



MARK MY WORDS

Trade Mark Services

Guide to:

AUSTRALIAN TRADE MARK REGISTRATION

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WHAT IS A TRADE MARK?

The Trade Mark laws operating in Australia define a Trade Mark as:

“A sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.”

A sign, for the purposes of trade mark registration can be pretty much anything — a word or words, a logo (comprising words and imagery or style), an image on its own, a colour, a shape, an aspect of packaging and even smells and sounds can be registered as trade marks.

The key is to ensure that your ‘sign’ is capable of distinguishing your goods/services. This means it needs to act as a ‘badge of origin’ for those goods or services, something that lets consumers and others know that the product/service belongs to you. It is therefore more difficult to register a trade mark if it is, or has as its main element/s, something that other traders would honestly need to use to describe their goods/services of the same or similar nature to yours.

Examples of difficult to register trade marks, those that are questioned on their capability to distinguish the goods/services would be:

The Best Computer Shop (for retail services)

Other computer shop operators are likely to need to use this phrase for their own shop honestly.

Melbourne Chinese Restaurant (for restaurant services)

Other Chinese restaurant operators are likely to need to inform people they are in Melbourne and use this similar phrase.

SnugFit (for clothing goods)

Other clothing producers are likely to need to describe their clothes as “snug fitting” and use this similar phrase.

Trade marks may also be questioned on their capabilities to distinguish when they are for common surnames or simply the names of places – this is because other people with that surname have a right to use it, as do people from a certain place. In a lot of cases, combining a ‘commonly used’ word or phrase with a not-so commonly used word or phrase (or an image/logo) will avoid this issue because on the whole it’s not likely other traders would need to use that trade mark.



THINGS TO CONSIDER BEFORE APPLYING?

Most importantly, your trade mark needs to meet the definition seen on the previous page to be registrable; if it doesn't it could prove difficult to secure rights.

It's also important to ensure your chosen trade mark does not conflict with an earlier filed trade mark that is claiming similar goods or services to yours. If someone else has registered the same or deceptively similar trade mark already, for similar goods/ services (or has an application pending before you) it could be difficult for you to secure registration due to that conflict and the likelihood of confusion occurring between your 'brand' and the one with earlier rights. For this reason, we strongly encourage a trade mark search to be conducted as soon as you select a name and before you officially commence using it. The search is discussed further in this guide.

There are also certain words and symbols that are prohibited by Trade Mark Law in Australia, or, are covered by other legislation. For example, you could not register a trade mark that incorporates the Olympic Rings. You cannot register trade marks that are scandalous, contrary to law or likely to mislead and deceive.

Scandalous trade marks are, generally speaking, ones that are offensive to other people (not necessarily simply in poor taste or rude but truly offensive) such as Trade marks that include offensive and/ or abusive elements that are personal, religious or racial in nature.

For a trade mark to be considered 'misleading and deceptive' there must be an element that automatically does this- up front. For example, if you were to attempt registering a trade mark that included a domain name that you didn't own, this would be deceptive; or, if you tried using a celebrity's name in your trade mark but didn't have permission to do so, this would also be deceptive, as you would be suggesting an affiliation or endorsement that doesn't exist.

Who can own a Trade Mark?

The making of an application in itself is confirmation to the Trade Mark office that you use, or intend to use the trade mark in good faith for the goods/services that are relevant. The 'rightful' owner is usually the one that adopted the trade mark, and uses or intends to use the mark. A trade mark can be challenged by other parties if they believe that you are not the 'rightful owner' of the trade mark, or that the application has been made in bad faith.

The owner must be someone with a legal status – such as an individual or group of individuals, or an incorporated body (such as a Pty Ltd or Limited company). A business name cannot own a trade mark. Generally the right to own property, including trade marks, falls to whoever is the business registrant.



Is it possible for someone else to use or register the same 'Trade Mark'?

In short, yes.

By registering your trade mark you are granted the right to use that trade mark for the goods/services nominated. It may be possible for someone else to register the same trade mark, quite easily, for goods/services that are not deemed related – where it's unlikely consumers would be confused between them. It is also possible for someone else to register the same, or similar, trade mark for the same goods/services after you do. This can be done if they show that they used and promoted that trade mark since before you sought trade mark registration and that use has been continuous (if they can do this, the examiner must remove your trade mark as a problem). It may also be done if they show their use to be honest and continuous with your trade mark registration. (This later option can be more difficult, as the evidence generally needs to be substantial).

