



Trade Mark Guide

GET THE FAQs



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Question 1. What Exactly Is A Trade Mark Anyway?

Essentially, a trade mark is a way of identifying your unique goods/products or services from others. It's how customers recognise you in the marketplace and distinguish you from your competitors

Trade marks can be many things, including:

1. Business/brand name – like Coca-Cola;
2. Logo – like Nike Swoosh device;
3. Combination of name and logo;
4. Slogan or tagline – like “Just Do It”;
5. Names of the products or services you provide; and
6. Even a colour or scent – like Cadbury’s distinctive purple as a colour trade mark for chocolate.

Question 2. Should I Trade Mark My Business Name, Logo, Or Slogan?

It's important to understand that each thing you're trying to trade mark is its own piece of intellectual property. Therefore, if you were to trade mark both your business name and logo, these would be two standalone applications. In instances where an applicant files for more than one trade mark, it is not uncommon to have one application accepted but the other knocked back.

To protect your brand to the absolute max, it's best to trade mark everything you can. However, if you're strapped for cash, typically your brand name (i.e. the particular words themselves), would provide the greatest scope of protection.

Ultimately, whatever you apply for really depends on your particular circumstance. If your brand name is too descriptive, or similar to that of other registered trade marks, you may have greater success if you apply to register your logo mark instead. Alternatively, your logo might be more important to your brand than the name, in which case, you might want to register it only.

Question 3. What Trade Mark Applications Will Likely Be Rejected?

When weighing up what to register, you should be aware of the kinds of words or phrases that would be difficult to register on their own. For example:

1. Descriptive words or phrases e.g., **MINTY** for toothpaste describes a common flavour, or **BOUNCE** for trampoline describes the function of a trampoline;
2. Misspellings of common words e.g., **Flickr**;
3. Geographical names, particularly where the goods or services are associated with the reputation of the place e.g., **BONDI** for beach towels, or **HUNTER VALLEY** for wine;
4. Common surnames e.g., **JONES** or **SMITH**;
5. Common phrases e.g., a coffee shop owner trying to register the phrase '**BEST COFFEE IN TOWN**';

A trade mark gives the owner the exclusive right to use that mark in connection to their goods or services. Therefore, if you were granted a trade mark over common words and phrases this would deprive other traders in the marketplace from describing their goods or services.

You should also be aware of other earlier registered trade marks in the same class or classes, even if there are additional words you don't intend to use. For example:

- If you wanted to register **DOGGIE WORLD**, the following would conflict: **DOGGIE WALK, DOGGIE ONLINE, DOGGIE TREATS** etc.

There are of course exceptions to these rules, and you have some options down the line to stake your claim on a trademark if your brand has built up significant traction over time.

Question 4. What Has A Better Chance Of Being Accepted?

As a rule of thumb – words that are not commonly used in your industry have better chances of being registered as a trademark.

Creativity and uniqueness are more likely to be rewarded in the eyes of the trade mark examiner. For example:

- Invented words, e.g. **GOOGLE**;
- Words that don't describe the goods or services, e.g. the word **UBER** doesn't describe a ride-sharing service.

5.

What Is A 'Class', How Do I Decide? On A 'Class' Or 'Classes'?

When you apply to register a trade mark, you must choose one or more 'classes'.

Choosing what "class" or "classes" are right for you can be the most difficult part. There are 45 different classes you can choose from. Of these 45 classes, the classes fall into one of two categories:

1. "Goods" or
2. "Services".

The first **1 – 34** classes are for goods (i.e. physical products), and the other **35 – 45** classes are for services you may provide (e.g., cake decorating). You can use the Trade Mark Classification Search to assist with selecting your classes of goods or services.

What classes you choose are important because once you have secured your trade mark, you only have the exclusive right to use your trade mark in connection with the goods or services you have registered in.

For example, if you were in the business of producing luxury suitcases, the most obvious class to register in would be Class 18 which is for 'items used for the transport of personal goods, such as suitcases and other travelling bags'. Once your trade mark is registered, you will have the exclusive right to use your trade mark in connection to this class. However, if your brand expands and you decide to start selling clothing, you are not protected as your trade mark is registered in Class 18, rather than Class 25 which is for 'clothing, footwear and headwear'.

