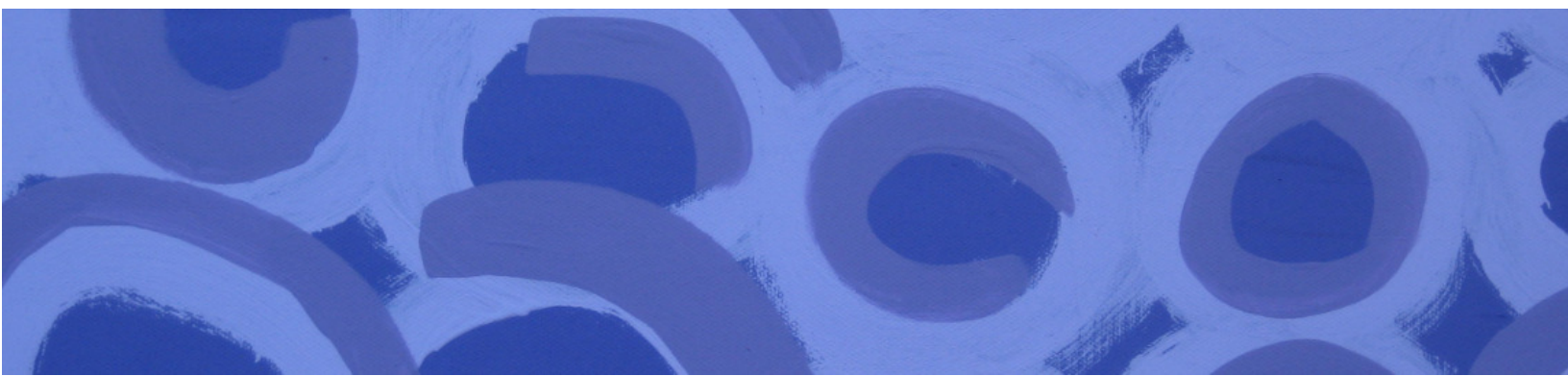




Terri Janke and Company Pty Ltd
Lawyers and Consultants

TRADE MARKS

**Answers to questions and General
Information**



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What is a trade mark?

A trade mark is a distinctive sign used by a person or a business to identify itself to consumers and to set apart its products or services from those of rival traders. In essence, trade marks are all about marketing and gaining a competitive edge on the market.

Types of trade marks

There are two types of trade marks.

1. Common law trade marks

A common law trade mark is a trade mark that is used by a person or company for advertising and marketing their goods and services. In this way, the trade mark is used as a brand name or logo but is not registered under the Trade Marks Act 1995 (Cth).

2. Registered trade marks

A registered trade mark is a trade mark that is registered under the *Trade Marks Act* and is listed on the national trade mark register of Australia, IP Australia. A registered trade mark is usually denoted by the symbol ®. Only a registered trade mark can use this symbol. Trade marks that are still going through the registration process use the symbol ™ and this symbol is used through the application process until it is a registered trade mark.

What is a registered trade mark?

A registered trade mark is a powerful commercial tool used to communicate your business and brand to the public. It is used to distinguish the goods and services of one trader from those of another. Almost anything from colours, images, sounds, words, slogans, shapes and smells can be registered as a trade mark. Once registered, a trade mark becomes personal property just like any other possession. A trade mark owner is given the legal right to exclusively use or control the use of a mark for the goods or services in which it is registered.

This is distinct from...

- A **company name**, which identifies a legally incorporated entity;
- A **business name**, which is a trading name only, valid only in the state(s) it is registered; and
- **Domain names**, which are site addresses on the Internet. Registration of a domain name gives you exclusive use of that Internet address but only for an agreed period of time.



The *Trade Marks Act* defines 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 or organisation, from goods or services dealt with or provided by any other person or organisation.

A “sign” includes any of the following or any combination of the following “letter, word, name, signature, numeral, device, brand, heading, label or ticket, aspect of packaging, shape, colour, sound or scent”. This is a non-exhaustive list of the things that may be trade marks. Some examples of these include: CADBURY (colour purple); VEGEMITE (word); FREDDO FROG (shape); the shape of the distinctive COCA COLA bottle; and the high pitched “PING” sound between the words “AH McCAIN, YOU’VE DONE IT AGAIN” (sound).

What are the benefits of registering a trade mark with intellectual property (IP) Australia?