It's also important to note that if someone has used the same, or very similar, trade mark since before you first used or registered (whichever is the earlier date) but not sought registration as a trade mark, they may have rights under common law that would allow them a defence against trade mark infringement, which in turn could see them allowed to continue use even if you have registered the trade mark.

Business Names, Company Names, Domain Names etc.

Having registered any of these names does not provide you with ownership and rights in the name – only trade mark registration will do this.

A **business name** is also known as a trading name. It allows the registrant of that name to trade by the name. It's essentially an 'alias' for whoever is carrying on the business, however, when registering a business you will see there is a disclaimer to ensure that your chosen business name does not infringe a trade mark.

A **company name** is a legal entity (where as a business name is not). If a company intends to trade by a name, other than the company name registered, it must also register a business name. This is a Federal registration however, still does not provide ownership or higher protection than a trade mark.

A **domain name** is essentially your website address; the name that others will type into their internet browser in order to find your website. Domain names are basically provided to you under license for a certain period of time to use as the identifier for your website and must be renewed or you will risk loss of website and email accounts. Again, it does not provide ownership to the key name you have chosen.



REGISTERING YOUR TRADE MARK



STEP 1 - TRADE MARK SEARCH

We consider that a trade mark search should head your 'to do' list when considering a new name for a business, company, product or service.

If your preferred name is too similar to an existing trade mark you could not only have difficulties in securing rights, but you may be infringing another person's rights and face action because of it.

Ensuring your chosen trade mark is available and is not infringing anyone else's rights provides you with peace of mind to know that your 'brand' won't be stepping on any toes, and that it can become your property and business asset. Even if you have been using your 'brand' and promoting it for some time, difficulties can arise so a trade mark search should always be considered.

The official examination with the government office once you file an application can take a long time (usually around 4 months) so you may wish to know where you stand sooner and our various searches can provide you with this information.

We offer different types of searches to suit different budgets:

Identical search – Considers whether there is any absolutely identical trade mark already registered in Australia to your chosen name, for the same/closely related goods or services;

Register Search – Considers the Australian trade mark database for any absolutely identical trade marks, or deceptively similar trade marks already pending or registered in Australia that may be raised as 'too similar' to yours;

Full Availability & Infringement Search – Considers whether there are likely to be trade marks that conflict with yours; whether there are any other areas of the Trade Marks Act 1995 that may see your trade mark as not registrable; whether there are existing businesses and companies in Australia who have used the same name for a while and may have 'prior' common law rights and general Internet searches.



STEP 2 - FILING THE APPLICATION & CLASSES

As trade marks are ‘signs’ used to distinguish the goods/services of different traders, it follows that when you file an application you must advise what those goods/services are.

All goods and services fall into ‘classes’ that have been listed and put in place under an international agreement. The list of classes and the goods/services that fall into them have been adopted by a majority of countries around the world. There are 45 of these ‘classes’ to select from. Numbers 1-34 cover goods and numbers 35-45 cover services. A part of our search process (regardless of the type of search you select) is to provide recommendation on which classes you require. When we prepare and file your application, in order to meet the basic filing requirements, we must advise the trade mark office of the class number and provide a specification of the goods/services being claimed with the class/es. By employing our office to file the application on your behalf, we will attend to this for you.

Further, by engaging us to file the application we will be listed as your agent on the official record as the “address for service”. This means all government correspondence will come to our office for attention – it also means that in the event another party wishes to query, contact or challenge your trade mark they should contact us rather than you directly. By receiving all communication for you we can review, report and advise accordingly.



Series Trade Marks

It is possible to request registration of a series of trade marks. This is allowed when you have two or more trade marks that closely resemble each other and differ only in respect of one or more of the following ways:

A. Statements or representations as to the goods or services in relation to which the trade marks are to be used;

For example – in relation to ‘clothing, headgear and footwear’

NAME Clothing

NAME Headgear

NAME Footwear

B. Statements or representations as to number, price, quality or names of places; Examples:

Number	Price	Quality	Names of Places
MMW1	MMW \$1.00	MMW PREMIER	SYDNEY MMW
MMW2	MMW \$20.00	MMW SUPERIOR	MELBOURNE MMW
MMW1st	MMW \$5.00	MMW GOLD	MMW
MMW2nd	MMW £5.00	MMW SILVER	MMW PERTH
MMW3rd	MMW ¥5.00	MMW BRONZE	MMW WA

