

Trade Marks Q&A

Updated July 2020

What is a trade mark?

A trade mark may be a word, device/logo, slogan, packaging get-up, product shape, colour, combinations of these, or indeed, almost any aspect of branding that serves to differentiate your products and services from those of your competitors. A well-chosen trade mark:

- distinguishes your products or services from others in the marketplace;
- is a memorable symbol for the reputation of your business and quality of your products and services; and
- is a symbol for the marketing messages made to your customers.

Why should I apply for a trade mark registration?

There are many reasons to seek protection of your trade mark, including:

- a trade mark application reserves the trade mark for your use while you are preparing for product /service launch;
- registration gives you the exclusive right to use the trade mark throughout the country and to stop others from using it or a similar trade mark in the same field of business;
- a registration is an easily enforceable right against misuse by competitors; and
- a registration can be a valuable asset and property right which may be licensed or sold.

What should I consider when choosing a trade mark?

It is important to choose a good trade mark, one that is registrable and confers strong rights.

Good trade marks are distinctive of your products and/or services and therefore registrable, including invented words such as "KODAK" and "XEROX", arbitrary words such as "APPLE" for computers or "SINGER" for sewing machines, and fanciful logos and devices.

Equally good are trade marks which have a positive connotation or convey information about the products in a suggestive way, but do not describe the products, for example "DURACELL" for batteries, "MICROSOFT" for computers or "CYCLONE" for fencing.

Weak trade marks which feature descriptive or generic words such as "NO FRILLS", "CLASSIC" or "LITE", or laudatory words such as "GREAT" or "BEST", are difficult to register and provide limited prospect of preventing competitors using the same trade mark.

Will my business name registration provide trade mark protection?

Confusion often arises between trade marks and business names. Selection and registration of a company name or business name is often the first step in the start-up phase for new businesses. While this step is necessary, it is critical to recognise that a company or business name registration does not protect that name or provide rights in the name.

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It is a common misconception that business and company names are “the same thing” as trade marks. They are quite different. Registration of a company or business name satisfies the legal obligations of carrying on business under that name. On the other hand, a trade mark is your “brand” - those words or devices by which customers identify your business and which distinguish your business from other products or service providers in the marketplace.

The words or phrases that make up your company or business name may be the same as your brand name/trade mark. Nevertheless, you still need to clear the name for use and registration as a trade mark. So while it remains very important to perform a business name clearance search, you also need to search the trade marks register.

What preliminary checks should I make?

Prior to adopting a new trade mark it is prudent to conduct searches of the Trade Marks Office database and marketplace at the earliest opportunity. We recommend searches be conducted before a trade mark is adopted or any significant costs are incurred for obtaining registration, preparation of artwork, website design, packaging or advertising campaigns.

A trade mark search will:

- reveal if use of your trade mark is likely to infringe a prior registered trade mark;
- determine if the proposed mark is available for registration; and
- assess whether or not the registration process is likely to be problematic (and therefore more expensive).

Additional searches for common law trade marks (trade marks which are in use but may not be registered) including searches of telephone directory listings, domain names, company and business names, internet searches and searches of industry publications and databases, should be undertaken to ensure there are no competing common law trade mark rights which may conflict with use and registration of your trade mark.

Our trade marks team is able to advise on appropriate search strategies in Australia, New Zealand and overseas, and provide an estimate of costs. Our search reports will give you a detailed analysis of the findings and options for resolving any potential conflicts.

What information is required for filing a trade mark application?

In order to file an application in Australia or New Zealand you will need:

- the full name and street address of the applicant, including incorporation details if the applicant is a company;
- a list of the products (goods) and/or services for which registration is needed. Goods and services are divided into 45 classes and we will assist you to prepare a specification listing the goods and/or services you will use in connection with the trade mark. The Nice Classification is available on our [Resources page](#);
- if the trade mark contains a device or logo, a clear black and white or colour representation is needed;
- if priority under the Paris Convention is to be claimed from an application initially filed in another country, details of the priority application are needed; and
- an English translation of any words included in the trade mark of a language other than English will be needed before acceptance, as will a transliteration of any non-Roman characters together with a translation of the words into English. Providing this information at filing may avoid issue of an examination report and associated costs.

