

THE BENEFITS OF REGISTERING A TRADE MARK

What is a Trade Mark?

Trade marks provide that extra measure of protection over your brand, deterring other people from using it and increasing your rights against those who infringe upon it. A trade mark is a registered symbol or words that are used to distinguish your goods and services from those of others. It is essential to protect your brand and distinguishes the goods and services that you provide in the eyes of consumers. A successful business is usually intrinsically associated with a valuable trade mark.

What can I Trade Mark?

You can register a trade mark over the following individual or combination of items:

- Logo
- Letter
- Number
- Word
- Phrase
- Picture
- Shape
- Sound
- Smell
- Aspect of Packaging



The more original or unique a trade mark is, the easier it will be to register. Something that is commonly used or likely for a competitor to use will be more difficult to register, such as a location or a common phrase. It must therefore be sufficiently different from other registered trade marks.

It goes without saying that once someone has registered a trade mark, you cannot register a trade mark over that same subject matter. Even if somebody has not registered a trade mark over their brand or logo, but has used that brand and gained a reputation in the market place, you may also be prevented from registering a trade mark over that brand or logo. There are also restrictions for trade marks over flags, emblems, official signs and armorial emblems. For example, there are restrictions on trade marks containing a representation of or association with the Royal Family.

The Selection of Goods or Services

When applying for a trade mark, you must select the category or categories of goods and/or services which you want your mark to cover, and provide a specification of each category. There are 45 categories to choose from. A poor description in the specification will not give proper protection. At Bywaters Timms we can help in selecting the appropriate categories and drafting a specification to sufficiently describe your goods and services. You cannot amend a trade mark description once it is registered, so it is good practice to invest in a professional to get this right in the beginning. You also will not be refunded the application fee if IP Australia refuses to register your trade mark.



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Warning—this article is only meant to give you general information and should not be relied on as legal advice. If you want more information then talk to one of our lawyers.

What does Registration Provide?

Registration of a trade mark means it becomes your personal and intellectual property. It gives the owner a legally enforceable right to use the trade mark, licence its use to others or sell it. An example of licensing is in franchising, where the franchisor who owns the trade mark provides franchisees a licence to use it in association with their franchised business. Licensing allows you to charge a royalty fee for the use of the trade mark, and gives you control over how the trade mark will be used.



Registration also gives the owner the right to prevent other people from using a similar trade mark in connection with the goods and services that your registration covers. When another person uses your trade mark it may be:

- a. an infringement of your rights under the *Trade Marks Act 1995*;
- b. passing off; and/or
- c. misleading and deceptive conduct under the *Competition and Consumer Act 2010*.

Trade mark registrations are published publicly online, making it difficult for someone who infringes upon your trade mark to claim that they lacked knowledge of your trade mark's existence.

Before you lodge your trade mark application you should have proper searches conducted by experienced professionals. It is not sufficient to just pop the name into the ASIC website, IP Australia or Google.

By registering your trade mark, the chances of someone else claiming that your trade mark infringes upon theirs will decrease. If IP Australia allows a trade mark to be registered which you believe is confusingly similar to your registered trade mark, then you will have strong grounds to oppose the infringing trade mark.

Registration lasts for a period of ten years beginning on the date of filing your application, after which you can renew it. The trade mark will only be registered in Australia. You may also register a trade mark internationally in selected foreign countries, helpful for when businesses wish to expand.

Be aware that if you trade over the internet to foreign countries you could potentially infringe on someone else's trade mark. If someone has a mark registered in that country and yours is too similar to theirs, then they may be able to bring infringement proceedings against you. If your trade mark will not infringe on that of another person, then it is advisable to register it in the countries you trade in.

To let people know that your trade mark is registered, it is good business practice to place the recognisable ® symbol next to your trade mark. Only registration gives you the legal right to do this, and it adds a level of professionalism to a business or product. Pending registration you can use the ™ symbol. Both ® and ™ can be used when the mark is registered but ® **must not** be used unless it is registered and misuse may attract a penalty of up to \$10,200.

Who can Apply for a Trade Mark?

An individual, company or an incorporated association can apply for a trade mark. An application cannot be made in the name of a business, therefore it should be made in the names of the individuals or company which owns the business.

The process:

1. Once the application and payment of the application fee is made to IP Australia, the trade mark application will be published on the Trade Marks database and can be searched on [ATMOSS](#).
2. IP Australia will then examine the trade mark.
3. If the trade mark passes examination, it will then be advertised in the Australian Journal of Trade Marks and will be open to opposition by the public.
4. If no objections are made to your trade mark, it will then be registered and you will be sent a certificate of registration, after payment of the registration fee.

The whole process takes approximately seven and a half months if all goes smoothly.

If international protection under the Madrid Protocol is sought for an Australian trade mark within six months of the Australian application, then the international application will receive the same priority date as the Australian Application. The priority date is the date of filing the trade mark, meaning the priority date of the international trade mark will be the same as the Australian.

Be mindful that your trade mark must be used after you have registered it, otherwise it may be removed from the register for non-use after three years. You cannot simply register a trade mark just to stop someone else from using it.

Scams

Trade mark owners and applicants need to be aware of the increasing levels of scams. People and overseas companies will possibly contact you and try to offer you services or request monies in relation to your trade mark. Some of these requests can look very official. You should not under any circumstances, pay any monies, respond to any companies or have anything to do with these fraudulent requests. You should only deal with correspondence from your lawyer or official correspondence from IP Australia. A recent example is a scammer impersonating WIPO (the World Intellectual Property Organization). This scammer markets itself as the World Intelligent Property Office and uses a similar logo and address to the real WIPO.



Conclusion

You do not have to register a trade mark in order to use your brand. However when taking into account the benefits of registration, it is highly recommended to do so. It pays to have that extra level of protection against competitors.

Remember, the more you do to protect your intellectual property, the more protection you will get.

If you would like more advice about registering or protecting a trade mark, please contact us to talk to one of our solicitors.