C. The colour of any part of the trade mark.

Examples: MMW; MMW; MMW;

(these differ only in colour in part of the mark so would be acceptable)

Types of Applications

There are several ways to file an application in Australia, suited to different purposes and budgets:

1. **Paper Filing** – (most expensive and not used by our office) – this involves completing and posting/faxing a ‘paper’ application – this incurs the highest government fee for a standard trade mark;
2. **Pick List Filing** – (least expensive government fee) – usually appropriate; this means we select goods/services from a government generated pick list for each class of your trade mark application – using their terms and definitions.
3. **Headstart Application** – (in between government fee) – This provides a report within 5 days as to whether your proposed mark is likely to be accepted for registration. Assuming a positive result we then move to formally file the trade mark and it then goes through its usual process.
4. **Own Specification Filing** – (higher government fee) – this allows us to draft the goods/services in our own words rather than use the pick list – this can be good when you have an unusual product/service that does not meet common definitions, or if we need to draft your specification in a way that avoids conflict with another trade mark.



STEP 3 - GOVERNMENT EXAMINATION: REPORT OR APPROVAL

After your application is filed the government office must examine all of the details to ensure that:

- a) The basic filing requirements are met; and
- b) To ensure that your trade mark is registrable

This process usually takes around 4 months in a standard pick list application – a time frame that does fluctuate. If you have filed a Headstart application, the formal examination will then be quicker.

Adverse Reports

If an adverse report is issued, and you have had a full search conducted before filing (or filed a Headstart application), the issues raised will not come as a surprise. The most common reasons for the trade mark office to object to your trade mark being approved are:

- a) Your trade mark conflicts with a trade mark that has an earlier date than your own; and
- b) Your trade mark is not automatically seen as capable of distinguishing your goods/services from those of other traders.

If an adverse report is issued you will be given 15 months to respond and address the issues so that your trade mark is in order to be approved.

We encourage any applicant that receives a report to respond to it as soon as possible. If left too late in the time frame, you may need to request (and pay for) an extension of time past the 15 months allowed. The usual way to address these types of issues is providing evidence of use (or in some cases, intent to use) of your trade mark; refining your goods/services to remove the issue, and in some cases negotiating with owners of earlier trade marks.

Our office will advise, based on your situation, the best and most likely option to succeed. This advice is provided at no additional charge, as it is included in your application fee. We will seek your instruction and if (and only if) you provide it will we take further billable action on your behalf.



Notice of Acceptance (approval)

If no issues are found during the government examination of your application – or if you successfully address any issues that are raised – a notice of acceptance will be issued. This will advise the date on which the acceptance of your trade mark will be advertised in the Official Journal of Trade Marks. The advertisement of acceptance commences a period of time during which other people may lodge formal objections to your trade mark becoming registered, if they believe they have grounds to do so. They will have 2 months from the date of advertisement to file a notice of intention to oppose. Once a notice of intention to oppose has been filed, the ‘opponent’ must then lodge their statement that sets out the grounds and particulars upon which they oppose.

If nobody lodges a notice of their intention to oppose, or do not request an extension of time in which to lodge their objection, your trade mark can then progress to full registration.

What if someone opposes?

If someone files a notice of an intention to oppose your trade mark becoming registered during the period allowed (or within an extended period if they request such an extension) we will be notified by the Trade Marks Office. There are a number of grounds an opponent may select and advise when filing their statement of grounds and particulars – including the same ones that the examiner may rely on to issue an adverse report. Additionally an opponent may claim that you are not the owner of your trade mark; that it is too similar to one that has acquired a reputation in Australia and that it includes false geographical indications amongst others.

(If the Opponent does not file the statement of grounds and particulars within 1 month of the notice of intention to oppose, or seek further time, then the opposition will be dismissed and your mark will progress as normal).

After the above documents are filed by the Opponent, you will need to file a notice of your intention to defend against the opposition. If you do not do so, then your trade mark will lapse and the opponent will effectively ‘win’ their opposition. You must file this notice of intention to defend within one month of receiving the Opponent’s statement of the grounds and particulars. After the opponent receives your notice of intention to defend, they will then have three months to file evidence in support of that opposition, in an attempt to prove that the grounds they have selected are true. You will then have the opportunity to provide evidence in answer to the evidence they have supplied (you will also have three months). The opponent will then have a final chance to supply further evidence before the matter is decided (this final evidence must be filed within 2 months). A decision may happen simply by a government officer considering both parties’ evidence, or either of the parties can request to be heard in the matter.

