

# Trade Marks

## What is a trade mark?

*A trade mark is a way of identifying a unique product or service. Sometimes called a brand, your trade mark is your identity.*

A trade mark is used to distinguish the goods and services of one trader from those of another. A trade mark can be your most valuable marketing tool. The public identifies a certain quality, reputation and image with goods and services bearing a trade mark. The more successful your business is the more valuable the trade mark becomes.

A trade mark is a right that is granted for a letter, number, word, phrase, sound, smell, shape, logo, picture and/or aspect of packaging. An example of a well-known trade mark is QANTAS and the flying kangaroo.

## What is a trade mark registration?

This is a commercial asset that gives you the right to stop other entities from using deceptively similar trade marks to draw away your customers.

A registered trade mark is legally enforceable and gives you exclusive rights to commercially use, license or sell it for the goods and services that it is registered under.

## Why register?

There are many benefits of registering a trade mark, but you don't have to register your trade mark to use it. There is protection against misrepresentation under trade practices or fair trading legislation; however without registration, it can be expensive and time consuming to take action under common law.

As the owner of a registered trade mark you:

- have the exclusive right to use your registered trade mark as a brand name for the goods or services specified in the registration
- have the exclusive right to authorise other people to use your registered trade mark for the goods or services specified in the registration
- have a registered trade mark that is personal property and can be sold
- have a registration that usually covers the whole of the Commonwealth of Australia
- may give the Australian Customs Service a notice objecting to the importation of goods that infringe your registered trade mark
- can be in a stronger position to stop other people from using your trade mark as their brand name on the same or similar goods or services of your trade mark registration.

The registration process can reveal existing registrations that might be infringed by your use of your trade mark in time for corrective action to avoid a costly dispute.

In Australia, registration also provides an initial defence to infringement of others' registrations.

## Who do you apply to?

IP Australia is the Australian Government agency that administers intellectual property (IP) rights and legislation relating to patents, trade marks, designs and plant breeder's rights.

## Before you apply

Before you apply, you'll need to decide if registering a trade mark is appropriate for your brand, where you want to register it and what's involved in the application process.

## The Australian trade mark registration process

There are many steps involved and things to consider when registering a trade mark. It is important to take care in completing your application as this will assist IP Australia in processing your trade mark application as quickly as possible

### 1. Pre-filing search

Before applying for a Trade Mark Application, you should conduct a search to see if there are any trade marks already being used by other traders that may affect the likelihood of your trade mark being registered.

Searches can be conducted using online databases for trade marks or by an IP professional.

#### **How much does it cost?**

\$0 – if the search is conducted by yourself.

#### **How long does it take?**

There is no set time for the search to be conducted.

### 2. Filing an application for a trade mark registration with IP Australia

Your trade mark application will include a copy of the trade mark and a description of the goods or services you currently use or intend to use your trade mark on.

### 3. Examination by IP Australia

Approximately three to six months after filing, your application will be examined by IP Australia, although you can seek an expedited examination.

Many applications pass examination without objection, although it is not uncommon for objections to be raised. If the Examiner raises any objections, you are given an opportunity to overcome them through argument and/or amendment of the application.

If your application meets all the requirements, your trade mark will be accepted for registration.

You have 15 months from the date of the Examiner's first report to overcome any objections by the Examiner and to have your application accepted. An extra six months is available upon payment of extension fees.

### 4. Acceptance for registration

Acceptance of trade mark applications is advertised on IP Australia's website, at which point they are open to a three month opposition period.

### 5. Oppositions

Third parties are given three months to oppose registration of your trade mark.

Anyone who believes your trade mark should not be registered may oppose its registration within three months of the advertisement date.

If your application is opposed, it is your responsibility to defend this action. The cost of defending such a challenge depends on a wide range of factors, including the interested party's conduct.

Oppositions are not common

### 6. Registration

Following the opposition period, if no opposition is filed against your application or if an opposition is unsuccessful, your trade mark will be officially registered following payment of the government registration fees. Your trade mark will be recorded in the Register of Trade Marks and a certificate of registration issued.

Your trade mark will be registered from the date you filed your application. Once registered, your trade mark becomes an enforceable legal right.

## How do I register a trade mark internationally?

An Australian trade mark registration provides protection only in Australia. To protect your trade mark overseas, you will need to register it in each country of interest. It is usually advisable to register your mark in each country where you manufacture or sell products, or are licensing your trade mark (or plan to do any of these things).

Before applying for an international trade mark, you should conduct a search to see if there are any trade marks already being used by other traders which may affect the likelihood of your trade mark being registered.

Searches can be conducted using online databases for trade marks or by an IP Professional.

#### **How much does it cost?**

\$0 – if the search is conducted by yourself.

#### **How long does it take?**

There is no set time for the search to be conducted.

### Australian trade mark registration costs

Trade marks are registered in relation to selected goods and services, which are categorised into different classes. The cost of the registration process varies depending on how wide a range of goods and/or services are selected. For a routine selection of goods or services falling into one class:

- Optional searching to check whether a trade mark is available for use and registration typically costs about \$1100.
- Filing an application for trade mark registration typically costs about \$880.
- Analysing and responding to objections (if any are raised) typically costs about \$1000, though much higher costs are possible if you are faced with serious objections and choose to argue the point.
- Acceptance and registration typically costs about \$800.
- renewals due every 10 years cost about \$700.

For detailed information on costs, visit:

<http://www.ipaustralia.gov.au/get-the-right-ip/trade-marks/time-and-costs/fees/>

### How long does a trade mark last?

A trade mark can have an infinite life representing significant business value.

- Initial registration of a trade mark is for 10 years.
- You can continue to renew it for successive periods of 10 years by paying a fee.
- You must actively use your mark to avoid removal on the grounds of non-use.

### Unregistered trade marks

It is not necessary to register a trade mark to obtain some rights to it. Trade marks that are not registered may be protected under common law and enforced using the provisions of the Competition and Consumer Act 2010 and other state based fair trading legislation.

Protecting your trade mark without the benefit of registration may be more difficult and expensive.

You don't have to register your trade mark in order to use it. The symbol TM can be used with a trade mark at any time.

### Further information on trade marks

Detailed information about trade marks can be found at IP Australia's website at:

<http://www.ipaustralia.gov.au/get-the-right-ip/trade-marks/>

### Contact us

For advice on, or assistance with, your trade mark, speak to Phillipsons Accounting Services.

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