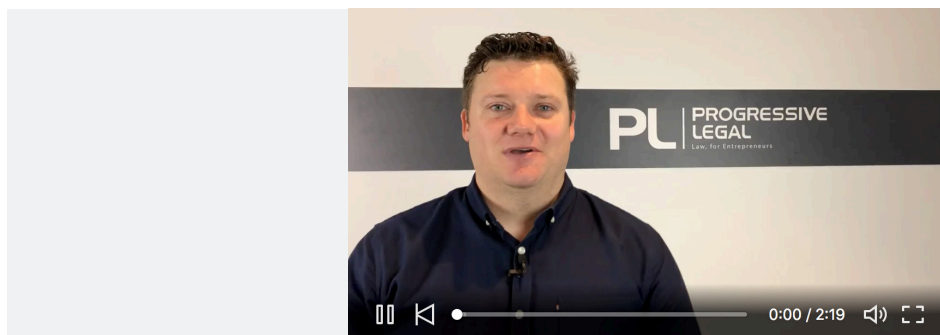


Australian Trade Mark Guide

1. What's a Trade Mark?

- A trade mark is a “badge of origin” for your brand.
- For most Australian businesses, it could be your business name, logo, tag-line, products, programs or services you want to deliver, jingle, etc – anything you use to differentiate from your competitors.
- It prevents consumers being confused as to who is the ultimate owner of the mark.
- Think about all the bigger brands out there and what you’ve seen used in advertising from one brand to another...
- What was once thought only necessary for big business is starting to become extremely important for small businesses, all the way from start-up. Remember, the younger the business – usually the more vulnerable it is.
- Globalisation, the Internet, increasing knowledge around the trade marking space and business’ collective willingness to protect their brands and enforce their legal rights, has meant that the importance of securing these important intellectual property assets has dramatically increased and more broadly a bigger focus is now being placed on a business’ intellectual property protection strategy – and that includes securing all the available trade marks to make sure they are protected.

Click here to watch the video:
What's a trade mark?



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2. I have a business name? Isn't that enough?

Most Australian businesses don't realise that just because you have a business name – it doesn't give you the legal right to use it and use it exclusively!

- That might sound quite strange, but we hear it so often – if someone was out there first using it in the market (whether it's a name, tag line, product name, slogan, logo), technically, they have first legal rights to it.
- Only a registered trade mark with IP Australia will give you the highest possible legal rights to the trade mark.
- A business name is a nickname essentially and distinct from a legal entity.
- The legal entity might be for instance Bob Smith t/as Bob the Builder, or Bob Smith Pty Ltd t/as Bob the Builder (if a company). The individual or company owns the business name, and can own many others.
- We've seen so many cases where a business that starts to trade (sometimes even for a long period of time), then finds out that they need to stop trading with their name because they are infringing someone else's trade mark.
- It's an extremely serious issue if it happens and is in most circumstances a very expensive exercise, in some cases unfortunately it can be fatal for a business.



- Although there's no legal requirement to register your trade mark, the consequences of someone coming along and attempting to prevent you from trading is huge, especially for smaller businesses.
- As soon as you use your mark (most commonly business name, logo, slogan/ tag-line / slap-line or product names), you have what is called inherent rights which are common law rights. But only a full trade mark registration will provide you with the maximum protection.

The reason why you register your mark with IP Australia is so you have much greater protection. Your rights in the mark are then easier to enforce and you have a much stronger legal position.

- Most investors or purchasers of a business will insist on the registration of trade marks because they know what the dangers are if they aren't protected. It's just good business and it should be a part of your businesses' IP protection strategy (just like securing all the business names, domain names, social media handles etc).

**Click here to watch the video:
What's the difference between a business name and a trade mark?**



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3. Why is trade marking so important in 2019?

