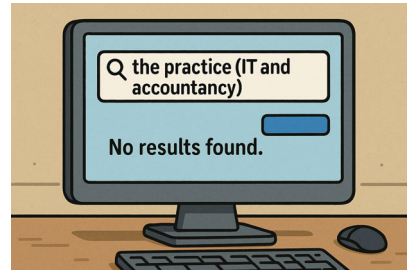


Progressive Green Pty Ltd v Flo Energy Pty Ltd [2025] FCA 1315

The pub test pop quiz - honest!

Is it dishonest to proceed with use of a trade mark:

- If you only search Internet and company/business name registers, not the Trade Marks Register?
- If there was a relevant mark on the Trade Marks Register?
- If your searches are unusually specific?
 - Eg. entire phrases "THE PRACTICE (IT AND ACCOUNTANCY)" and "The Practice Business Advisers and Tax Practitioners", not THE PRACTICE
- What if you don't have a sophisticated legal team?



The Practice Pty Ltd v The Practice Business Advisers & Tax Practitioners Pty Ltd [2024] FCA 1299

The pub test pop quiz - honest!

Is it honest to adopt a trade mark if you have opposed registration of that same trade mark in the past?

- What if you previously co-existed under a similar name?
- What if your company adopted that mark in the USA and it was natural progression to use in Australia?
- What if the trade mark was your corporate name?
- Would already having a trade mark registration for that mark help?
- What if you had used the mark for 15 years?



Fanatics, LLC v FanFirm Pty Limited [2025] FCAFC 87

The pub test pop quiz - honest!

Is it honest to launch a business with a trade mark if you genuinely believed there would be no confusion with another business using the same trade mark in the same space?

- What if you received a cease and desist letter before you launched?
- What if you did not engage the trade mark lawyers you have used for decades to conduct trade mark searches?
- What if a simple search would have found the prior mark?

Hemmes Trading Pty Ltd v Establishment 203 Pty Ltd [2024] FCA 1100



Strategies for mitigating risk



Strategies for mitigating risk



Trade marks and online enforcement update

Average re-branding costs for a small business

Logo	\$1,000 – 5,000
Website	\$6,000 – 20,000+
Stationery Brochures/collateral	\$5,000+ \$5,000+
Packaging	\$15,000+
Advertising campaign	\$5,000 – 10,000+
Costs associated with responding to cease and desist letter and resolving by agreement	\$5,000 – 10,000
TOTAL	\$42,000 – 70,000+
TRADE MARK CLEARANCE SEARCH AND REGISTRATION (1 MARK 1 CLASS)	\$3,500 (approx.)

Trade Marks Office decisions update – August 2025- January 2026





Trade marks and online enforcement update

Substantially identical marks

Earlier mark	Applied for mark	Reference
BLUE ZONES	BlueZones	Blue Zones, LLC v System Biologie Deutschland UG [2025] ATMO 35 (20 February 2025)
		Browns Sawdust & Shavings Supplies Pty Ltd v Timothy Dean Brown [2025] ATMO 20 (31 January 2025)
	WONDER FOODS	WHAV Pty Ltd v Propel Health Pty [2025] ATMO 222 (31 October 2025)
AUDD	AudD	AUDC Pty Ltd v AudD LLC [2025] ATMO 199 (22 September 2025)
PEM	PEM	PEM STUDIOS MELBOURNE PTY LTD v Kalliso Holding Pty Ltd [2025] ATMO 189 (11 September 2025)
		Sichuan Chuanwazi Food Co Ltd v Chuan Zhao [2025] ATMO 172 (29 August 2025)

Trade marks and online enforcement update

NOT substantially identical marks

Earlier mark	Applied for mark	Reference
EUROTAINER	ROTAINER	Eurotainer v Container Rotation Systems Pty Ltd [2025] ATMO 261 (16 December 2025)
Naked Wines  	Nearly Naked Sidewood Nearly Naked	Naked Wines International Limited v Ashwood Estate Pty Ltd [2025] ATMO 241 (18 November 2025)
TUCKERBOX	DOG ON THE TUCKERBOX 	Borambola Wines Pty Ltd v The DOTT Developments Pty Ltd [2025] ATMO 218 (24 October 2025)
alya skin	AYA SKINCARE	Frostbland Pty Ltd v Koori Skin Care Pty Ltd [2025] ATMO 217 (21 October 2025)
WIRRA WIRRA		R. G. & R.T. Trott Pty Ltd v Lentil Global Pty Ltd [2025] ATMO 167 (25 August 2025)
CREMFIL	CREMFUL	PURATOS v International Foodstuffs Co LLC [2025] ATMO 161 (12 August 2025)

