

FILING A TRADE MARK APPLICATION IN AUSTRALIA

Why register a trade mark?

Under Australian law, trade mark rights arise in two ways:

- (a) by registration either by way of a national application; or an application for registration of an International Trade Mark designating Australia under the Madrid Protocol; and/or
- (b) at common law once there has been sufficient use of the trade mark to give rise to the requisite level of reputation.

While Australian law does recognise trade mark rights arising through use of the trade mark (known as “common law” rights), these rights are limited and generally far more difficult to enforce. In order to enforce common law rights, it is necessary to be able to establish a sufficient level of reputation (which is acquired through use of the trade mark in the relevant market) in order to establish a claim for passing off. There will usually be a significant time delay between the commencement of use of a trade mark and the ability to establish a sufficient reputation in the trade mark and a trade mark owner will not have significant rights in their trademark in this interim period. Further, such rights may also be geographically limited.

Trade mark registration provides broader protection of the trade mark and the protection extends throughout Australia. Registered rights are also far easier and significantly less expensive to enforce.

A trade mark registration provides the registered owner with a monopoly right, that is, registration confers exclusive rights on the owner of the registration in a competitive marketplace.

A registered trade mark also constitutes an asset which can be bought and sold or licensed to others. Trade mark registration provides a basis for the grant of a licence to others to use the trade mark and is an essential part of any franchising strategy. Trade mark licensors/franchisors have a duty to protect the interests of their licensees and franchisees. In the absence of registration, it may be difficult to attract licensees and franchisees and justify the payment of licence/franchise fees.

What is registrable subject matter?

The Australian Trade Marks Act provides a broad definition of what can be registered as a trade mark. This includes:

- any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent.

For trade marks containing graphics, there may also be copyright issues to consider. If the graphics were created by a contractor or any person other than an employee, a copyright assignment should be obtained. Under Australian law, in order to obtain a valid assignment of the copyright, the assignment must specifically assign the copyright and must be in writing. In the absence of the above, mere payment for the work is insufficient to transfer the rights to the copyright in the work.

Minimum Filing Requirements

The minimum filing requirements to obtain a priority date in Australia are as follows:

1. Applicant's name and address.
2. Trade mark details including electronic copy of a device in jpeg or tiff format.
3. Statement of Goods/Services.
4. Priority details if the application is a Convention Application.

No power of attorney or authorisation of agent is required.

Requirements for Registrability

Broadly, in order to be registrable as a trade mark, a trade mark must be distinctive within the meaning of the Australian Trade Marks Act and must not conflict with earlier trade mark rights.

Distinctiveness

There is a threshold level of distinctiveness for registration of trade marks in Australia.

A trade mark must not be directly descriptive of the goods or services on which the mark is to be used or of a kind which other traders would legitimately wish to use in the course of trade in respect of their similar goods and/or services.

Intent to Use

The applicant is required to have an intention to use the trade mark in Australia although no declaration or form is required to be filed for this purpose. Lack of intention to use is a ground of opposition. Lack of a bona fide intention to use a trade mark is also a ground for removal of a registration.

Conflicting Trade Marks

It is important to conduct searches for conflicting trade marks prior to commencing use or applying for registration:

- (a) to ensure that use of the trade mark does not infringe earlier trade mark rights; and
- (b) to assess the merits of the application for registration.

Under the Trade Marks Act, the test for conflicting trade marks for the purpose of infringement and registration is not simply whether there is an earlier identical trade mark but whether the trade marks are substantially identical or deceptively similar in connection with goods/services which are the same, of the same description or closely related. In general terms, if the marks are likely to be confused with each other, they conflict with each other.

Registration Process

The application is a very important document in the registration process as it determines the scope of protection and establishes a priority date. It is not possible to make substantial changes to the trade mark after filing or to broaden the scope of protection by adding goods and services. Therefore, considerable care should be given to the goods and/or services to be covered in the application.

Examination

Applications are typically examined within approximately 3-4 months. It is possible to request expedited examination in certain circumstances, for example where there is infringement or potential infringement or other urgent reasons. However, it is necessary to provide justification for this. Accordingly, the request must be accompanied by a statutory declaration setting out the reasons for the request. In most cases, Convention applications are also generally examined as a priority. Due to the 6 month time difference between the priority date and the filing of these applications, the Trade Marks Office attempts to identify any potential conflict between these and other trade marks as soon as possible.

The Australian Trade Marks Office conducts substantive examination and examines each application on its merits. If there are any objections to the application, an Examiner's report is issued identifying the objections to registration and/or other deficiencies in the application. The objections can range from relatively minor formalities issues to more substantive objections that the trade mark is not sufficiently distinctive or conflicts with an earlier trade mark registration or application, or that the application does not satisfy one or more of the other specified criteria.