- **Risk management** - it's becoming such a hot topic now and is an essential part of business' IP strategy, because it's so dangerous to a business if it doesn't.
- **Potential investment** - any investors or potential purchasers for a business will look very quickly to make sure that the business has registered all its relevant trade marks. If it hasn't, they will be asking questions as to why not and be very wary or scared of. This shows how much importance they put on it, from experience.
- **Increasing value of IP generally** - it's becoming more and more valuable as businesses invest in technology and new ways of doing things, new trade marks to protect, new designs, new patentable inventions, technical know-how, automation, inventive steps, processes and secrets worth protecting.
- **The Internet** – it's the driving force behind most of the change and for some businesses e.g. AirBnB, Facebook, Uber, Nike, etc - almost their entire balance sheet is IP.
- **Increased competition** - even smart medium and smaller businesses are wisely investing heavily in IP as they realise this is the new currency of the digital age. It's what can make a smaller business compete with larger ones and even outgrow them rapidly, if that IP is protected.
- **Scarcity** - it's becoming really important now where we've not only got a scarcity of names starting to happen but also more businesses conducting more global business and protecting their IP in international markets as the knowledge in this area grows more and more.
- **Protection of the business' legal rights** - having registered trade marks in Australia allows you to prevent others from infringing your Intellectual Property rights. E.g. stop someone else from confusing the market as to who is the rightful owner of that mark.

Click here to watch the video:
Why are trade marks becoming so important for Australian businesses?



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4. Should I trade mark my business name, logo, tag-line or all of them?

- You might suspect the answer already...all of them if you can, and separately – to give them the most amount of legal value and protection individually.
- You see, IP Australia views each of these as separate pieces of intellectual property and each of them are capable of registration.
- You can combine them together in what is called a composite mark. You can combine the business name with the tag line for instance: "Progressive Legal, Forward Thinking Business Law"
- It depends, however in most circumstances securing the name is the first port of call given that most of the investment in IP is around your brand "name" as opposed to a logo or a slogan/by-line/tag-line etc.

Importance of registering your business name as a trade mark

- We recommend that you get your name trade-marked first as soon as you're set on the name and happy with it.
 - + It takes a lot of time to come up with a name and once you finally have determined that this name is the right one for your business.
 - + Getting the registered trade marks in Australia now ensures that you have the maximum rights to stop someone coming along afterwards and copying your name and confusing the market.
 - + You might think, "what's the chances of that happening?", but believe me it does.
 - + Even competitors have been known to try and frustrate their opposition by registering similar names and releasing products with same or similar names in order to confuse the market and frustrate you.
 - + We've seen it happen too many times – and the consequences can be frightening.
- Names are becoming more and more scarce and a lot of businesses are starting to take a very active interest in securing their Intellectual Property.
- The cost of potentially going through a rebrand is a scary proposition for any business owner.

- Not just the cost of having to change all your branding, documents, contracts, new business name registrations, domain names, business cards, stationery, flyers, social media handles - let alone the business frustration and interruption!
- It's much safer to get your trade marks in Australia registered, and get them registered now.

- + It's not as expensive as you might think.
- + Small investment now to protect your business down the track.
- + The stitch-in-time, will save nine.

Logos and tag-lines are valuable trade marks for your brand

- These aren't necessarily in order of preference in terms of protection.
- A business could have a generic name but seek to protect their logo first or their tag line because of the relative importance of it or perhaps the amount of time, effort and cost in producing the logo for instance.
- It really is a case-by-case basis and some quick advice from a professional is invaluable.
- Have a think about the brand Nike for a moment. That brand has so much value in "Just Do It" and the swoosh, that each the name, the logo and the tag line are virtually the same in terms of recognition for the brand. They're all synonymous with the brand.

**Click here to watch the video:
What do I need to trade mark?**



5. Is my Australian trade mark protected overseas?

- We get this question quite a lot. That, and, “can I register a global trade mark?”
- Unfortunately, there’s no such thing as a global trade mark and if you want the highest protection, you have to register in the jurisdiction in which you wish to obtain that protection. i.e. if you want to be protected in the USA, you have to register your trade mark in the USA.

Different approaches and timing

- Now, there’s two way of doing that – we can either apply for the trade mark in that country as you would starting from scratch, or, we register your trade mark here in Australia first and use the application as a base to file further trade marks in other countries.
- The big thing to remember is that if you want protection overseas, you should consider obtaining that protection as soon as possible from a legal perspective (as it really is a first come, first serve – first to register, first with the rights – usually). There are exceptions of course.
- For example, if you know you’re going to be expanding into a certain market overseas, you should be looking to register the trade mark that as soon as possible – or at the very least having a strategy in place as to when and what to trade mark.
- Also, just because a business has a trade mark in the USA, doesn’t mean they have any protection here necessarily. They will need to be trading here or register a trade mark here in Australia to obtain that protection. Same goes for Australian businesses in other countries.