Deceptively similar marks

Earlier mark	Applied for mark	Reference
GENTLE DENTAL CARE GDC CENTRAL DENTAL CARE	NEWPORT GENTLE DENTAL CARE	Gentle Dental Care Group Pty Ltd v Dr Wael Wasef trading as Newport Gentle Dental Care [2025] ATMO 248 (1 December 2025)
ARENA	ARENA BREAKOUT  ARENA BREAKOUT INFINITE	Foxtel Management Pty v Tencent Holdings Limited [2025] ATMO 242 (20 November 2025)
ATHLETA	ATHLECIA	Athleta (ITM) Inc v Sports Group Denmark A/S [2025] ATMO 196 (17 September 2025)
STAPLE	STAPLE SWIM	Victor Liang v FAYT The Label Pty Ltd [2025] ATMO 190 (12 September 2025)
shaka tea	SHAKAO	Shaka Beverages, LLC v Stanley Meissner [2025] ATMO 184 (9 September 2025)
  		HIJOS DE RIVERA, S.A v Sociedad Anónima Damm [2025] ATMO 185 (9 September 2025)
  	 HUNCHY HILLS	Hunchy Hills Distillery Pty Ltd [2025] ATMO 180 (5 September 2025)

Trade marks and online enforcement update

Deceptively similar marks




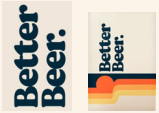
Earlier mark	Applied for mark	Reference
FLASHPACKERS		Richgrove Pty Ltd v Flash Pack Travel Ltd [2025] ATMO 178 (4 September 2025)
ROOH AFZA		Hamdard National Foundation (India) v Hamdard Laboratories (WAQF) Pakistan [2025] ATMO 169 (28 August 2025)
		FDB Mobler A/S [2025] ATMO 163 (13 August 2025)
GROWTHPOINT 	GrowthPoint	Growthpoint Properties Australia Limited and Growthpoint Properties Limited v GrowthPoint Technology Partners LLC [2025] ATMO 159 (11 August 2025)
		White International Pty Ltd v WHITES POWERSPORTS AUSTRALIA PTY LTD [2025] ATMO 157 (11 August 2025)
CREMFIL	CREMFUL	PURATOS v International Foodstuffs Co LLC [2025] ATMO 161 (12 August 2025)

NOT deceptively similar marks

Earlier mark	Applied for mark	Reference
EUROTAINER	ROTAINER	Eurotainer v Container Rotation Systems Pty Ltd [2025] ATMO 261 (16 December 2025)
Naked Wines 	NAKED LIFE	Naked Wines International Limited v Inspi Holdings Pty Ltd [2025] ATMO 244 (25 November 2025)
Naked Wines 	Nearly Naked Sidewood Nearly Naked	Naked Wines International Limited v Ashwood Estate Pty Ltd [2025] ATMO 241 (18 November 2025)
TUCKERBOX	DOG ON THE TUCKERBOX 	Borambola Wines Pty Ltd v The DOTT Developments Pty Ltd [2025] ATMO 218 (24 October 2025)
alya skin	AYA-SKINCARE	Frostbland Pty Ltd v Koori Skin Care Pty Ltd [2025] ATMO 217 (21 October 2025)
 Long list of Nike swoosh marks		Nike Innovate C.V. v Eastlake Football Club Limited [2025] ATMO 214 (17 October 2025)
AQUAROCKBAG		Bluemont Pty Ltd v Project Material Pty Ltd [2025] ATMO 207 (3 October 2025)

