

Trade Mark Information Sheet

GENERAL INFORMATION REGARDING TRADE MARKS

This information sheet is intended to provide a brief explanation as to obtaining an Australian Trade Mark and is intended as general guidance only. It is not meant to be a substitute for obtaining advice and, if you have a query, you should contact us for advice. There are many advantages in using the services of CHRYSILIOU IP, such as the comfort in knowing that you have some of the most experienced attorneys available acting for you and in having our Firm permanently recorded as the address for service as a notice to others that your rights will be protected and enforced (see later).

- **Who may apply to register a Trade mark**

Only the owner of a trade mark may validly apply to register a mark. In most cases, the owner of a mark in respect of the goods or services of interest is the first person who uses the mark in the course of trade in Australia in respect of those goods or services or the first person to apply to register the mark in respect of those goods or services in Australia, whichever occurs first.

- **Registrability**

Only trade marks that are distinctive or capable of becoming distinctive marks may be registered. Marks which lack an inherent capability to distinguish may still be registered if the Applicant shows that the mark is qualified for registration by use or other special circumstances.

In certain circumstances trade marks which consist of shape, colour, sound or scent can be registered, but they must be accurately described and be capable of being represented graphically.

Registration gives the registered proprietor the right to exclusive use of the mark in respect of the goods or services for which it is registered and for goods and services similar to those for which it is registered.

Marks which may not be registrable, unless presented in a distinctive manner, or subject to extensive use, include common surnames (e.g. SMITH) significant geographical names (e.g., SYDNEY) and words which have a significant reference to the character or quality of the goods or services (e.g. CALMS for motion sickness pills). Initials or letters (less than three) are also generally unregistrable unless they form a pronounceable word or have had extensive use. Marks basically consisting of numerals only are also generally unregistrable, unless they have had extensive use.

Words or terms which are common to the particular trade are also generally not registrable, since all traders have a right to use them.

It is always advisable to seek the advices of the Chrysiliou IP Trade Mark Attorney team as to whether your trade mark is registrable or how to meet the requirements for

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registration. Often, rights can be lost by not having the best available professional advice.

- **Lodging an Application**

The Trade Marks Register is divided into 45 classes. If you wish to register a mark in respect of goods or services falling in more than one class, a single application may be made. There are additional fees for each class specified after the first. If you wish to register more than one mark for the same goods or services, separate applications must be made. If a series of similar marks is to be registered, an application for the series can only be in respect of a single class. Thus, for multiple classes, multiple applications are required for a series of marks.

It is important to draft a specification of goods or services which will adequately and validly protect your interests and again the proper professional advice at the lodgement stage can safeguard your interests in the long term.

It is a requirement for making a valid application that the Applicant is using or has an intention to use the mark in relation to the specified goods or services. If there is no intention to use the mark when filing the application, and no use commences, any registration may be subject to removal upon application by a third party if the lack of intention to use can be proven.

- **Infringement**

Infringement of a registration occurs if the mark, or one substantially identical or deceptively similar to it, is used in relation to goods or services within the specification in the registration. Infringement also occurs where the mark is used on goods or services not within the specification but which are of a “similar description”, but a special defence is available if no deception or confusion results. Always seek the advice of the Chrysiliou IP Trade Mark Attorney team in preparing enforcement programmes and preventing unauthorised use of your trade marks or marks that may be deceptively similar thereto.

- **Examination**

A trade mark application must be examined by the Trade Marks Office before it can be registered. If objections are raised, an examiner's report issues.

When the application is examined, the Examiner must determine if the mark is capable of distinguishing the Applicant's goods or services and also if the mark will conflict with earlier registrations or applications made in respect of similar marks for similar goods or services. If objections are raised on the basis of earlier marks, it may be necessary to argue or to restrict the goods or services of the application to avoid the conflict. This is just one area where the expertise of the Chrysiliou IP Trade Mark Attorney team will assist us to achieve the best possible result. In some cases, evidence of use may need to be filed to overcome an official objection.

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After an Examiner's report has issued, a period of 15 months is allowed to place the application in order for acceptance. At the expiry of this 15 month period, it is necessary to request and pay for extensions of time, otherwise the application lapses. A total of only six months extensions may be obtained, unless "special circumstances" justify further extensions.

Once objections are overcome, acceptance of the application is published in an Official Journal. Third parties have three months from publication of acceptance to oppose registration of the mark. If no opposition is lodged then the mark will be registered, subject to payment of a registration fee.

- **Duration**

An Australian Trade Mark registration has an initial term of 10 years from the filing date. It may be renewed indefinitely for periods of 10 years each, subject to a payment of a renewal fee for each period. During this 10 year term, CHRYSILIOU IP maintains itself as the address for service of any notices or proceedings (at no charge to its clients) to ensure that any notices or proceedings served upon us are properly actioned and your interests protected. Also, it is a warning to the public that your interests are being protected by our Firm.