Time is of the essence!

- If you're already trading in other countries, you should be applying to register ASAP as time is of the essence!
- Australian businesses usually file applications for trade marks in Australia first, before filing in any overseas countries and it's possible to register through WIPO (World Intellectual Property Organisation) and apply to register in multiple countries in one go instead of having to do them all separately.
- It's also important to note that if you file an application in Australia first and you intend to, or do, sell your product or offer your service in other countries, you should file an international application in those countries within 6 months of filing your Australian application.
- This will give you the benefit of claiming your Australian filing date as the overseas filing date, giving you an earlier protection date.

[Click here to watch the video](#)



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6. What are the different classes of goods and services for trade marks?

- IP Australia clumps together similar goods and services in 45 different classes (34 classes of goods and 11 classes of services).
- This is so that, for instance, an accounting firm can co-exist on the IP register and not offend a big food store just by having the same or similar name. e.g. McDonalds Accountants and McDonalds Fast Food Restaurants. Or Dove chocolate and Dove soap.
- It means that many businesses can co-exist and not have a monopoly over a business name. For instance, when they operate in a completely different market, it's not going to confuse the market by having the same or similar name.
- There are a lot of classes with thousands of activities (you can just imagine how many businesses are doing what types of activities).
- The downside is that you have to pay per class, per application. However, in most instances we find businesses will only cover 1 or 2 classes of business, but in some circumstances 3 or 4.
- It's critical to get the classes and activities right the first time around because you can't expand on an application after it is filed – you can only narrow the scope!
- If you don't get all your core activities the first time around, then you will need to file a new application with IP Australia to get them covered, so best to get the right advice first.

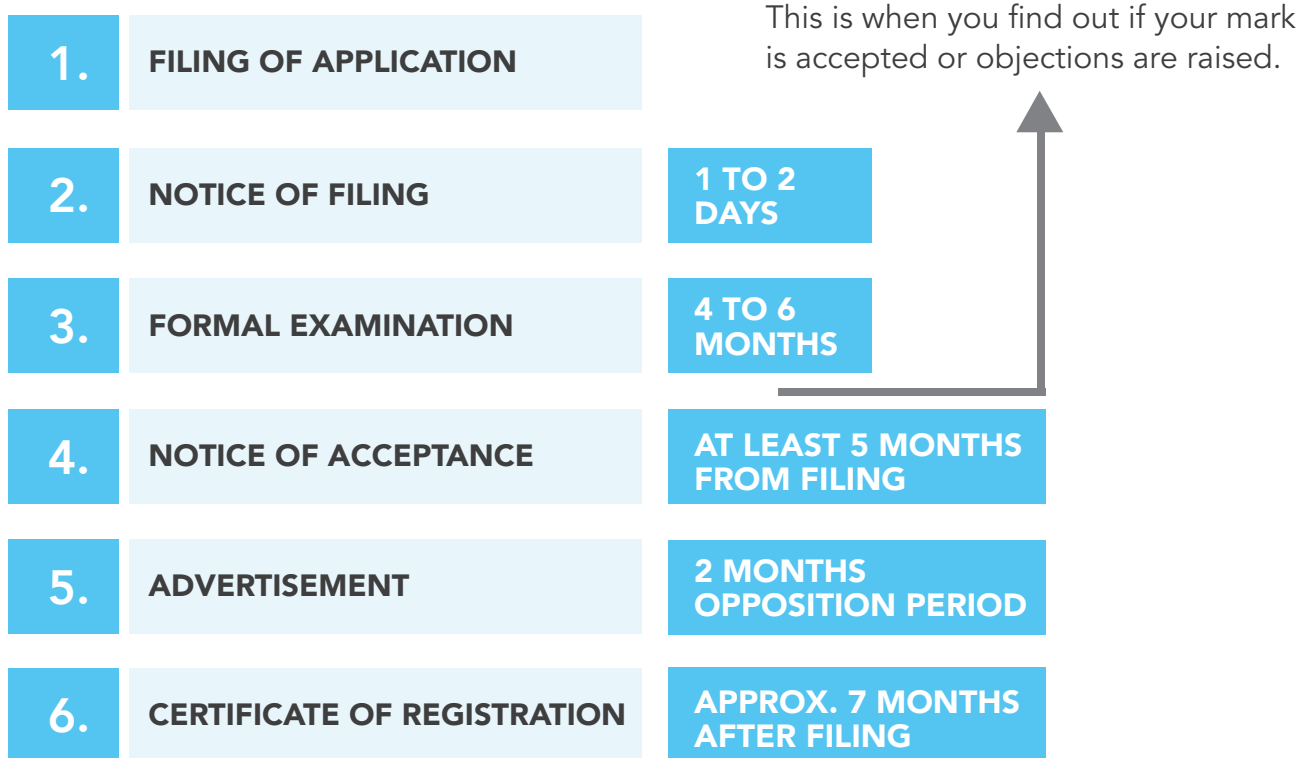
Why is it critical to get the classes and core activities right before you file a trade mark?
[Click here to watch the video](#)