Trade marks and online enforcement update

NOT deceptively similar marks

Earlier mark	Applied for mark	Reference
 KAVE	 KAVENO	Puma SE v Sunday Red LLC [2025] ATMO 197 (19 September 2025) JULIA GRUP FURNITURE SOLUTIONS, S.L. v Jiaming Huang [2025] ATMO 183 (9 September 2025)
BUTTER	BUTTERCORE	Workinonit Pty Ltd v ALL FENIX GROUP PTY LTD [2025] ATMO 182 (8 September 2025)
MONSTER ENERGY MONSTER	 MONSTER GARAGE	Monster Energy Company v TM Storage Place Pty Ltd [2025] ATMO 173 (1 September 2025)
FLUOR FLUOR	FLUOROFIX	Fluor Corporation v Science Developments Pty Ltd [2025] ATMO 170 (29 August 2025)
BETTER BEER BETTER BEER ARVO ALE 	TRADIE BEER BUILT BETTER	Better Beer Holdings Pty Ltd v TRADIE Holdings Pty Ltd [2025] ATMO 147


Trade marks and online enforcement update

Likely to cause confusion

Earlier mark	Applied for mark	Reference
aspenmedical ASPEN MEDICAL ASPEN MEDICAL – WHEREEVER WE'RE NEEDED	ASPEN MEDICAL PRODUCTS	Aspen Medical Pty Ltd v Aspen Medical Products, LLC [2025] ATMO 249 (1 December 2025)
ARENA	ARENA BREAKOUT ARENA BREAKOUT INFINITE 	Foxtel Management Pty v Tencent Holdings Limited [2025] ATMO 242 (20 November 2025)
REEL	REELSTAR	Meta Platforms, Inc v Reel Star Pty Ltd [2025] ATMO 224 (31 October 2025)
LEGACY	LEAVE A LEGACY NOT A LOST LIFE	Legacy Australia Incorporated v David Anthony Hamilton [2025] ATMO 200 (23 September 2025)
		Ayam S.A.R.L. v Alpha Oriental Traders Pty Ltd [2025] ATMO 166 (19 August 2025)




Trade marks and online enforcement update

Likely to cause confusion

Earlier mark	Applied for mark	Reference
 <p>Oyster Bay</p> <p>SOMETIMES THE WORLD REALLY IS YOUR OYSTER OYSTER BAY OYSTER OYSTER BAY NEW ZEALAND SOMETIMES THE WORLD REALLY IS YOUR OYSTER</p>	<p>Oyster Shed</p>	<p>Delegat Limited v Comiskey Management Services Pty Ltd as Trustee for NewPub Family Holdings Trust [2025] ATMO 158 (11 August 2025)</p>


Trade marks and online enforcement update

NOT likely to cause confusion






Earlier mark	Applied for mark	Reference
<p>EUROTAINER</p>	<p>ROTAINER</p>	<p>Eurotainer v Container Rotation Systems Pty Ltd [2025] ATMO 261 (16 December 2025)</p>
<p>Naked Wines</p> 	<p>NAKED LIFE</p>	<p>Naked Wines International Limited v Inspi Holdings Pty Ltd [2025] ATMO 244 (25 November 2025)</p>
<p>Naked Wines</p> 	<p>Nearly Naked Sidewood Nearly Naked</p>	<p>Naked Wines International Limited v Inspi Holdings Pty Ltd [2025] ATMO 244 (25 November 2025)</p>
	<p>PUMA</p>	<p>PUMAS-AI Inc v PUMA SE [2025] ATMO 226 (3 November 2025)</p>

Trade marks and online enforcement update





NOT likely to cause confusion

Earlier mark	Applied for mark	Reference
TANUMBIRINI	TANUMBIRINI, TANUMBIRINI STATION	Rallen Australia Pty Limited v Tamboran Resources Limited [2025] ATMO 212 (15 October 2025)
UBANK		National Australia Bank Limited v YouPay Pty Ltd [2025] ATMO 192 (15 September 2025)
	CAESARSTONE	Caesarstone Ltd v CAESARSTONE [2025] ATMO 171 (29 August 2025)
FLUOR 	FLUOROFIX	Fluor Corporation v Science Developments Pty Ltd [2025] ATMO 170 (29 August 2025)
WIRRA WIRRA		R.G. & R.T. Trott Pty Ltd v Lentil Global Pty Ltd [2025] ATMO 167 (25 August 2025)
Olefun	OleFun	gui lin shen hu shang mao you xian gong si v Shiyu Zhang [2025] ATMO 156 (6 August 2025)
ACC	ACC	Sandoz AG v Actor Pharmaceuticals Pty Ltd [2025] ATMO 152 (1 August 2025)