The successful party in opposition proceedings is able to request an ‘award of costs’ against the unsuccessful side. This means, the unsuccessful party may be ordered to pay a certain amount of the ‘winning’ side’s costs. All costs are determined by a set schedule. Of course, if your application is opposed we will notify you immediately upon our office being informed, and provide advice, recommendations and fee estimates based on your particular case.



STEP 4 - REGISTRATION & RIGHTS

If your trade mark is accepted for registration and is not opposed by a third party (or, if you are opposed but come out as the successful party) the trade mark can then proceed to registration. This will not occur for at least 7.5 months from the date on which your application was filed.

How long does registration last?

The initial period of protection is for 10 years from the date the Application was first filed; you can renew this each 10 years if you desire and are still using your trade mark. It's important to note that trade marks can be vulnerable to removal if they remain unused for a certain period of time.

Where will my trade mark be registered?

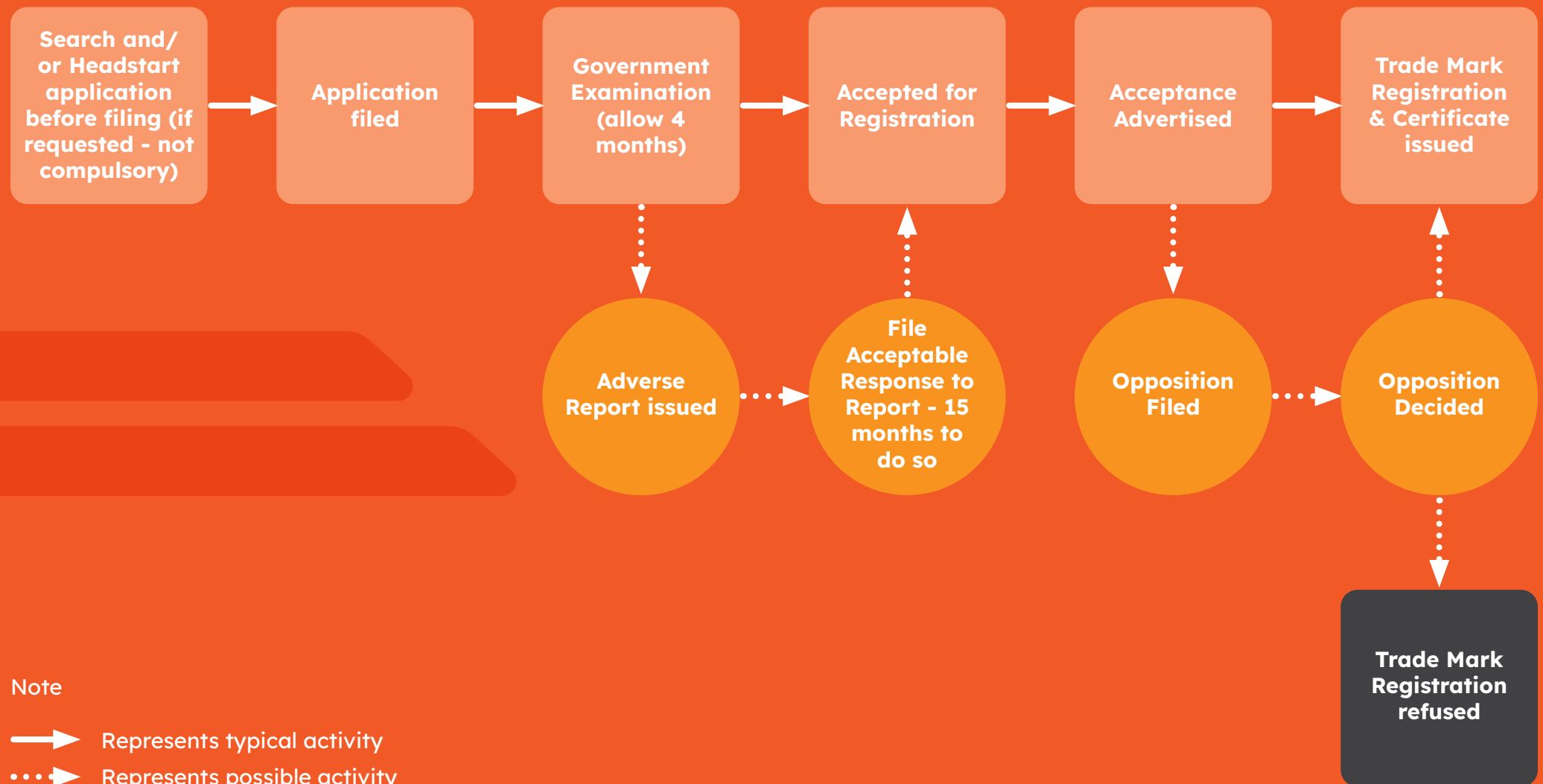
Your trade mark will be registered Australia-wide. Your rights therefore also apply Australia-wide (unless particular limitations are placed on your trade mark, which usually would occur to resolve opposition matters and similar).