Under intellectual property laws, the *Trade Marks Act* provides protection for registered trade marks. As the registered owner, you:

- have a registered trade mark which is personal property and can be sold;
- have exclusive ownership rights to your trade mark nationwide as a brand name in the classes of goods or services for which it is registered;
- will be in a stronger position to stop other people from using your trade mark as their brand name or as a deceptively similar brand name in those classes of goods or services;
- have the exclusive right to authorise others to use your registered trade mark for the goods or services specified in the registration (via license); and
- have the right to give the Australian Customs Service a notice objecting to the importation of goods that infringe your registered trade mark.

Broadly speaking, once your trade mark has been registered, you will obtain an Australia-wide monopoly for use of that trade mark in respect of the goods or services for which registration was granted. You will not obtain this right if you use your mark as a business name, domain name, or company name without registering it as a trade mark.

What if I registered my business name, is that adequate protection?

A business name is simply a name or title under which a person or other legal entity may conduct its business. Business name registration is legally required under NSW law before a business can start to trade. Under the *Business Names Act 2002* (NSW), if you choose a name for your business that is not your own name then you must register that name with the Department of Fair Trading (NSW). **Business name registration is separate to trade mark registration.** Registration of a business name does not also register that business name as a trade mark and is only valid in the state it was registered in. Whereas, trade marks registration is valid nationally.



Application for registration

The current processing time for registering trade marks is 3-7 months, although applications can be expedited.

Applying for registration of your trade mark will involve:

1. preliminary searches to establish whether there is a trade mark that may be the same or very similar to your trade mark;
2. lodging an application for registration of a trade mark with IP Australia;
3. considering whether you wish to apply to have your application dealt with on an expedited basis;
4. dealing with any objection that IP Australia may have to the registration of the mark; and
5. paying registration fees which will ultimately be a prerequisite to the issuance of a certificate of registration.

Classes of goods and services

For the purposes of registering your trade mark, all goods and services are categorised into classes.

When making your application, it will be necessary to nominate the number of classes in respect of which your application will apply. You will also need to supply more information regarding the composition of your product to ensure the correct class or classes are applied for.

This means listing the specific products and services in listed classes for which you will use or intend to use the trade mark. For this reason, it is recommended that you undertake a thorough search on the proposed brand names for products and services. There are trade mark lawyers and attorneys that can provide a thorough search of all business names and registered trade marks in Australia. Before even selecting a name, it is prudent to conduct a trade mark search of the trade marks database on the IP Australia website: <http://www.ipaustralia.gov.au>.

Your lawyer will be able to advise you on this. Keep in mind, however, that increasing the number of classes will increase the amount of fees payable for:

1. lodging the application; and
2. Securing registration of the trade mark.



How do you register an Australian trade mark?

1. Submit an application to the Trade Marks Office

When you're ready, you may apply to have your proposed trade mark registered against certain classes of goods and services. There are 45 separate classes of goods and services in which a trade mark may be registered.

What happens next?

2. Examination

The Trade Marks Registrar will review your application and make an assessment. When you apply to the Trade Marks Office there is no guarantee that your proposed trade mark will be accepted and advertised in the Australian Official Journal of Trade Marks.

3. You receive the result of your application

a. Accepted:

If the Registrar accepts your trade mark application, it must be "advertised" in the Australian Official Journal of Trade Marks for two months before it may be registered. In this context, "advertising" means that the Registrar's decision to accept your request for registration is published in the Australian Official Journal of Trade Marks. This allows the public to be made aware of your efforts to get your trade mark registered and gives them an opportunity to challenge that registration.

At this point your work is done. As the applicant your job is to wait for the two month period to hear if anyone will oppose the application. If no one does, at the end of the two months your pending acceptance will become automatically official.

b. Denied:

If your application is denied, you have 15 months to amend it. You also have the option of having your case heard by the Registrar of Trade Marks. At this hearing they will provide you with an opportunity to plead your case before the application is officially rejected. If officially rejected you have the option of appealing the decision of the Registrar to the Federal Court of Australia.

4. Opposition by a third party

A person may oppose the registration by filing a notice of opposition with IP Australia. The registration of a trade mark may be opposed on any of the grounds specified in the Trade Marks Act and on no other grounds (please see below). The notice of opposition must be in an approved form and must be filed within two months of the applications publishing. The opponent must serve a copy of the notice of opposition on the party whose trade mark they are opposing.



