

## PROCEDURES FOR OBTAINING TRADE MARK REGISTRATION IN AUSTRALIA

### What can be registered as a Trade Mark?

A trade mark may exist in the form of a letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent, or any combination thereof.

Examples of Trade marks that cannot be registered

- a common surname;
- direct description of the goods or services with which it is used;
- something that is complimentary of the goods or services with which it is used (e.g. Perfection & Whopper);
- a geographic name having a presence or potential connection to your goods or services (e.g. Perth & York)
- a set of numerals (e.g. 2000); and
- one or two letters without significant get up.

### Why Register a Trade Mark?

Although registration of a trade mark is not essential, it is recommended. Registration provides prima facie proof of ownership and, if valid, also provides the registered owner with not only the right to use the trade mark, but also the right to stop others from using it (or a mark which is substantially identical to or deceptively similar to the registered trade mark).

#### To Search or Not to Search

It is not a requirement that a search be conducted prior to applying for registration. However, it is certainly recommended and may save you wasting time, effort and money on a mark you cannot use and/or register.

### Seeking Trade Mark Registration

Applying for Trade Mark Registration

To seek registration of a trade mark it is necessary to lodge a trade mark application with the Australian Trade Mark Office.

#### Examination of the Application

After lodgement, the application is examined by the Trade Mark Office. If there are grounds for objecting to the application an examination report will be issued.

The most common grounds for objecting the application are:

- whether the trade mark is distinctive; and
- whether the trade mark is substantially identical with or deceptively similar to an earlier lodged trade mark application or registration.

To overcome the objections it is necessary to respond to the examination report. The cost for responding to the examination report will depend on the nature of the objections raised and the number of examination reports that will be issued.

#### Acceptance and Opposition Period

Upon overcoming all objections the trade mark application will be accepted. The acceptance of the trade mark application will be advertised and the application will be open to opposition by a third party for a period of two months. If no opposition is lodged, or the opposition is unsuccessful, the trade mark will be registered.

The registration will then be in force for a period of 10 years from the date of application.

## Renewals

Renewal of the registration is required every 10 years, commencing from the date the application was initially filed, in order to keep the registration active.

## Costs

Costs will be incurred in respect of each of the above stages in searching, applying for, prosecuting, obtaining and renewing a trade mark. We can provide detailed advice of the costs likely to be incurred in respect of any or each of these stages should you require it.

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## About Wrays

Working with start-ups to multinationals since 1920, we are one of Australia & New Zealand's largest independent IP specialist firms.

Intellectual property lawyers, attorneys and advisors all under one roof, ready to protect, grow and defend your valuable assets, locally and globally.