Once you have chosen a class, you will also need to choose a description within that class. Back to our luxury suitcase example, the most relevant class is Class 18, however the descriptions within that class would most likely be Suitcases, Suitcase handles, Luggage, Luggage bags, Luggage straps, Overnight cases, etc.



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“There is never a bad time to start a business – unless you want to start a mediocre one.”

– GARY VAYNERCHUK



6. What Are The Different Trade Mark Classes?

When applying for a trade mark, you must determine what your mark will be used for. In doing so, you need to select one or more of the classes on the next page that you believe best describe your goods and/or services:

Trade marks are usually metaphors of one kind or another. And are, in a certain sense, thinking made visible. – SAUL BASS

GOODS	SERVICES
1. Chemical products;	35. Advertising, marketing, business, and retail;
2. Paint products;	36. Insurance and finance;
3. Cosmetics and cleaning products;	37. Construction and repair;
4. Industrial oils and greases;	38. Communications;
5. Pharmaceutical products;	39. Transport, logistics and storage;
6. Common metals and their alloys;	40. Treatment and materials processing;
7. Machinery;	41. Education and entertainment;
8. Hand tool products;	42. Computer, software and scientific services;
9. Computer, software and scientific goods;	43. Hospitality;
10. Medical instruments;	44. Medical and veterinary services; and
11. Appliances;	45. Legal and security services.
12. Vehicles;	
13. Firearms;	
14. Precious metals, their alloys, and jewellery;	
15. Musical instruments;	
16. Paper and cardboard;	
17. Rubber products;	
18. Leather goods;	
19. Non-metal materials and building products;	
20. Furniture, cookware and mirrors;	
21. Household goods and kitchenware;	
22. Ropes and string;	
23. Thread and yarn;	
24. Textile products;	
25. Clothing and other apparel;	
26. Lace and embroidered goods;	
27. Mats, carpets, and other floor coverings;	
28. Sporting games and related goods;	
29. Meat, fish and processed foods;	
30. Staple foods;	
31. Agricultural products;	
32. Beverages;	
33. Wines and spirits; and	
34. Smoking goods.	

“

**Never say never,
because limits, like
fears, are often just
illusions**

- MICHAEL JORDAN

7.

How Does A Trade Mark Stop Others From Copying Me?

The way you can stop other others from copying your brand identity is twofold – your trade mark can be wielded as both a sword and a shield.

Sword: Competitors may try to take advantage of your trade mark, or elements of your logo, business name, or design for their own products or services thereby driving traffic away from your business and confusing prospective customers. After you lock in your trade marks, you have the right to stop others from infringing on your intellectual property, such as sending a cease-and-desist letter or initiating proceedings.

Shield: Once you have registered your trade mark, you have the exclusive right to use, licence and even sell the mark. Another benefit after registration is that your trade mark can carry the ® symbol. This symbol puts others on notice to respect your mark and can ward off potential competitors when they are conducting searches to decide on their brand name. Registration also prevents another party from adopting a near identical name to yours, meaning similar names to yours in the same class of goods or services can't be registered.





8. I've Already Registered My Business Name – Why Do I Need A Trade Mark?

A common misconception is that a business name is enough to protect your brand.

In reality, it's not. Even though you have registered your business name on ASIC's business name register, this does not give you the exclusive right to use the name. No one can register a business name that is identical to yours, however, this doesn't prevent another party from registering your name (or one similar to yours) as a trademark before you.

Registration of a trademark is on a first to file basis. If another party beats you to trade mark registration, then they may then take legal action against you for infringing on their mark and you may need to stop trading under that name. As you can imagine, rebranding is a costly exercise that could prove to be detrimental to your brand. Of course, you have some options to stake your claim to the unregistered mark if you have built up a significant reputation over a sufficient period of time – such as applying to the court to have their trade mark removed from the register. However, it is easier to avoid this expensive headache altogether by securing your trade marks before anyone else does!

