



## Protecting your brand – trademark

### 1. What is a trademark

A trademark distinguishes your business from others.

A trademark can be a distinctive word, phrase, sound, smell, shape, logo, picture, letter, aspect of packaging or a combination of these. However, it is not a business name, company or domain name. A trademark should also be differentiated from a patent (which is concerned with designs).

Common words, phrases and images may not be registrable if the word, phrase or image is ordinarily used to indicate the kind, quality, quantity, intended purpose, value, geographical region or some other characteristic of the goods and services to which your trademark is to be used in connection with. For example:

- CHOCOLATE for food
- ULTRA WHITE for paper
- MELBOURNE for a service business
- GLOBAL for transport
- 4WD for vehicles
- Drawings of exact goods
- Common surnames
- Official signs (such as flags, emblems)

### 2. Do I need to register a trademark?

It is not compulsory to trademark your brand name/logo, but by registering it receives protection against your competitors using it and gives you exclusivity. Trademark registration is the best form of brand registration available. It can provide and protect recognition of your brand, an investment for your business.

If someone else already has registered the same mark (or deceptively similar) as yours, they can object to your application or registration. Likewise, if somebody tries to register the same mark, you can object (if IP Australia has not already rejected their application in the initial stages).

It is a common misconception that by registering a business name, company or domain name, that you are protected. This is not the case.

### 3. How to register a trademark?

The initial step is to lodge the application with IP Australia. We can assist you with process.

Each application must be for a discrete name, logo or name and logo combination and must designate a class(es). There are 45 classes from which to choose (we can assist you with

identifying the appropriate class(es)), in which your trademark may be registered. The trademark should only be registered in class(es) in which apply to your business/product.

The *Trademarks Act* states that you must use or intend to use the trademark in relation to the goods or services of the class identified in the application.

The cost depends on the number of applications to be made. For example, if you wanted to register 5 trademarks in 3 classes, this is 15 applications. It is recommended to start with the most important marks in the most important classes, to keep the number of applications (and therefore the cost) down. For example, you could seek registration of:

- 2 marks in 2 classes which would be 4 applications; or
- 4 marks in 1 class, which would also be 4 applications.

The application fee charged by IP Australia per trademark is \$250 per class (as at the date of writing this document).

We can search the IP Australia database in advance of preparing the application to check there are no pending or registered applications which show up under the names of the proposed trademarks. This does not guarantee that the trademarks will be accepted for registration but simply that there are no other trademarks currently registered under that name. The database cannot be searched to establish whether there is a similar graphic under a different name.

If the application meets all the requirements, it will be accepted for registration. If not, IP Australia will send a report setting out any requirements that need to be addressed. This must be done within 15 months of such request.

The current waiting period from the time of filing an application and acceptance for registration of a trademark is 3 to 4 months.

After acceptance of the application for registration, the details of the application will be advertised in the Official Journal of Trade Marks. For three months after the advertisement date, anyone who believes that the trademark should not be registered may oppose its registration. If no opposition is filed against the application, the trademark will be registered.

#### **4. Once your trademark is registered**

Once the trademark is registered, it will be regarded as registered from the date that the application was lodged, not from that date it was examined or accepted. This is important as it provides early protection and possible priority over a subsequent application by a competitor.

Protection is only provided in the class in which the mark is registered and exactly as it is registered. It is recommended by IP Australia to use the ® (R) symbol next to your trademark once you have obtained successful registration.

You must use your trademark. If it is unused for a continuous period of 3 years, it is open to be challenged by anyone (including a competitor looking to take it over) and it can be removed from the register. This would mean you could use your right to that trademark.

The trademark is registered in Australia (only) for a period of ten years (from the original filing date) and continues indefinitely as long as the renewal fees are paid. A renewal notice will be provided by IP Australia to you. As such, you should ensure your address details are kept up to date with IP Australia.

If you require registration overseas, application must be filed directly with each country or by a single application (World Intellectual Property Organisation) nominating the (participating) Madrid Protocol countries.

All rates are accurate as at the date of publishing this information sheet and are subject to change without notice.

This information is intended as a guide only. For further information, feel free to contact Leanne Scott of Scott Legal on 03 9111 0078.

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