An Applicant is then provided with an opportunity to respond to any objections raised by the Examiner in the first report. The response may be by way of written submissions or arguments contesting the objections and/or proposed amendments to overcome the objections.

In the event that there are no objections to registration of the application, the application will proceed straight to acceptance.

Trade mark applications which designate Australia under the Madrid Protocol are examined according to the same criteria as trade mark applications filed directly at the Australian Trade Mark Office.

There is 15 months from the date of the Examiner's first report to meet any requirements identified by the examiner and to secure acceptance of the application. If more time is required, it is possible to request up to another 6 months, providing the request and payment of the relevant fees is made before the deadline specified in the Examiner's report. Further extensions beyond 6 months will only be granted in special circumstances.

Publication

Details of an Australian application are typically available on the IP Australia database within a few days of filing. Accordingly, details of the application are usually in the public domain within a few days of filing.

However, in the case of trade mark registrations filed under the Madrid Protocol which designate Australia, details of the corresponding Australian application may not be available until forwarded to IP Australia. Accordingly, these trade marks will not be available on the IP Australia Trade Marks Office database until after the details have been received and entered onto the database.

Further under the Paris Convention, it is possible for an application to be filed in a member country up to 6 months after the original application and claim priority from the country of first filing. These applications will not be available on the IP Australia Trade Marks Office database until after they have been filed and entered onto the database.

During examination, the Trade Marks Office considers the merits of the application and if any objections to the application are raised, an Examiner's report is issued. The objections can range from relatively minor formalities issues to more substantive objections on the basis of insufficient distinctiveness or conflict with earlier registered or pending trade marks.

An Applicant has an opportunity to address these objections in a written response which is lodged at the Trade Marks Office. The response can include written submissions or arguments contesting the objections and/or proposed amendments to the statement of goods or services to overcome the objections.

In the event that the Trade Marks Office has no objections to the application, the application will proceed straight to acceptance.

Acceptance and Advertisement

When an application is accepted, it is advertised in the Official Journal of Trade Marks for opposition purposes.

Opposition

Once advertised, the trade mark application is open to opposition by any interested party for 3 months from the date of advertisement. The grounds of opposition will depend on the facts of the particular case.

It is possible to obtain an extension of time to formally oppose a trade mark application in certain circumstances. A request for extension of time must be filed before the opposition deadline expires.

IP Gateway has particular expertise in conducting opposition proceedings and the practice and procedures before the Australian Trade Marks Office. If you require further information in relation to opposition proceedings or questions in relation to a particular case, please let us know.

Registration

Assuming that no opposition is filed, an application will then proceed to registration following payment of the registration fees. The Applicant has 6 months from the date of advertisement in which to pay the registration fees. This deadline cannot be extended.

The entire procedure, from filing an initial trade mark application to grant of the registration, typically takes a minimum of 7 months if no objections are raised during examination. However, the registration process may take longer if objections are raised as additional time will be required for the preparation and filing of submissions. In some cases, evidence may be required in order to overcome objections on the basis of insufficient distinctiveness or conflict with earlier trade marks.

Renewal fees

Once registration has been granted a trade mark is registered for an initial term of 10 years from the initial filing date. A trade mark registration may be renewed indefinitely for further 10 year periods upon the payment of renewal fees.

It is important for the due dates for payments of these fees to be monitored in order to avoid loss of valuable rights.

Use of Trade Marks

Products covered by the application should preferably be marked as follows:

- For unregistered trade marks including pending applications for registration the symbol TM should be used.
- Once the trade mark has been registered, then the © symbol or a footnote "Registered trade mark" should be used to indicate that the trade mark is registered.

Where a trade mark is used under licence the following marking should be used:

- "Manufactured/Distributed (as applicable) by (name of company) under licence/authority of (name of trade mark owner), owner of the trade mark(s) (details of trade mark(s))."
- The marking of products in this manner is recommended as it places the public on notice as to the existence of registered trade mark rights.

In Australia, the above is important in a claim for damages or a claim for an account of profits in court proceedings as it assists in arguing that the infringer had constructive notice of the earlier trade mark rights. In certain other jurisdictions, marking is essential in order to recover damages.

Use it or Lose It

Once a trade mark is registered, it is important to continue to use the trade mark in the form in which it is registered. Under the Australian Trade Marks Act, if a trade mark is not used for a continuous period of 3 years, the registration will become vulnerable to removal or partial removal for non-use.

Similar legislation applies in many other jurisdictions. In certain countries, it is necessary to be able to prove use in order to maintain and/or enforce registered rights.

Infringement & Enforcement of Trade Mark Rights

It is important for trade mark owners to be vigilant in protecting their trade mark rights. Delay in acting against infringers may prevent the trade mark owner from obtaining certain remedies such as a preliminary injunction. Further, a failure to take action against infringers over a substantial period may eventually lead to the creation of co-existing rights as the trade mark owner may be taken to have acquiesced in the use of the trade mark by the later party. This ultimately leads to dilution of the rights of the existing trade mark owner.

