

# Protecting Your Trade Marks

January 15, 2020

Advantage Partnership Lawyers



## Examples of well-known trade marks:

- QANTAS and the flying kangaroo



- McDonalds golden arches



- The Lonely Planet logo



- The Coca Cola logo



- The Starbucks logo



## What is a trade mark?

A trade mark is a sign that is used to uniquely identify the goods and services of your business from those of another. A

A trade mark can be a letter, number, word, phrase, sound, smell, shape, logo, picture, aspect of packaging or any combination of these.

A registered trade mark is legally enforceable and gives you exclusive rights to commercially use, licence or sell it for the goods and services that it is registered under.

## Why should I have a trade mark?

A trade mark is your identity – a way for you to distinguish your goods and services from those of competitors and show your customers who you are.

Trade marks allow consumers to find your products and connect with them. They can be used to educate customers about the quality of your products, and the reputation and history of your business.

If you want to establish a brand for your product or service, you should consider creating a trade mark. A trade mark can be your most valuable marketing tool.



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## FAQ

**Q: I've registered my business name. Do I still need to register my trade mark?**

A: Yes. A registered business name is not the same as a registered trademark. The two systems are entirely separate and do not affect each other.

**Q: Do I need to register all of my trade marks?**

A: Look at all of the trade marks that your business uses and consider whether or not some or all of these trade marks should be registered. Your long term objective should be to register all of your important trade marks. To determine which your important trade marks are, think about this – what damage would it do to your business if you were required to stop using that trade mark overnight or if a competitor were allowed to commence using that trade mark overnight?



## Do I need to register my trade marks?

It is possible to protect a trade mark without registration. *However*, you must have proof that you have built up a reputation in the trade mark to such an extent that use of the trade mark by someone else would be misleading.

Proving reputation or the likelihood that consumers would be misled or deceived is often very difficult. You do not want to risk wasting all the time, effort and money that you have put into establishing your trade mark and educating the public to connect it with your business.

Therefore, it is a good idea to register your trade mark **before** you go to the time and effort in establishing reputation in the trade mark.

## What are the benefits of registration?

Registration is beneficial for a number of reasons:

- A registered trade mark is infringed without having to show that consumers are likely to be misled or deceived. It is not necessary to show that you have reputation in the registered trade mark.
- A registered trade mark is automatically infringed when someone uses the same or similar trade mark in respect of the same or similar goods and services.
- If people see your trade mark on the register, they are likely to choose a different trade mark. This reduces the risk of being pushed out by a competitor, or even by accident.
- Registered trade marks can be sold or transferred without having to sell the whole business. In other words, your trade mark will have value.

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## How do I register my trade mark?

You can apply for a trade mark online using IP Australia's eServices. As well as paying the required fee, you will also need:

- The name and contact details of the applicant
- A representation of the trade mark
- Nomination of the relevant classes
- A description of the goods and/or services to which the trade mark will apply
- A translation of any part of your mark that is in another language.

## How do I protect my registered trade mark?

To protect your trade mark, you should regularly monitor the Australian Official Journal of Trade Marks to ensure that trade marks similar to yours are quickly identified.

The procedure for opposing a trade mark application consists of two mandatory elements:

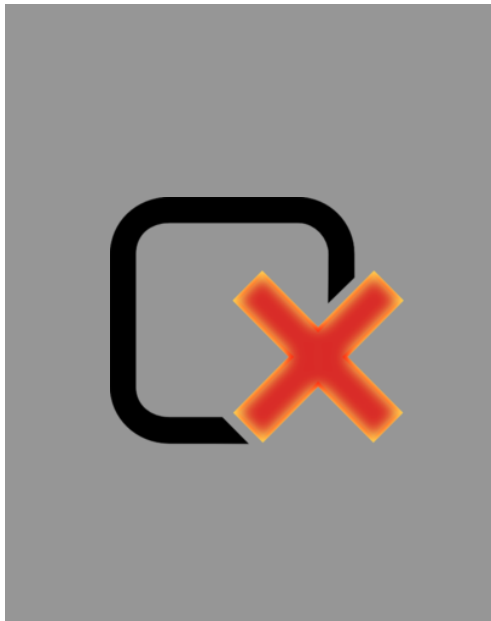
1. A "Notice of Intention to Oppose" must be filed **within two months** of advertisement of acceptance in the Australian Official Journal of Trade Marks; and
2. A "Statement of Grounds and Particulars" (SGP) setting out the grounds of opposition must be filed **within one month** of filing the Notice of Intention to Oppose. The grounds must be "adequate" and supported by material facts.

Note that extensions of time will only be granted in very limited circumstances. The Registrar has the power to dismiss your opposition proceeding if you do not comply with your obligation to file a SGP within the time period.

## How do I defend my application to register a trade mark?

If your application to register a trade mark is opposed, you are required to file a "Notice of Intention to Defend" **within one month** of receiving a copy of the SGP.

If you **do not** file a Notice of Intention to Defend, your application for registration will lapse. Lapsed applications will be treated in the same way as discontinued or dismissed applications.



**"YOU NEED TO PROTECT YOUR TRADE MARK RIGHT FROM THE BEGINNING"**

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## How can we help?

We can assist you at any stage of registering, opposing or defending a trade mark application.

We can help you to:

- Regularly monitor the Australian Official Journal of Trade Marks to ensure that trade marks similar to yours are quickly identified;
- Carefully consider whether there are adequate grounds of opposition in order to file an SCG;
- Ensure that both the Notice of Intention to Oppose and the SGP are filed within the prescribed time frames;
- Act promptly to defend your trade mark in any opposition proceedings, beginning with filing a Notice of Intention to Defend within the specified time limit.

Please contact our office on **02 9221 7555** or **legal.one@advantagepartnership.net** to discuss your trade marks further.



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