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Under Australian and New Zealand practice:

- Multi-class applications are permitted.
- The Nice International Classification is followed.
- No Power of Attorney or Authorisation of Agent is required.
- No notarisation or legislation of documents is necessary.
- No certified copies of priority documents/applications are required.

However, many countries in Asia, South America, the Middle East and Pacific Island still require Powers of Attorney or Authorisations of Agent to be provided. Some of these countries also require these documents to be notarised and legalised.

What is the process and timeframe from filing through to registration in Australia and New Zealand?

Once a trade mark application is filed it is examined by the Trade Marks Office. This currently takes about 4-6 months in Australia, and about 1-2 months in New Zealand.

We can request expedited examination of an application in Australia if there are commercial reasons to do so (such as the imminent launch of the product, issues with a competitor, or an intention to use the Australian application as a base for filing an International Registration). If expedited examination is requested, an application will be examined in about 3-4 months.

If any objections are raised at examination we will report these to you, together with options and cost estimates to address the issues.

Once an application is accepted it is advertised for opposition purposes. During this period third-parties can oppose the registration of your trade mark. An application is open to opposition for a period of two months in Australia, and three months in New Zealand.

Assuming no serious objections are raised or oppositions received, the typically timeframe from filing through to registration is about 9-12 months in Australia, and about 7-10 months in New Zealand.

It is not possible to secure registration in less than seven months due to international agreements of which Australia and New Zealand are party.

A flowchart of the trade mark application process is available on our [Resources page](#).

How long does trade mark protection last for in Australia and New Zealand?

Trade mark registration lasts for ten years and is renewable every ten years, and may be retained indefinitely by paying the renewal fees.

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How do I apply for a trade mark overseas?

There are different systems for protecting trade marks overseas and we will work with you to develop the most appropriate global filing strategy depending on your business plans and budget.

The two main options are:

1. International Registration under the Madrid Protocol system – allowing you to file a single application designating the countries or territories of interest; and
2. Filing national applications in the countries of interest. For those countries that not member of the Madrid Protocol, national registration is the only route for protection.

Further information on protecting your trade mark overseas is available on our [Resources page](#).

Trade mark applicants may be able to defer the cost of filing overseas for up to six months, by claiming priority under the Paris Convention. The basic concept of the Paris Convention is that if an applicant files an application for a trade mark in a country, it can maintain that filing date as their 'priority date' in other countries provided applications are filed in those other countries within six months.

What can a trade mark attorney do for me?

The role of trade mark attorneys is to protect trade mark rights by providing advice, searching and registering trade marks, in Australia, New Zealand, and overseas. Trade mark attorneys also maintain the registrations, attend to renewal, conducting trade mark audits, and provide conflict, enforcement and infringement advice.

Trade mark advisors can provide valuable assistance at the time of choosing a trade mark, will provide strategic advice for searching and filing, and will simplify the registration process for you. They will also give guidance should you need to obtain registration overseas for export products and services. Expert assistance provides peace of mind.

Our trade marks team is available to provide a full range of trade mark protection and portfolio management service including:

- Brand creation and selection advice
- Trade mark strategy and pre-filing advice
- Trade mark clearance searches
- Trade mark filing, prosecution and registration
- Trade mark opposition, non-use removal and revocation proceedings
- Negotiation and settlement of trade mark disputes
- Enforcement and infringement advice
- Trade mark renewals and post-registration maintenance
- Trade mark watching and monitoring services
- Due diligence, audits and portfolio reviews
- Domain name disputes
- Labelling and regulatory compliance advice
- Customs watch programmes.

Disclaimer: This document is general in nature, and must not be relied on in lieu of advice from a qualified professional in respect of your particular circumstances.