Why might the Registrar deny your application?

- A trade mark cannot be graphically represented;
- A trade mark does not distinguish the applicant's goods or service;
- A trade mark is scandalous or its use is contrary to the law;
- A trade mark is likely to deceive or cause confusion;
- A trade mark is substantially identical with, or deceptively similar to (SEE DEFINITION BELOW) another trade mark.

Why might a third party challenge your application?

It is not uncommon for other business owners with registered trade marks to challenge your application for registration. A third party may oppose your registration because:

- You are not the owner of the trade mark;
- The opponent's earlier use of a similar trade mark;
- You lack intention to use the trade mark;
- A similar trade mark to yours has acquired a reputation in Australia;
- Your trade mark containing or consisting of a false geographical indication;
- Your application is defective; or
- Your application has been made in bad faith.

How can I protect my business name in the interim?

If your trade mark is not yet registered or is not able to be registered, you should use the letters ™ on your goods or in relation to your services to show others that the trade mark is yours.

Once your trade mark is registered, you are allowed to use the symbol ® to denote a “registered trade mark”. It is strongly recommended that when your trade mark is registered you use the ® symbol on the goods or in relation to the services for which your trade mark is registered, to put other people on notice that the trade mark is yours.

What are some tips for choosing my trade mark?

The more original the word, the easier it may be to register as a trade mark. Words commonly used in everyday life, or commonly used in the course of business, are less likely to be accepted for registration. This is because it is unfair to restrict your competitors or other businesses from using everyday language or language necessary for conducting their business. For example, it cannot be a direct description of the goods or services for which it is used, like “Television” or “Furniture”. It would need to be more unique than that, for example “FANTASTIC” Furniture (the registered trade mark being “Fantastic”) or “DICK SMITH” Electronics. Your trade mark



should be easy to pronounce and spell. It is best you consult with your legal advisor prior to registering any given name.

My business logo has a brand name and a distinctive colour or image. Do I need to register the colour or image and the business name?

This will vary on case by case basis and it is really best to obtain legal advice before making such decisions.

What is “deceptively similar”?

A trade mark cannot be deceptively similar to any other trade mark under the same classes of goods or services. A trade mark must not appear so similar, whether in letters, sounds, colours and so on, that it may confuse consumers into thinking it is, or is associated with another brand. This is more likely to be the case if the trade mark is registered against the same or a similar category of goods or services.

Are all trade marks registrable?

To be registrable a trade mark must meet certain conditions that are spelled out in the *Trade Marks Act 1995* (Cth). Trade marks that:

- indicate the kind, quality, intended purpose or value of the goods or services; or
- are common surnames or geographical names are usually not capable of distinguishing goods or services.

In addition:

- Trade marks which conflict with an earlier trade mark, or would mislead the public about the nature of the goods or services are not registrable;
- Words protected by law cannot be registered as trade marks. Others are prohibited as trade marks under the Trade Marks Act 1995 (Cth), for instance, OLYMPIC CHAMPION, or other legislation. For instance, the use of the word CHAMPAGNE is governed by provisions of the Australian Wine and Brandy Corporation Act 1980.

Can I register Indigenous words as trade marks?

Before using Indigenous language words as your trade mark, brand or domain name in relation to your business, it will be useful to consider:

- Is it appropriate for the word to be used in the proposed context?
- Will it be misleading or deceptive? and/or
- Will people think it is associated with an Indigenous clan or community?



If an Indigenous language word is used in a commercial way such as for a trade mark, brand, business name or domain name for goods or services, you will need to obtain free, prior and informed written consent from the relevant owners of the traditional knowledge or Indigenous knowledge, in addition to entering into a benefit sharing agreement. We recommend you consult a legal advisor before acting on this issue.

How long do trade mark rights last?

Trade marks are protected as long as they remain registered. After registration is accepted, a trade mark is protected for 10 years. This 10 year period starts from the day you first apply to register your trade mark. At the end of that 10 year period, if you wish to extend your trade mark for a further 10 years, this can be done by paying the renewal fee to the Trade Mark's Office.

What if my trade mark is already used for different products and services?