7. What's the general process of getting a trade mark in Australia?

- IP Australia is the governing body of all registered intellectual property in Australia. It is the central repository for Trade Marks, Registered Designs, Patents, and other IP.
- The Australian trade mark registration process is conducted on-line through IP Australia.
- After filing a standard trade mark application, you will receive a notice of filing within a day or two and be allocated a filing date. As soon as you obtain the filing date of the application, you'll obtain protection i.e. you have more rights as of that date.
- From there, it usually takes 4-6 months for the mark to be formally examined by a trade mark examiner, at which point they'll indicate whether IP Australia has any objection to the mark, or if they think anyone else on the register would have an objection. There are a number of other objections they may also raise.
- However, if all clear - then the application proceeds to acceptance and is advertised in the official Trade Marks Journal. It's open for a period of 2 months, which allows others the opportunity to oppose to the mark if they have a valid reason.
- If there is a problem with the mark at the examination stage, an examination report will be provided and you'll be given the opportunity to respond to the objections.

The whole process takes at least 7 months from filing all the way up to final registration, but it's well worth the wait to have your IP secured and, in any event, you receive priority rights from the filing date.



[Click here to watch the video:](#)
What's the process of getting a trade mark in Australia?



8. What's the head-start application process for getting a trade mark in Australia?

- The problem with the standard process is that it can take 4-6 months before the trade mark is even looked at by IP Australia and for most businesses, that's too long to find out whether they can start using a name/logo/tag-line/product name etc in the market.

It speeds up the examination of the mark

- So, IP Australia invented this great system of being able to find out within 5-10 working days what ordinarily happens in 4-6 months and speeds up the examination of the mark.
- With the head-start process, you obtain a report within 5-10 business days (as opposed to months) which picks up whether there will be an issue with the proposed trade mark. This allows you to consider any likely objections by IP Australia or other Trade Mark owners.

It allows you to cure any potential defects before you formally file it

- This early assessment allows you to cure any potential defects prior to lodging the formal application (afterwards it can be difficult to amend in any significant way).
- The other great thing is that it's completely confidential and no-one will see your proposed Trade Mark until you're ready to file.
- You can also discuss any issues with the assessing examiner after you receive the report. If it's all clear, then you can pay the second part of the fee and get underway with the usual process.
- The other great thing is that if you think there might be issues with the mark, then you can amend the application to cure the objections (e.g. if the mark is too descriptive or generic, likely to be needed by other traders).

It usually saves money and time if there are any issues with the mark

- Instead of wasting further time and money, you can amend the application and start the head-start process again.
- This quick turnaround gives the modern fast-paced entrepreneur more comfort in using their business name / logo / slogan in the marketplace and not having to wait months before the standard application is assessed.

- We've had loads of clients make invaluable use of the head-start application process which has picked up potential objections by IP Australia, allowing us to amend applications before their application is officially filed. Our clients have peace of mind that they'll be able to use their trade marks and prevent others from using the same or similar mark and confusing the market.
- We've also saved a lot of clients from going ahead with a Trade Mark and having to go through a costly rebrand down the track and potentially infringing other intellectual property.

