

# Trade Marks

## What is a trade mark?

Your trade mark is the unique way for your consumers to identify the nature, quality and origin of your products or services. It's not only your name or just your logo, a trade mark can include a letter, number, word, phrase, sound, smell, shape, logo, picture, movement, aspect of packaging, or some combination of these elements.

Other features you can protect with a registered trade mark include your slogans, catch-phrases, jingles, distinctive colour schemes, or even Twitter hashtags.

## Your name is not enough to protect your brand - online or off

Business owners should be aware that a business name, company name, or domain name provides only limited protections. Registration of a trade mark provides:

- the exclusive legal right to use, licence and sell your mark in Australia;
- protection of the identity of your goods and services, and prevents others from imitating your brand;
- legal protection and enables you to stop others trading with it;
- rights of enforcement against other traders who use a mark deceptively similar to yours.

For example, if you trade mark a Twitter hashtag, you have greater control of online promotions whether it's conducted via the Internet, social media, digital streaming, mobile or other smart devices.

Our senior trade mark lawyer was the first legal practitioner in Australia to successfully register a Twitter hashtag trade mark for a client.

If you are interested in protecting specialist or specific branding (online or traditional) with a registered trade mark, you can get in contact with our team by email on [ip@ablawyers.com.au](mailto:ip@ablawyers.com.au) or call **1300 565 846**.

## ? What do the trade mark symbols mean?

There are two symbols commonly in use. The major difference between the two is how it relates to your rights of enforcement.

TM	All this means is that you are using your trade mark. It has <b>not</b> been registered.
®	This symbol means your trade mark is registered by IP Australia under the <i>Trade Marks Act 1995</i> . A registered trade mark can provide legal protection and enable you to stop others trading with it.

## 🔑 What are the advantages of registering a trade mark?

By registering your trade mark, you can:

- turn it into a valuable asset when you value or sell your business;
- sell your registered mark or license the use of it to another;
- protect your brand throughout Australia;
- more easily and quickly stop others from using your it.

A registered trade mark has the added legal protections of the provisions of the *Trade Marks Act 1995*.

## 📝 Applying for a trade mark

If you decide to apply for registration of your trade mark, you must describe your goods and/or services in your application. Unfortunately, there are 45 classes for goods and services and many possible 'claims' (the legal term for descriptions of goods and services) within each class. In order to protect your business, you must submit an appropriate claim. If your claims are false or inaccurate, your application risks encountering problems and ultimately, your mark may risk removal for non-use.

## ⚙️ The registration process

IP Australia examines your application to ensure you have met its basic filing requirements and to confirm your trade mark is registrable. If accepted, IP Australia will publish your trade mark in the *Australian Official Journal of Trade Marks*. Interested third parties then have two months within which to oppose your mark on specific legal grounds.

Once registered, you have the exclusive legal right to use, license and sell your trade mark in Australia for 10 years commencing on the submission date of the trade mark application. To continue registration a mark may be renewed every 10 years.

## 🛡️ Infringement

Infringement of your registered trade mark occurs if a person uses 'a trade mark' that is *substantially identical* with, or *deceptively similar* to, your mark in the same or similar goods or services class in which yours is registered.

*Substantially identical* - This test is a side-by-side comparison taking into account the similarities, differences, essential features and the total impression of resemblance between the marks.

*Deceptively similar* - When a mark so nearly resembles another it is likely to deceive or cause confusion.

## ⚖️ Legal Action

If you wish to enforce your trade mark rights your best first step is to notify the alleged infringer (by way of a letter) indicating that they are infringing your rights.

If you wish to take matters further then you are at liberty to commence action against the alleged infringer. A court may grant an injunction, damages or an account-of-profits.

If infringement is proven, a permanent injunction will be put in place to prevent the infringer from undertaking any further infringing conduct. The infringer will not be able to continue their conduct without a licence to do so from you.

Damages compensate the owner for losses suffered as a result of the infringement.

Where the infringers have sold or benefited financially from the infringing goods, the court may order that they pay you a sum equivalent to the profits they made from using your trade mark.

### How we can help

Often your best approach when looking to apply for a trade mark is to seek expert legal advice. Our team of experienced lawyers can help you with the process of trade mark registration by:

- searching the Trade Mark Register, ASIC records, Domain names and Google;
- submitting an application for your trade mark in one or more classes;
- providing step-by-step progress reporting;
- notifying you of likely conflicts, registered or unregistered;
- providing legal advice on potential consequences of conflicts;
- providing legal advice on best options to overcome any requisitions or issues raised by IP Australia.

Contact us on **1300 565 846** or **[ip@ablawyers.com.au](mailto:ip@ablawyers.com.au)** for a complimentary discussion on your IP needs and set yourself up for success.