

Trade Marks



What is a trade mark?

A trade mark is a sign used, or intended to be used, to distinguish one trader's goods and services from the goods and services of other traders. The definition of a registrable trade mark includes common trade marks such as brand names, logos and slogans as well as more unusual trade marks such as colours, shapes, sounds and even scents.

How do you select a good trade mark?

Examples of good trade marks include invented words (eg KODAK), suggestive or emotive words (eg SUNSILK for shampoo) and arbitrary words (eg APPLE for computers). Names that are difficult to register include descriptive words, common surnames and geographical names.

The importance of searching

Before a trade mark is adopted, searches should be conducted to check whether anyone else has registered or is using a similar mark. If someone else has registered and/or commenced use of a similar mark, they may be in a position to object to the use of your proposed mark. It is important to search the Australian Trade Marks Register and general searches should also be conducted of the internet, company/business name registrations, the yellow pages etc.

How do you obtain a trade mark registration in Australia?

Applications to register a trade mark in Australia are filed with IP Australia (the government body incorporating the Patent, Designs and Trade Marks Offices). The application must include details of the trade mark, the name and address of the applicant and a statement of the goods and services to be covered by the application. Goods and services fall into different classes and the costs involved will depend on the number of classes selected. For example, wine falls in class 33 and clothing falls in class 25.

A flowchart illustrating the application process and the timing involved can be found overleaf. Standard trade mark applications are examined within around 3 months. IP Australia will then either issue a Notice of Acceptance or an adverse Examination Report objecting to the mark. Possible objections include objections based on the existence of conflicting earlier marks and objections raised against marks that are too descriptive. The Office allows a period of 15 months for an applicant to try and overcome any objections raised. It is possible to extend this period for up to 6 months by paying extension fees.

Headstart Option

The alternative to filing a standard trade mark application is to file a "headstart" request for a quick initial assessment of a mark. "Headstart" requests are assessed within 5-10 days and so any likely objections are identified very quickly. Once the "headstart" results are received, there is then a further 5 day period to decide whether to proceed with formally filing the application (in which case the application will then be formally examined within around 3 months) or to abandon the "headstart" request (in which case the details of the request will not be made publicly available).

Acceptance/Opposition/Registration

If/when an application is accepted by IP Australia, there is then a 2 month opposition period during which time third parties have an opportunity to object to the registration of the trade mark. Please refer to our information sheet on Australian Trade Mark Oppositions for further information in this regard.

If no opposition is filed, the application will proceed to registration and a Certificate of Registration will be issued. A trade mark is registered for an initial period of ten years but can be renewed indefinitely for further ten year periods (although keep in mind that, once a trade mark has been registered for more than five years, any third party can apply for cancellation of the trade mark if there has been no use of the mark in the preceding three year period).

Once a trade mark is registered the ® symbol can and should be used. For unregistered marks, the ™ symbol may be used.

How do you protect your trade mark overseas?

Additional searches should be conducted in the markets of interest before use of a trade mark is commenced overseas and applications to register the mark should then be filed in each of the relevant countries. Whilst it is not possible to file one application to secure "worldwide" protection, it is possible to file an application through the "Madrid Protocol" system to obtain trade mark protection in a number of designated countries. There are currently over 60 countries that are able to be designated by a Madrid Protocol Application with the costs involved dependant on the number of countries that are selected. For countries that are not members of the "Madrid Protocol" (for example, Canada is not a member), national applications must be filed with the Trade Marks Office in the relevant country.

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Our trade mark services include:

- Advising on the registrability of proposed trade marks
- Preparing and filing trade mark applications in Australia and also overseas
- Prosecuting trade mark applications through to registration
- Providing trade mark infringement advice
- Handling trade mark opposition matters and trade mark cancellation proceedings
- Filing domain name applications and handling domain name complaints

Trade Mark Application Process