Unless there are reasons not to, we suggest the head-start process

- We'll usually make use of the head-start process, unless there are reasons otherwise to obtain a filing date as a matter of urgency (potential infringing business), or if clients have been trading for a very long time and have significant and extensive evidence of use.
- In most circumstances, the extra fee of \$80 per class to find out in 5-10 days instead of months, is a no-brainer.

1.	FILING OF APPLICATION (HEAD START PROCESS)	REPORT AFTER 5-10 DAYS
2.	NOTICE OF FILING	1 DAY AFTER PAYING PART 2 FEE
3.	FORMAL EXAMINATION	1 TO 3 MONTHS
4.	NOTICE OF ACCEPTANCE	AT LEAST 5 MONTHS FROM FILING
5.	ADVERTISEMENT	2 MONTHS OPPOSITION PERIOD
6.	CERTIFICATE OF REGISTRATION	APPROX. 7 MONTHS AFTER FILING

This is when you find out if your mark is likely to be accepted or objected to during the formal examination phase.

[Click here to watch the video](#)

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9. How do I know if my trade mark is available?

- We use IP Australia's Australian Trade Mark Online Search System (ATMOSS).
- It is a great tool to find out whether there are any other businesses that have same or similar trade marks in order to determine the chances of success in obtaining a potential trade mark.
- We can do a simple search for you to see whether other traders have registered on the trade mark register, and in what classes of business and activities underneath those classes.
- There's also a way to do more advanced searches to see if anyone has registered in similar or related classes and what they have registered.
- Because it's all publicly available information, it's free to find out but you have to know where to look and after doing tens of thousands of these searches, we know where to look and can advise you quickly.
- We're happy to provide you with a complimentary quick search to check the availability and provide you with some advice on what to register and prospects of success.

**CLICK HERE IF YOU WANT US TO DO A COMPLIMENTARY
QUICK SEARCH OF THE TM REGISTER FOR YOU**



10. What's the cost of registering a trade mark in Australia?

The government charges are as follows:

Standard trade mark filing fees

Item/Action	Fee
Trade mark application - with picklist	\$250 per class
Trade mark application - without picklist	\$330 per class

Head-start filing fees

Item/Action	Fee
TM Head-start (pre-application service) new request	\$200 per class
TM Head-start (pre-application service) Part 2 fee	\$130 per class

Our professional fees

- We charge a flat fee \$850 + GST + gov't fees to file a trade mark, then \$275 + GST admin fee for handling all the notices through filing, examination, acceptance, advertisement up to final registration.
- Be very wary of those law firms or IP attorneys that charge per class of business.
- We understand why they would do this as it takes a bit longer for each application when extra classes are added, and activities need to be identified.
- However, in our experience, it doesn't truly represent the real time involved.
- Additionally, it provides a disincentive for clients to get the protection that they need. i.e. if it costs more for extra classes on top of the government fees, then clients are likely not to get the full protection they need.

**IF YOU'RE READY TO GET STARTED,
CLICK HERE TO GET UNDERWAY!**

11. How do I use my Trade Mark?

- Once we receive a filing date for your trade mark, you start to accumulate further legal rights – straight after the filing date.

Shield or sword

- You can use a registered trade mark as a shield or a sword.
- A **shield** - to prevent others from registering the same or similar mark underneath you on the IP Australia register. i.e. first come, first serve.
- A **sword** to be able to stop others from infringing your IP and misleading the market, confusing potential customers or even taking profit away from your business.
- We've seen it happen a lot: derivative product names, logos etc. Especially now that businesses are starting to become very savvy about their rights and becoming very protective of their brands.

Using the symbols™, ® and Copyright ©

- You might notice a difference with how big brands use different symbols at the end of their trade marks. E.g. BRAND NAME ™ or COMPANY ®.
- You can use the ™ symbol when you want to identify to the market that this is your brand, this is your logo, this is your tag-line to make sure that everyone knows that you are serious about it and are willing to protect it.
- You can only use the ® symbol when you have registered rights in the trade mark, i.e. you have received the Certificate of Registration.
- You may use the ™ symbol all the way up to final registration of your mark and once it's registered, change the symbol to ®.
- You can use the Copyright symbol © on your literary work, website, publications etc without registering the work as you have inherent copyright in your words.
- Best is to identify e.g. "Copyright © - Progressive Legal Pty Ltd (ACN 607 068 708) Trading as Progressive Legal. All rights reserved (2019)."