Infringement & Registrability Searches

We strongly recommend conducting searches in relevant territories before commencing use or registration of a trade mark in any market. While brand extension can be a very successful way of introducing new products or entering new markets, we recommend that careful consideration be given before expanding use of a trade mark into new markets or expanding the range of goods or services on which a mark is used. It cannot be assumed that the trade mark is available in the new territory or that the trade mark is available in relation to the extended product range.

Searching of the mark to be used, and preferably also registration well in advance of commencing use in any particular territory is even more important where there is significant expenditure or lead time involved in entering any new market. Many territories do not recognise rights arising through use. Once goods are on the market, there is a risk that another party may file an application for the same mark and may secure rights to the trade mark. In some cases, by filing an application the later party may secure better rights to the trade mark or a conflicting mark and may then be able to exclude the original user from that market.

Although the Australian Trade Marks Office does conduct a search during examination, this cannot be considered to be exhaustive and does not guarantee registration. In many cases, a trade mark is accepted by the Trade Marks Office and then subsequently opposed by the owner of a similar trade mark in respect of similar goods and/or services.

IP Gateway utilises leading edge trade mark search facilities and databases to search for earlier conflicting trade mark rights and reduce the risk of encountering earlier conflicting rights.

Searches are subject to the following limitations:

- In many jurisdictions, there is a delay before newly filed applications are entered and are available for searching. This includes applications filed under the Madrid Protocol. Details of the national application may not be available for searching until forwarded to the relevant national office and entered onto the database. Any such delay is beyond our control.
- Under the Paris Convention, it is possible for an application to be filed in a member country up to 6 months after the original application which claims priority from the country of first filing. These applications will not be available for searching purposes until after they have been filed and entered by the relevant national office.

- In some jurisdictions, trade mark rights arise through use. These are unregistered rights and will not be located in a search of the relevant official Trade Marks Office database records.

Watches for Conflicting Trade Marks

For the reasons set out in this brochure (See Section on Enforcement), it is important for trade mark owners to be vigilant in protecting their trade mark rights. It is possible to maintain watches for conflicting trade marks. We also recommend maintaining watches for conflicting trade marks in Australia and any other markets of interest. If any further information is required or you have any questions, please contact us.

Registering Trade Marks in other countries

Trade Marks are generally granted on a national basis. There is no such thing as a worldwide trade mark although there are some regional registrations, for example, the European Community trade mark.

Protection may be secured by way of separate national applications in each of the countries of interest or by filing an application for registration of an International Trade Mark under the Madrid Protocol.

If Convention priority is to be claimed in the overseas application(s), the application(s) must be filed within 6 months of filing the original application. A Convention application enables the Applicant to claim the benefit of the filing date of the original or first filed application in Australia.

International Trade Marks

INTERNATIONAL TRADE MARK REGISTRATIONS

Madrid Protocol

Australia recently became party to the Madrid Protocol which allows businesses to register trade marks internationally in a cost effective way. An international Madrid Protocol trade mark registration is a valuable tool to those businesses who need to protect their valuable trade mark(s) in the US, Europe, Asia and Africa.

Applications to register trade marks through the Madrid Protocol are lodged through the Australian Trade Marks Office acting as a Receiving Office for the International Bureau in Geneva. Every application must be based on an Australian trade mark application/registration and is filed in English. A basic application fee is payable as well as a designation fee for every country in which the International Application is to have effect. A Certificate of Registration is usually issued by the International Bureau within six months of filing the application. The designated countries are listed on the Certificate of Registration.

The trade mark application is then forwarded to every designated country where it is examined, accepted if no objection is raised, advertised and registered. Renewal fees are payable every ten years but only to the International Bureau and not to each individual country in which the mark is registered.

New countries may be added at any time with the payment of the basic application fee and the designation fees.

A Madrid Protocol trade mark registration offers a streamlined registration process resulting in considerable cost savings in foreign agency fees, translation costs and administration fees over the system of filing individual foreign applications.

Further advantages of the Madrid Protocol are as follows:

- A single application is lodged through the Australian Receiving Office designating as many as 73 overseas countries resulting in considerable savings in regards to foreign agency fees.
- There is no need for costly translations from and into the official language of every designated country. The applications are lodged in English. Correspondence

is directed through the International Bureau in the language in which the application has been lodged.

- The more countries designated at application stage, the cheaper the cost to register an international trade mark. The application fees are comprised of a basic fee and a designation fee for each of the preferred countries.
- A fresh Madrid Protocol trade mark registration based on an Australian trade mark application/registration can be lodged at any time to add any number of countries in order to complement marketing plans and expansion into new overseas countries.
- If an adverse examination report issues in any one of the designated countries, the Applicant has the choice of either appointing an Agent in that country to prosecute the application through to registration,

or

- the Applicant may withdraw the application from that specific country without any adverse effect upon its Madrid Protocol trade mark registration in other countries.