9. I Already Have My Domain Name – Could Someone Take It?

Your website is the first port of call for customers and reflects your products or services, and ultimately your brand. However, even though you may have secured your domain name this does not give you proprietary rights to the name.

By registering the domain, you do not own the name, but rather hold a licence to use it for a specified period, subject to terms and conditions. If someone later registers a trade mark that is an exact match to your '.com.au' and/or '.net.au' domain name, then your licence can be revoked by the domain name regulatory body (auDA) for trademark infringement.

10.

Are Trade Marks Worth The Investment?

Believe it or not, the brand that your users and customers associate with your service or product could be your most valuable asset as your brand grows. Aside from preventing others from registering the same or similar mark, your trade mark is a valuable piece of intellectual property that can be both sold and licensed.

Gaining trade mark protection is also another way to encourage investment in your brand. It shows that your brand is legit and has plans to grow. If you don't have these protections in place, investors and potential purchasers of your business may be skeptical as to why not. This is because the value of your trade mark also represents your business's goodwill.

Goodwill is the intangible value of a business, such as its overall reputation, customer loyalty and branding. Essentially, your business will be valued higher than the sum of its actual assets the greater it's goodwill. It's best to get your ducks in a row early and get trade mark protection as soon as possible before sh*t gets real!



11. What's The Difference Between The ™ And ® Symbols?

Another benefit after registration is that your trade mark can carry the ® symbol. These are used to identify trade marks that have been registered with IP Australia. It puts others on notice that your trade mark has legal protection and it is even a criminal offence to display the ® symbol with a trade mark that has not been registered.

On the other hand, if the ™ symbol is usually used early on to send a message to other traders that you intend to claim a trade mark over your brand name, logo, slogan etc., or that your trade mark application is still pending. It essentially means you are claiming ownership of your trade mark as an unregistered mark. However, it is important to note that the ® symbol will give you a lot more protection if you ever find yourself in a trade mark dispute. Trying to defend a product marked with the ™ symbol in court can be costly, so it's always best to apply for a trade mark early on and secure that ® symbol.



2. Will My Trade Mark Be Protected Internationally?

Once registered, your trade mark will only be protected within Australia. So, for example, if you live in Sydney and register a trade mark, someone in Perth can't use your trade mark for similar products or services as those you offer. Even if your business has no reputation in Perth, you can pursue an infringer since registration operates Australia-wide. Whereas if you don't have a registered trade mark, if someone is copying your brand, or elements of your logo, business name, or design for their own products or services, you will have to prove your business reputation in that region to go after the infringer.

If you intend to expand your brand internationally, gaining international trade mark protection is a whole other process. You can either apply directly to another country or file a single application through the World Intellectual Property Organisation (WIPO) and nominate countries that are members of the Madrid Protocol. If you're ready for world domination, get in touch with our awesome partner law firm, Lazarus Legal separately and they can assist in registering your trade mark(s) internationally!

13. What Is The Trade Mark Process?

1. **Searches/ Advice:** One of our Lazarus Legal advisors will conduct preliminary searches and prepare email advice on the process and recommended classes for your goods and/or services.
2. **Filing:** Once you are confident with the type of trade mark you are applying for (e.g., name, logo, or slogan etc.) and have chosen the classes of goods and/or services your trade mark should be registered in, we will then submit your application to IP Australia.
3. **Application Process:** there are essentially two types of trade mark applications that can be lodged:
 - A. the **Standard Application**; or
 - B. the **TM Headstart Application** (an optional pre-application service).

The TM Headstart Application is an optional pre-payment service that will provide you an initial assessment to help you determine if your trade mark is likely to be registered. It is not a guarantee that your trade mark will be registered, but rather a good indication.

4. **Examination:** An examiner will formally assess your trade mark application against the requirements specified in the Trade Marks Act 1995. This could take anywhere between three to four months.
5. **2-month opposition period:** If your trade mark is accepted your trade mark will be advertised as 'accepted' on the IP Australia website. There is then a 2-month period for others to oppose the registration of your trade mark.
6. **Registration:** After two months, if there are no oppositions from your competitors or the public, your trade mark will be registered!