What rights do I have as a trade mark owner?

There are several main rights that come with a registered trade mark: The right to use your trade mark, in Australia, in connection with the goods/services it is registered in respect of; The right to authorise the use of your trade mark in Australia, in connection with the goods/services it is registered in respect of (e.g. in a licensing situation, or franchise situation etc). The right to take infringement action against other persons that use your trade mark (or a deceptively similar trade mark), in Australia in connection with the same or related goods/services without your permission, and are found to be infringing upon your rights. The right to claim your trade mark is 'registered', and use the trade mark with the ® symbol. A person cannot claim or represent a trade mark as registered, or use this symbol, if it's not registered. In fact, it's an offence to do so.



TRADE MARK REGISTRATION PROCESS



INTERNATIONAL PROTECTION

There are two ways you can seek to register a trade mark outside of Australia:

1. Filing of national applications, directly to each country of interest. (In some cases, this will be the only option)
2. Through the Madrid Protocol – a Protocol to which Australia is a member. This allows you to file a single application and choose which of the other member countries you wish to extend your trade mark rights to.

(There are currently 120+ countries available through this system.)

For more information on the Madrid Protocol, please see our International Trade Marks Guide

Priority Period Available For Australian Applicants

The date of your earliest application (for example, your Australian application) for a particular trade mark in relation to its goods/ service is known as your 'priority date'. If you file overseas within 6 months of this date you are entitled to claim (in most countries) priority, so that each international application will be treated as though filed at the same time as your Australian application. This will provide you with preference over any application filed during that time with a later priority date. This provides a good window of time to plan and budget for any overseas trade mark requirements. This is a strict six month period, and cannot be extended. If you file later than 6-months you will lose the right to claim priority based on your earlier Australian application and each foreign application would then be treated as filed on the precise physical filing date.

European Union (EU) Trade Mark

An EU Trade Mark extends to all member countries of the European Union and can be achieved by filing a single application (or, selecting it as a single designation under the Madrid Protocol). If approved, you will gain the same level of protection and right as you would by filing into each European Union member separately. However, it's important to note that because it is a single application, a rejection due to a problem in one member country will affect the entire EU application.



IMPORTANT NOTES

Infringement

It is the trade mark owner's responsibility to monitor for infringement and determine if action is required. Contact our office if you would like information about our monitoring service to help identify infringing activity, or, conflicting applications filed after your own. If you suspect your trade mark rights are being infringed please contact us. There are circumstances that allow people to have defence to any allegation of infringement, so always seek professional advice before making any threat of infringement action. If you have received communication from another party stating that you are infringing their rights, please contact us for advice.

Use it correctly

Use your trade mark the way it has been registered; It is a punishable offense to display a trade mark as registered (including by using the ® symbol) if it is not subject of a trade mark registration.

Use your trade mark as an adjective – it is not a noun – for example:

- ☒ XYZ® Lawnmowers
- ☐ XYZ®
- ☒ We import and distribute XYZ® Lawnmowers
- ☐ We import and distribute XYZs®

Don't allow your trade mark to become generic:

As a trade mark is a 'sign used to distinguish the goods/services...' don't let your trade mark become the common name for the type of goods/services, as it could then cease to be considered a 'trade mark'. In such cases, it may be possible for the registration to be cancelled following an application to the courts. A good example of a trade mark owner ensuring their trade mark does not become generic is Sealed Air Corporation (from USA). This company owns the rights, in a number of countries, to the trade mark "Bubble Wrap" and variations. A term a lot of us are familiar with, and use in daily life – however, this company is very good at contacting others that try and use this term as a description of goods in trade mark applications and advising that the term is a trade mark, not a common description and that it needs to be changed accordingly to terms such as "plastic packaging material incorporating air pockets" and similar.