**Click here to watch the video:
How to use your trade mark to identify your brand?**

12. What do I do if I find someone using my trade mark?

Step 1 *Preserve the evidence*

- It's vital to preserve the evidence because posts can be taken down and then difficult to obtain if the evidence isn't preserved.
- Whether this is taking screen shots or printing a hard copy of the online offending material, it's important to keep a permanent record of potential intellectual property rights breaches.
- This can be used to explain to your lawyers what the offending conduct involved, and as evidence to support a claim later down the line if necessary.
- Make sure you include evidence on all the social media if you can, showing how many people have for instance viewed, commented, reacted, shared etc! This will show the amount of damage.

Step 2 *Step back - do not engage*

- Be extremely careful about what you say.
- How you respond to finding someone infringing upon your intellectual property rights is very important.
- Be careful not to take the bait, react emotionally, engage with trolls or put your foot in it.
- If you get into an online screaming match, it's not going to assist you.

Step 3 *Get advice*

- Speak with a lawyer ASAP.
- Following the above, it's vitally important to speak with a lawyer before taking any steps to respond.
- The longer you wait, usually the worse it gets, and the more damage done – time is of the essence!
- Make sure you are getting the right advice from the right person that has experience in this area of Law.
- We find not many lawyers really understand the online environment, so really make sure they've got some experience in dealing with this type of situation.

- Call/email us as soon as possible so we can go through it together and work out an immediate strategy.

Tip 4 ***Prevention is the best cure***

- Get adequate protection: this is your wake-up call
- To prevent or avoid situations like these, or to put yourself in the strongest position should an infringement dispute arise, ensure that your intellectual property rights are appropriately protected.
- With intellectual property, possession is sometimes said to be nine-tenths of the law.
- That is, whoever has registered their trade mark or created their copyrighted material first will have the best claim over its ownership.
- Because of this, it's very important to act promptly and get your intellectual property protected as quickly as possible.

Click here to watch the video:
What do I do if someone is infringing my intellectual property?



It's very important to act promptly and get your intellectual property protected as quickly as possible.

13. What's the benefit of getting a lawyer to do my trade mark?

- Like anything in life, if you don't do something every day, there's a greater chance you're likely to get it wrong than having someone that does.
- Also, it's probably not your highest and best use of time. E.g. I get my accountant to do our reconciliation and tax returns because I'm likely to get them wrong or not know all the relevant, up-to-date information.
- We advise Australian businesses everyday about their trade marks both here and internationally.
- The difficulty with trade marks is that you're not allowed to substantially amend the trade mark (unless you narrow the scope) after you've filed it, so if you muck it up, you basically have to do the whole thing again and start from scratch and pay all the fees again – and leaving the business exposed in the meantime!
- It's not that expensive for the protection it provides, and at least you know that the mark you register is going to give you the protection you need, or as much as you can afford.
- A registered trade mark will give you protection for 10 years so is great value for money and peace of mind that you're protected.
- We're practical when it comes to financial matters and can work with you to obtain the protection you need with payments in stages if you need extra time to assist your cash flow.
- Feel free to get in touch – we're here to help.

A business has the greatest chance of success when it obtains expert advice from experienced advisors whether that's financial, legal, IT/software, marketing, branding etc.

NB> This guide is made for all Australian businesses that wish to protect their intellectual property (including their brand and all distinctive aspects of their activity e.g. names, logo, etc.).

Legal Disclaimer

This is legal information only, is of a general nature, and is not to be relied on as legal advice. To get proper legal advice tailored to your business, please feel free to get in touch with us.

Do you need trade marks registered for your business?

After helping over 2,000 SMEs over the past 5 years in the areas of Intellectual Property Law, Commercial Law, Dispute Resolution, Corporate Law and Workplace, we're passionate about what we do and protecting our clients.

We're relationship driven, not transactional (unlike the traditional law firm).

By striving to be affordable, practical and personable – we aim to be your long-term trusted business legal advisor.

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Ian Aldridge | Founder & Principal Lawyer

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