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## Tips on Trade Mark Protection in Australia

In Australia, a trade mark may be a word, name, number, logo, picture, aspect of packaging, shape, colour, scent, sound or a combinations of the those signs, which are used to distinguish goods or services provided by one trader from those of other traders.

### Why registration is important?

In Australia, there are two ways to establish your rights to a trade mark:

- by using the trade mark
- by registration of the trade mark

Although it is not compulsory to register your trade mark, registration makes it much easier for you to enforce your trade mark rights. The benefits of trade mark registration include:

- **Exclusive rights** - you can stop and prevent unauthorised use of a trade mark (e.g. copycats). Without registration, you can only stop and prevent unauthorised use if your reputation has been established in the trade mark.
- **Nationwide protection** – registration gives protection to your trade mark across Australia. Without registration, your rights are generally limited to the areas where you can prove a reputation.
- **Valuable asset** - a registered trade mark is a valuable asset which can be licensed or sold.

- **Cost effective enforcement** - once registered, reputation in the trade mark does not have to be established in order to obtain relief from infringement. Proving reputation can often be a difficult and costly exercise.

### How to select a registrable trade Mark?

When selecting a trade mark, it is important to choose a mark, which is distinctive and not substantially identical or deceptively similar to existing trade mark(s) (“Conflicting Trade Marks”).

#### Distinctiveness

A registrable trade mark should be capable of distinguishing the applicant’s goods or services from same or similar goods and/or services provided by other traders. Marks regarded as having no inherent ability to distinguish include:

- geographical names
- common surnames
- common trade expressions
- descriptive words and phrases
- short combinations of numbers or letters on their own

Examples of trade mark applications, which have been rejected due to lack of distinctiveness:

- **TOTALPATENT** for on-line interactive databases featuring information

relating to the analysis, evaluation and creation of patents in class 45 (2012 ATMO 46) – expression has been used for the sake of its ordinary meaning by other traders in Australia engaged in similar services

- **HARBIN** for beer, beer wort, non-alcoholic fruit extracts in class 45 (2012 ATMO 48) – Hairbin is the capital city of Heilongjiang province in China. Other traders should be able to use this term to indicate the origin of their goods.

#### Conflicting Trade Marks

An application for a trade mark must be rejected if the applicant's trade mark is substantially identical with or deceptively similar to an existing trade mark (registered or pending) in respect of similar goods or services. Hence, it is recommended to conduct searches for Conflicting Trade Marks prior to applying for registration.

Examples of trade marks that are substantially identically or deceptively similar:



- Red Eagle (composite mark) and Red Hawk (word mark) ([2012] ATMO 7)
- WOSS (word mark) and BOSS (word mark) ([2000] ATMO 88)

#### **Minimum Filing Requirements**

- the applicant's full name and address (including incorporation details if the applicant is an Australian company)
- a clear representation of the trade mark if it contains a device
- the class(es) in which the application is to be filed
- a statement of goods and/or services for which registration is to be sought

- details of convention priority claim (if any)
- an address for service in Australia (if overseas applicant)
- a translation of any part of your mark that is not in English (if any)

*Note: Business and trading names cannot own property; therefore, an application should be in the name(s) of the owner(s) of the business name registration or company (if the business is an incorporated entity).*

#### **Registration Process**

In Australia, the registration process includes

- Trade mark search (not mandatory)
- Preparation and lodgement of applications
- Examination
- Application acceptance
- Advertisement for opposition
- Trade mark registration

#### Trade Mark Search

Although a trade mark search is not mandatory for registration purposes, it can play a major part in reducing your risks and legal costs. A search should be conducted before using your trade mark for marketing and labelling your goods and services. A trade mark clearance search will:

- disclose whether your trade mark is available for registration
- identify whether your trade mark will infringe the rights of other traders
- minimise objections being raised during the registration process
- minimise the risk of a trade mark dispute arising later

#### Preparation and lodgement of applications

Once an application is filed, it is not possible to make substantial changes to the applications (including but not limited to

changes to the representation of the trade mark itself, addition of extra classes or addition of extra goods and services). Hence it is recommended that professional advice be sought prior to lodgement of the application. Important decisions you have to make when preparing an application include:

- the identity of the applicant;
- the elements of your branding. These may include the name of your business or company; the names of your goods and services; or distinctive elements of your packaging;
- appropriate descriptions of the goods and services you actually trade in or intend to trade in the near future; and
- the class or classes to be included in the registration.