- **Non-Use**

Generally, if a trade mark is not used in a three year period, it may be removed from the Register on application by a third party. However, a non-use action cannot be brought until five years after the filing date of the trade mark application. If your trade mark becomes liable to a non-use action, you should contact the Chrysiliou IP Trade Mark Attorney team for guidance and advice as to how to safeguard your position.

- **Searches**

Before using and applying to register a mark it is advisable that a search of at least the Trade Marks Office data-base is conducted to determine if the mark will infringe any existing rights given by any Trade Mark Registrations and also to determine if the mark is registrable. Searches need to be properly conducted and the Chrysiliou IP Trade Mark Attorney team has established search strategies which include looking for deceptively similar marks in a wide range of classes related to those of actual interest.

It should be noted, however, that use of an unregistered mark by third parties can give rise to common law rights which may limit or prevent use of the new mark. Consequently, a search of the Trade Marks Office data-base cannot give a complete indication of the availability for use or registration of a mark. Although there are some other additional searches which can be conducted, it is advisable for Clients to conduct a search in the market place to determine if there are any common law rights which may be infringed.

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- **Foreign Applications**

CHRYSILIOU IP has an extensive network of foreign associate attorney firms with which it works to ensure that Clients' interests are properly protected in each jurisdiction covered under the CHRYSILIOU IP foreign protection programme.

Applications to register a trade mark may be made in foreign countries at any time. However, if a foreign application is made in certain countries within six months of the date of filing of an Australian application, the priority date of the foreign application is that of the Australian application. The priority date is the date on which the application is tested for conflict with earlier marks. A similar situation applies to applications filed in Australia based upon an application filed in certain overseas countries up to six months prior to the filing of the application in Australia.

Most countries follow the same classification system as Australia. Some require separate applications for each class, while others allow multi-class applications. Most countries have an examination procedure.



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GENERAL INFORMATION REGARDING FILING TRADE MARKS OVERSEAS

- **Lodging an Application**

In most countries the Trade Marks Register is divided up into 45 classes.

If you wish to register a mark in respect of goods or services falling in more than one class, a single application can be made in some countries, but separate applications must be made in each class in other countries. Similarly, if you wish to register more than one mark for the same goods, separate applications must also be made.

- **Examination**

In most countries a trade mark Application must be examined by the Trade Marks Office before it can be registered.

When the application is examined, the examiner must determine if the mark is registrable based upon the laws of the country and also if the mark conflicts with any earlier registrations or applications made in respect of similar marks for similar goods or services. If objections are raised on the basis of earlier marks, it may be necessary to argue or to restrict the goods or services of the application to avoid the conflict.

Once objections are overcome, acceptance of the application is generally published and third parties usually have a restricted time from publication of acceptance to oppose registration of the mark. If no opposition is lodged then the mark will be registered, subject to payment of a registration fee in most countries.

- **Searches**

Before using and applying to register a mark it is advisable that a search of at least the Trade Marks Office records in the country concerned be conducted to determine if the mark will infringe any existing rights and also to determine if the mark is registrable.

It should be noted, however, that in some countries use of an unregistered mark by third parties can give rise to common law protection which may limit or prevent use of the mark. Consequently, a search of the Trade Marks Office records in such countries cannot give a complete indication of the availability for use or registration of a mark.

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- **European Community Trade Marks (CTM)**

It is possible to file a single application which covers all the countries of the European Union. Ratification in each country is not required. However existing rights and registrations in the member countries have seniority over a CTM application. If a conflicting registration in a single country is raised and cannot be overcome, then the entire application cannot proceed - it is not possible to exclude individual countries from a CTM application. In such circumstances the CTM application may be converted into a series of independent national applications, at additional cost.

- **Madrid Protocol**

The Madrid Protocol is a treaty which provides for the international registration of trade marks. It is an alternative system for obtaining a trade mark registration covering a number of countries. Protection is available in up to 50 countries by filing one international application. However, fees are required to be paid for each of the countries covered by the application. The International Bureau of the World Intellectual Property Organisation (WIPO) in Geneva administers the Madrid Protocol application process and under the CHRYSILIOU IP foreign filing program, systems have been implemented for taking best advantage of such process.

- **Requirements**

A company may only file an international application in the country where it has commercial activity and where it has filed its basic application for the same trade mark. International applications must be for a mark identical to the one covered by the basic trade mark application and include some or all of the goods and services covered by the application. The basic trade mark needs to be carefully maintained, because the international registration is dependent on it for five years from the date the international application is filed.

Although there may appear to be many advantages in filing a Madrid Protocol application, there are also disadvantages and applicants should seek the advice of the Chrysiliou IP Trade Mark Attorney team before making a decision as to the most appropriate foreign protection for their needs.