Use it or lose it

Remember – trade marks can become vulnerable to removal if they remain unused for a period of time.



Trading on the Internet

Remember that trading on the Internet places you in a global marketplace. Trade mark rights apply country-by-country, and use of your trade mark on the Internet could inadvertently infringe the rights of someone in another country. Australia, along with other member countries of the World Intellectual Property Organisation have established guidelines to help protect trade mark owners when doing business over the Internet. The guidelines state that a party (from one of the member countries) when allegations are made concerning trade mark infringement from someone from another member country, will not be held liable for any infringement up to the time of being notified of the infringement if the following applies:

- a) The user owns the right to that sign/trade mark in another member country, or uses it with the consent of the owner in that country;
- b) That any acquisition of the right in that sign/trade mark, or use of it, has not been in bad faith; and
- c) That the user has provided alongside the use of that sign/trade mark on the internet, information reasonably sufficient to contact them by mail, e-mail or telephone/facsimile.

Once a notice is received of alleged infringement, liability will still be avoided if the person receiving the notice

- a) Provides the relevant details to the sending party of their registered rights in their own country; and
- b) Expeditiously takes reasonable steps to avoid commercial conflict or avoid infringement of the trade mark rights referred to in the notice in that Member country.

Importing Goods

It is possible to lodge a notice with the Australian Customs Service to formally object to the importation of goods that infringe your registered trade mark. Such a process and related law provisions are administered by Customs.

Essentially, if you have lodged a notice and if goods come in that infringe your trade marks they will be seized by Customs. You will then need to determine whether they are to be released or not – and pay any necessary fees associated. More information can be found at the Customs website.



FEES

The following fees apply during the course of a standard Australian trade mark application.
All fees are inclusive of government fees, professional fees and GST and are current at the time of publication.

Searches (see page 7)

Identical Search	\$0.00
Register Search & written report with advice	\$220.00
Full availability & Infringement Search: word marks	\$550.00
Full availability & Infringement Search: word & image marks	\$750.00

Standard Applications (see pages 8 & 9)

First class using the 'pick list'	\$895.00
Each additional class using the 'pick list'	\$610.00
First class own specification rather than pick list	\$1045.00
Each additional class own specification rather than pick list	\$760.00

Headstart Applications (see page 9)

First class using the 'pick list'	\$975.00
Each additional class using the 'pick list'	\$690.00
Filing new trade mark/representation during assessment process (per class)	\$150.00

Series Applications (see page 9)

Contact for quote



FEES CONTINUED

Registration & Renewal (see page 12)

Registration	\$0.00
Renewal – first class (if paid by due date)	\$675.00
Renewal - per additional class (if paid by due date)	\$400.00

Other Common Fees – your instruction will always be always be sought. If not listed, please contact for a quote.

Hourly fee when applicable - Principal Attorney / Other Attorneys	\$330.00 / \$275.00
Filing of a Notice of Intention to Oppose	\$600.00
Filing of Statement of Grounds & Particulars relating to opposition	\$450.00
Filing of Notice of Intention to Defend against an Opposition	\$250.00
Filing request to remove due to non-use	\$600.00
Extension of time (per month or part therefore) – Application matters, by due date	\$155.00
Extension of time (per month or part therefore) – Application matters, after due date	\$210.00
Extension of time (per month or part thereof) – Opposition matters, by due date	\$205.00
Extension of time (per month or part thereof) – Opposition matters, after due date	\$260.00
Late fee to renew Trade Mark past due date, available for maximum of 6 months past due date (per month or part thereof) – (In addition to Renewal fee)	\$155.00
Drafting Deed of Assignment to transfer ownership of a trade mark with simple Letter of Assignment	\$165.00
Prepare Deed of Assignment if required	\$330.00
International Trade Mark Registration	Contact for quote



MORE INFORMATION

As this guide demonstrates, there are a lot of aspects to Trade Marks, Trade Mark law and Trade Mark registration. If you have questions, not answered in this guide, please contact our office:

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Disclaimer:

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