IS YOUR BRAND TRADE MARKED?

14. What's The Difference Between The Standard And TM Headstart Applications?

We have set out a simple comparison as follows:

THE STANDARD APPLICATION	THE TM HEADSTART APPLICATION (PRE-APPLICATION SERVICE)
<p>Initial Filing Fee:</p> <p>Initial filing fee of \$250.00 for each class of goods and services selected is payable upon lodging the application</p>	<p>Headstart Filing Fee (Part 1 Fee):</p> <p>Payment of \$200.00 per class for each class of goods and services selected is payable upon lodging the application.</p> <p>Initial Filing Fee (Part 2 Fee):</p> <p>initial filing fee of \$130.00 per class selected is payable upon lodging the application. This is known as the Part 2 fee.</p>
<p>The Report:</p> <p>An Examination Report will be issued with IP Australia's findings within 13 weeks of lodging the application. *</p> <p>*Note: When you file a standard application, it is made publicly available very shortly after you file your application. Once it is published only very minor changes can be made. When applying, you can choose to either use the trade mark picklist or not.</p>	<p>The Report:</p> <p>IP Australia will provide a brief report of the likelihood of your trademark registration within approximately 5-7 days from lodging the application. The report will identify potential issues that may arise in your application, and you will have an opportunity to amend the application within a short timeframe before it moves to the next stage.</p> <p>Note: As for the TM Headstart process, your request is not published until you pay the Part 2 fee. Therefore, you have a wider range of options to overcome potential barriers to registration. You can amend your trade mark and/or add new classes to your request. However, when applying for a TM Headstart you must use the picklist, hence the quick turnaround times.</p>





REJECTED?
☐ YES ☐ NO

15. What If My Trade Mark Application Is Rejected?

There is still potential to get your trade mark registered, even if it is initially locked back!

If we receive an Adverse Examination report, you will have 15 months from the date of the report to overcome the issues raised by submitting a Declaration. At an additional cost, our partner law firm, Lazarus Legal can assist you in trying to get your application accepted.

Even if your trade mark is rejected, you will maintain your 'priority date' during this 15-month period. The priority date is the date that you filed your trade mark application. This is date is important, because if your competitor tries to file a similar trade mark to yours at a later date, their application will likely be rejected given you submitted your application first and takes priority within that 15-month window.

16. What Is An Adverse Examination Report And What Are My Options If I Get One?

Throughout the course of your trademark application, you may receive an Adverse Examination report if your examiner finds that your proposed trade mark does not qualify for registration. The report will discuss the reasons why the examiner did not find your trade mark to be suitable, and depending on the issues raised in the report, may suggest how you can amend your trade mark to increase your chances of a successful application.

**“A great trade mark is appropriate,
dynamic, distinctive, memorable and
unique”** - PRIMO ANGELI



In the event that you do get an Adverse Examination report, these are your options:

1. If you have submitted a **TM Headstart** application, you can pay the Part 2 fee to convert your **TM Headstart** into an official **Trade Mark application**, and wait for the final report. If the final report is still adverse, you have 15 months to submit evidence addressing any concerns expressed by the examiner about your mark; or
2. If You can amend the classes for which you applied your trade mark:
 - A. To add a class, IP Australia charges \$200 per class;
 - B. To delete a class, there is no additional fee charged by IP Australia;
3. You can amend the representation of the trade mark, i.e. change the category of the trademark from a WORD mark to a LOGO mark (IP Australia charges \$150 per class to amend the representation); or
4. Abandon the trade mark completely.

Upon receiving an adverse report, you have a 5-day window to proceed with any of the above options, otherwise you will lose the monies you have paid thus far, and the trademark application will lapse.

To mitigate the costs associated with getting an adverse report after completing the trade mark application process, consider using **IP Australia's TM Headstart** service to better understand the chances of having your trade mark approved and registered.