If your proposed trade mark is the same as, or closely resembles another business' already registered trade mark, it may still be able to be registered if the goods and/or services that are covered by your proposed trade mark are different. This is surprisingly common, even with big companies. For example, the trade mark DOVE is registered for a company that makes soaps and for a separate company that makes chocolates. FANTASTIC is registered for a furniture company, and for pasta products and snack foods. An exception to this is where a trade mark is a 'famous' trade mark, such as ADIDAS or COCA-COLA, where the owner's rights in the famous mark may go beyond goods and services similar to those for which the famous trade mark is. You will need to consult your legal advisor.

International trade marks

Australia joined the Madrid Protocol relating to international registration of trade marks on 11 July 2001.

The Madrid Protocol system permits international registration through a single international application to the trade marks office of the home country and permits protection in approximately 56 countries.

The Madrid Protocol is not the only way you can apply for a trade mark overseas. It is still possible to file an application directly with each country. There may be some circumstances where applying directly to a country of interest may be a better option than seeking international registration under the Madrid Protocol.

Some of the points you need to consider are whether:

1. The countries you are interested in are members of the Madrid Protocol;
2. You are eligible to file an international application under the Madrid Protocol; and



3. The scope of your Australian trade mark includes all the goods and/or services you wish to protect overseas.

The date of filing of the international application will have the same effect as a national filing in each of the designated countries. Where no refusal is notified, or if refusal is withdrawn in a designated country, the international registration has the same effect as a national registration in that country.

All fees may be paid either to IP Australia in Australian dollars at the time of filing the international application or directly to the international bureau.

Your lawyer will be able to calculate the relevant fees payable upon receipt of your further instructions.

Ownership of trade mark

Asset protection strategies involve generally the separation of asset owning entities from related entities that attract trading risk.

Generally, all assets, particularly intellectual property, should be owned by an entity separate to the trading entities with the intellectual property licensed back to the trader.

You will need to consider which entity is appropriate to own the trade mark before you apply for registration.

About the author

Terri Janke is the Solicitor Director of Terri Janke and Company Pty Ltd, a Sydney based law firm specialising in intellectual property. The firm's strengths are intellectual property (IP), trade mark portfolio management, commercial agreements, mediation and corporate governance. Established in April 2000, Terri Janke and Company is the leading international authority on Indigenous Cultural and Intellectual Property (ICIP). The firm is a Registered Supplier with Supply Nation. Visit www.terrijanke.com.au

How can we help you?

1. We can help you through the application process, from selecting the right name, to countering any opposition. Achieving registration can be a complicated process. While submitting an application may appear simple, there is great potential for barriers to arise along the path to registration. From selecting a name, to appealing to the Registrar, to countering oppositions to your registration proposal, we can help inform you of your rights, advise you on the process, and manage your application to registration.



2. We can assist you in the maintenance of your trademark. Your attention to your trade mark does not end upon registration. Trade marks require consistent supervision and maintenance. IP Australia does not monitor the marketplace, nor provide assistance in identifying or prosecuting infringement matters. Regular checks need to be undertaken to protect the insurgence of similar trade marks. Trade marks need to maintain active, as IP Australia will challenge inactive trade marks. It is critical that the trade mark be used/kept active by (or under the authority of) the trade mark owner. Failure to do so may result in the trade mark being removed from the Register of Trade Marks. Why not have us do it for you?

3. Is someone infringing on your trade mark? We can advise and act on your behalf in the event that a third party is attempting to register, or has registered, a similar trade mark in related goods or services.

4. Have you been accused of infringing another person's trade mark? We can advise and act on your behalf in the event that a third party claims your registration or proposed registration infringes their trade mark rights under similar goods or services.

5. Changing your trade mark, or wanting to add goods or services to your application, after details of the application have been published. Only very minor changes can be made to a trade mark once an application has been filed and published. No goods or services may be added after publication, so it's important you get advice before registration. It is not uncommon for applicants to list goods or services they do not actually trade in, or omitting the goods or services they do trade in. Trade mark registration is for the goods or services you *actually* trade in or *intend to trade in* within the near future.

Important legal notice

This paper provides general advice only in an effort to encourage constructive debate on the topic. It is not intended to be legal advice. If you have a particular legal issue, we recommend that you seek independent legal advice from a suitably qualified legal practitioner.

Contact Information

Terri Janke and Company Pty Ltd

Lawyers and Consultants

Our Knowledge: Your Future

PO Box 780

ROSEBERY NSW 1445 Australia

www.terrijanke.com.au

Phone: 61 (0)2 9693 2577 Fax: 61 (0)2 9693 2566 Em: tjc@terrijanke.com.au