### **Classification**

Australia has adopted the Nice Classification of Goods and Services ("**Nice Classification**") (10th Edition, as of 1 January 2012) in the examination of trade mark applications. As there have been changes in the classification of particular goods and services, it is recommended that the initial search to identify potential Conflicting Trade Marks should be across all 45 classes.

### **Wording of the specification**

The specification of the goods and services covered by a trade mark should be clear and unambiguous. Examples of unacceptable specifications:

- goods in this class
- services in this class
- parts and fittings not relating to specific goods

### Examination

Typically an application will be examined within 3 to 4 months after filing. The examiner from IP Australia will examine each application on its own merits, including formalities and substantive requirements.

If the examiner decides:

- your application meets all the requirements, your trade mark will be accepted for registration; or
- your application does not meet all the requirements, an adverse report will be issued.

Some of the most common grounds outlined in an adverse report for rejection are:

- your trade mark does not distinguish your goods and/or services
- your trade mark contains words or phrases that other traders are likely to use
- your trade mark is substantially identical or deceptively similar to another trade mark

You will have **15 months** from the date of the examiner's first report for you to address their concerns. To overcome the objections, the applicant may:

- make submissions in rebuttal
- provide formal evidence of use
- amend the specification of goods and/or services to avoid the grounds for rejection

### Acceptance

Once an application has been accepted, a Notice of Advertisement of the Acceptance of the trade mark will be sent to the applicant.

### Advertisement For Opposition

Once advertised, the trade mark application is open to opposition by any party for 3 months from the date of advertisement. Common reasons for opposition include

- the trade mark is not distinctive
- the trade mark is identical or deceptively similar to another registered or pending trade mark
- the trade mark applicant is not the true owner of the trade mark

- the use of the trade mark is likely to cause deception or confusion because of the reputation in another mark

#### Registration

If no opposition is filed or opposition fails, an application will then proceed to registration upon payment of the registration fees. The registration fee is AU\$300 per class.

#### **Renewal**

A trade mark registration may be renewed every 10 years. The fee for renewal is AU\$300 per class.

#### **Use of Trade Marks**

Once a trade mark is successfully registered, it is important to use the trade mark in the form in which it is registered. To claim your interest in a trade mark, you can use either <sup>TM</sup> or ® symbols:

- <sup>TM</sup> symbol means that trade mark rights are being claimed in the mark. The mark itself may or may not be registered.
- ® symbol means that the mark is claimed to be a registered trade mark with the Trade Marks Office.

#### **Non-use Removal**

To prevent loss of your registered trade mark, you must use it in the course of trade. Any person who is adversely affected in a legal or business sense by the existence of the non-used trade mark may apply for removal of a trade mark for non-use, if:

- 5 (five) years has lapsed from the filing date in respect of the registration of the trade mark to be removed; and
- the trade mark has not been used in Australia during the three years immediately preceding the filing of the non-use removal application.

#### **Enforcement of Trade Mark Rights**

Once a trade mark is successfully registered, it is important for the owner of the trade mark to actively protect their trade mark rights. The avenues available for a trade mark owner to enforce trade mark rights include:

- Customs seizure: Customs provisions under the Trade Marks Act 1995 (Cth) allow Australian Customs to seize goods that infringe trade marks.
- Trade mark infringement litigation.

The detailed registration process in Australia including typical steps (green with unbroken lines) is shown below