17. Why Should I Use The TM Headstart Service First? Is It Worth The Extra \$80 Per Class?

Unless you have been using the trade mark for a long time, we strongly recommend first submitting a Headstart application.

Under the standard trade mark application process, it can take anywhere between 3 – 6 months before an examiner even looks at your proposed trade mark. For most businesses, that's way too long of a wait to know if you will likely succeed in registering the mark, or if you will possibly have to do a rebrand.

Meanwhile, if you opt for the Headstart service provided by IP Australia, a trade mark examiner will usually get back to you within 5 working days with a report outlining whether your trade mark will be successful or not.

If there are any issues raised in the report, you then have the opportunity to amend your trade mark. This could mean amending the trade mark itself (e.g. changing the words, or uploading a logo instead) or deleting one of your classes so it doesn't conflict with an existing mark.

Amending your application, if required, is an additional fee, however, it is well worth it to increase the success of your trade mark application.

After you have received the report and made any amendments (if necessary), you will then have five working days to pay the Part 2 fee. This converts your Headstart application into an official trade mark application.

SERVICE	SERVICE FEE
TM Headstart New Request (per class)	\$200
TM Headstart Part 2 Fee (per class)	\$130

“Every Trade Mark you Build adds to the financial value of your business, much more than your tangible assets”

- KALYAN C. KANKANALA

18. How Long Does It Take To Register A Trade Mark?

Well, that depends on which country you intend to apply in.

Currently, in Australia, a successful registration usually takes around seven and a half months, from start to finish, but this process can take longer if there are objections along the way.

19. How Long Does Trade Mark Protection Last?

Registration operates Australia-wide for an initial 10-year period. To protect your mark, your registration will have to be renewed every 10-years for a fee, which can be done 12 months before the renewal date or up to 6 months after.

20. What Is A Trade Mark Infringement?

Quite simply, a trade mark infringement is when one party uses an existing trade mark without prior consent of the trademark owner.

If you use another's registered trade mark without their permission, or use a sign or phrase that is very similar or essentially identical to an registered trademark, you could find yourself in legal trouble.

21. How Do I Check That My Logo Or Business Name Is Not Already Trademarked?

IP Australia's Trade Mark Search Portal publicly displays all trade marks that are registered, as well as those that are currently going through the application process.





22. Someone Has A Trademark That Is Too Similar To Mine. What Can I Do?

If you wish to oppose a trade mark, you **MUST** file a **'Notice of Intention to Oppose'** within 2 months of the mark being posted in the Australian Official Journal of Trade Marks.

You may elect to oppose in circumstances where:

1. a registered trade mark or an accepted trade mark application is too similar to your trade mark;
2. the mark is deceptive in nature or may be mistaken to belong to another brand, potentially damaging their reputation;
3. the applicant is not the bona fide owner of the trade mark.

Within the first month of having filed the Notice of Intention to Oppose, you must submit a **'Statement of Grounds and Particulars'** to ensure that your opposition does not lapse, and that the trade mark in dispute is not processed. IP Australia does not charge an additional fee for this.

23. Someone Has Filed A Notice Of Intention To Oppose My Trade Mark. How Do I Respond?

By filing a **'Notice of Intention to Defend'**, you can begin the process of safeguarding your mark against the opposition.

This must be submitted within **the first month** of obtaining the Statement of Grounds and Particulars from the other side, or else your trade mark application will become void, and you will no longer be able to proceed with the application.

In addition, Evidence 'in Support', 'in Answer' and 'in Reply' must be lodged to IP Australia to defend your mark.

Let's connect.

Are you ready to take the next step?

We hope this guide has answered some questions and helped you to navigate your way through the challenging and often complex world of trade mark legalese.

If you want to get set up right, Lazarus Legal is ready for the challenge. We can help you navigate and absolutely crush this space by providing you with accessible, affordable and immersive tools necessary to build a solid legal foundation and help you shoot for the stars.

Contact our team today at info@lazaruslegal.com.au to get the ball rolling!