Inherently distinctive

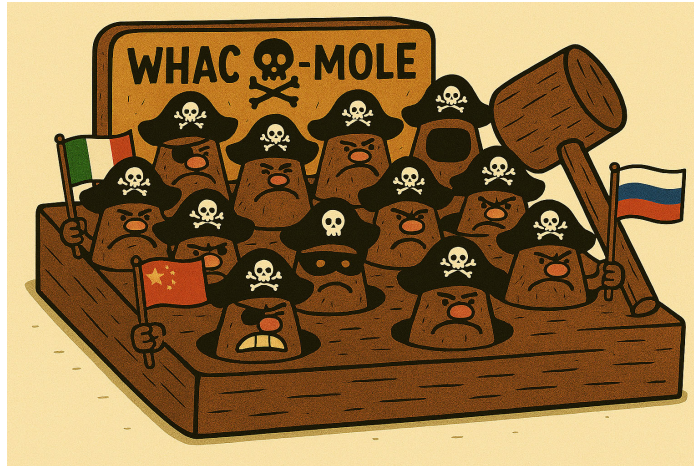
Mark	Goods/services	Reference
	44: Dental surgery services..	MDCA Investments Pty Ltd v Mobile Dental Care Australia Pty Ltd [2025] ATMO 251 (4 December 2025)
UPCODES	Class 42: Providing non-downloadable software for assisting users with research on building codes, code compliance, and information relating to the design, construction, or occupancy of buildings	UpCodes Inc [2025] ATMO 225 (31 October 2025)
	Class 39: Delivery of emergency supplies of medicines to medical practices including PBS medicines. Class 44: Pharmacy dispensary services.	The Veterinary Pharmacy Pty Ltd v Elnakeeb and Mostafa Pty Ltd [2025] ATMO 220 (30 October 2025)
	Class 9: various software Class 41: various entertainment/wagering	Sportsbet Pty Ltd [2025] ATMO 195 (16 September 2025)
PERDEKAMP EMOTIONAL METHOD	41: Entertainment and education services	PEM STUDIOS MELBOURNE PTY LTD v Kalliso Holding Pty Ltd [2025] ATMO 176 (3 September 2025)
 	29: Beef; beef products 31: Live animals 42: Genetic research 16: Boxes for packaging	Jeff Knox v The Australian Simmental Breeders Association Ltd [2025] ATMO 175 (2 September 2025)

NOT inherently distinctive

Mark	Goods/services	Reference
1-CLICK CLUSTERS	Class 42: various non-downloadable software, IaaS, SaaS etc.	lambda, Inc. [2025] ATMO 247 (28 November 2025)
	Class 9: crypto wallets/crypto exchange software etc. Class 36: financial services including for cryptocurrencies	Onecorp Industries Pty Ltd [2025] ATMO 237 (14 November 2025)
DocBags	Class 39: Delivery of emergency supplies of medicines to medical practices including PBS medicines. Class 44: Pharmacy dispensary services.	The Veterinary Pharmacy Pty Ltd v Elnakeeb and Mostafa Pty Ltd [2025] ATMO 220 (30 October 2025)
AnchorCCS	Class 44: Therapy, psychology, hypnotherapy, meditation, mental health services	Bernice Botha v Christian Postlethwaite [2025] ATMO 216 (21 October 2025)
	Various Class 35, 36, 39, 41 services; nature of the services less critical noting objection raised was that the marks "indicate [sic] that the claimed services are for SENIORS, that are provided NATIONALLY in AUSTRALIA".	National Seniors Australia Ltd [2025] ATMO 202 (26 September 2025)
	Class 3: Automatic dishwashing tablets	Henkel AG & Co. KGaA v Reckitt Benckiser Finish B.V. [2025] ATMO 198 (19 September 2025)
	3: Perfumery for pets 5: Dietary pet supplements	PET DRS PTY LTD [2025] ATMO 174 (1 September 2025)

Domain and online enforcement updates

The problem



The (possible) solution(s)

- Who (and where) are they, anyway?
 - RDRS
 - Social media
 - Trap purchases
 - File UDRP/auDRP proceedings

- What else can I do (whether I know who and where they are or not)?
 - Cease and desist, auDRP/UDRP, Customs watch notices
 - Google delisting and de-indexing complaints
 - Platform-specific takedown and enforcement mechanisms (manual and automated)
 - Hosting provider and infrastructure complaints
 - Registry, registrar and ICANN compliance complaints
 - Payment processor and advertising network complaints
 - Criminal reports
 - Back orders

Presenters



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