Disadvantages

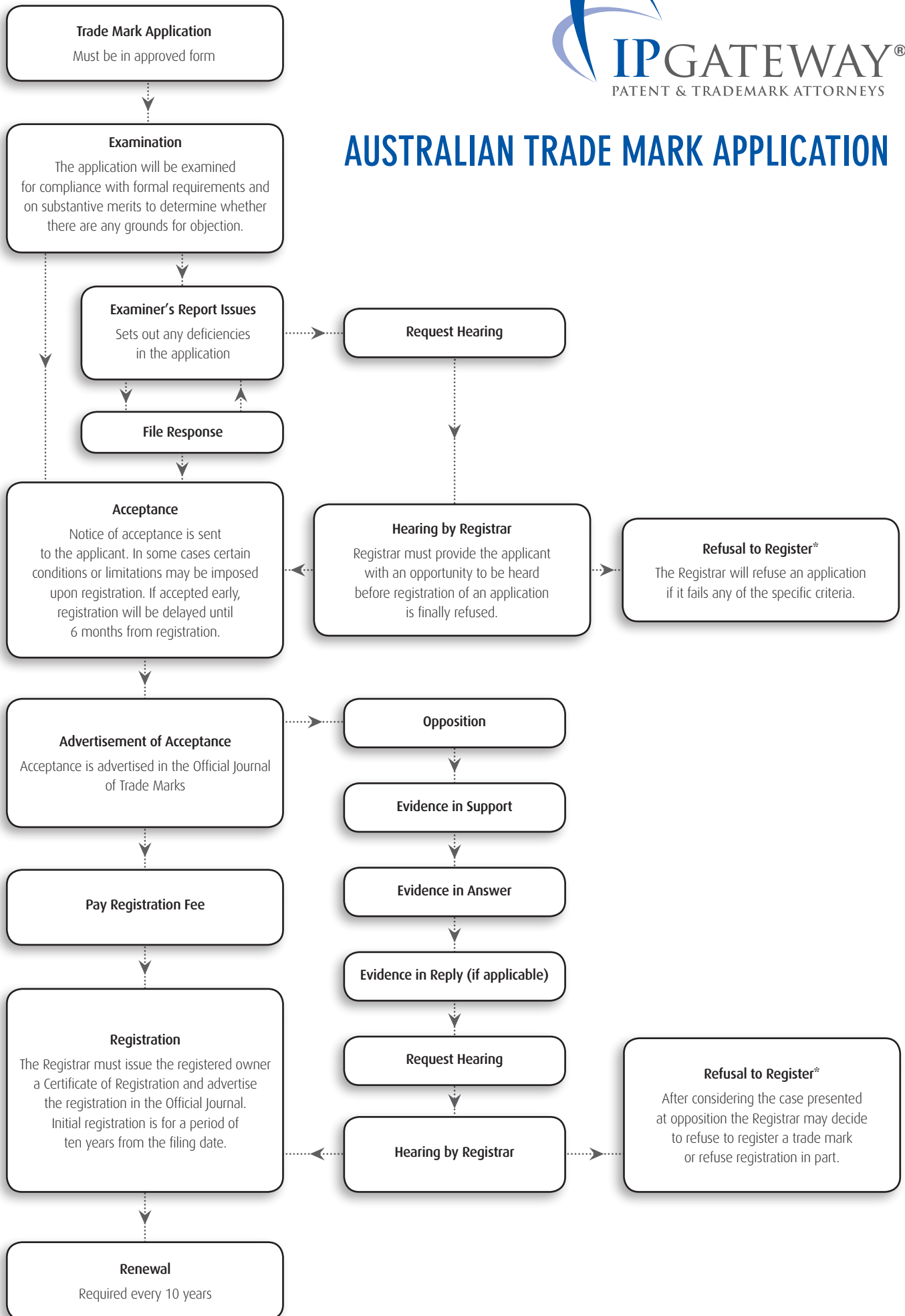
- An International Application is dependent on one or more home registrations/applications for the first five years. Due to the above dependence on the home registration/application, cancellation or restriction of the home registration/application will lead to corresponding cancellation or restriction of the International Registration/Application.

Requirements

- The Applicant has to be either an Australian national, or domiciled in Australia or have a real and effective commercial or industrial establishment in Australia.
- A basic Australian trade mark application/registration on which the International trade mark application can be based.
- The basic application(s) must cover all the goods and/or services claimed in the International Application.

For further information or questions on overseas trade mark applications please do not hesitate to contact us.

AUSTRALIAN TRADE MARK APPLICATION



*An appeal may be made to the Federal Court against the decision of the Registrar



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