

## PROTECTING YOUR BRAND

**A registered trade mark provides the owner with exclusive rights to use the trade mark for the goods and/or services for which it was registered**

Once registered, no one can use the trade mark without the registered owner's authorisation.

If you have a sign (see below definition) which you want exclusive use of, it is important you register the trade mark as soon as possible.

### What can you trade mark?

A trade mark can be a letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound, scent or any combination of these (each defined as a "sign" in the *Trade Marks Act 1995*).

A substantial amount of time and money is spent on establishing a sign. Before doing so, and especially before registering a trade mark, due diligence should be completed to ensure that the sign has not already been registered. It is also beneficial to know whether anyone is using the same or similar unregistered mark.

### Why register a trade mark?

Many people make the mistake of assuming that they have an exclusive right to use a sign simply because they created it or used it first.

However, this is not necessarily true. Further, registering a business, company or domain name does not give a person exclusive rights to use that name.

In order to obtain exclusive rights to use a sign, you must register it as a trade mark. Once registered, the owner has the exclusive right to use, licence or sell the trade mark within Australia.

Most importantly, the owner will have the right to prevent others from using the trade mark without their consent.

If you do not register your sign as a trade mark, there is a risk that someone else will register it as a trade mark and you could be forced to change your sign.

However, not all signs can be trade marked. The following trade marks cannot be registered:

- surnames which are common (for example: Smith);
- descriptive words;
- trade marks which are substantially identical or deceptively similar to marks which are already registered; and
- protected names.

For further information and examples of trade marks which cannot be registered, please contact Industry Legal Group.

### Infringement

A person infringes a registered trade mark if the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to:

- goods or services in respect of which the trade mark is registered;
- goods or services of the same description or which are closely related, in a manner which was likely to deceive or cause confusion; or
- where the trade mark is well known and use of the sign would likely be taken as indicating a connection which would adversely affect the interests registered owner, unrelated goods or services, or goods or services which are not of the same description.

The owner of a registered trade mark can bring court action if there is infringement of the owner's trade mark registration. If an action for infringement is successful, a court may grant an injunction and damages or account of profits.

Prior to commencing legal action, the owner of a registered trade mark can send a cease and desist letter to the infringer requiring the infringer to give certain undertakings (for example, immediately cease and forever desist from using the infringing



marks and deliver up for destruction any infringing material).

There are a number of defences to infringement, including where the alleged infringer was using the mark prior to the registered owners first use of the trade mark or where a trade mark is being used in good faith to describe a characteristic of goods or services.

Unregistered trade marks are difficult to protect as there is no "exclusive right". However, in limited circumstances, a person may be able to bring a claim for "passing off" and/or "misleading or deceptive conduct" against the offender (note - such claims are also available in instances where a registered trade mark is infringed).

These types of claims are much more difficult to prove and only provide limited remedies if successful. As such, Industry Legal Group recommends that people register their signs as trade marks for the best protection.

### Overseas Trade Marks

Trade marks can be registered in overseas jurisdictions. A different process exists in applying for overseas trade marks. Please contact Industry Legal Group for further information on overseas trade marks.

*This article is intended for information purposes only and should not be regarded as legal advice. Please contact Industry Legal Group for specific advice.*



### Need Assistance?

Industry Legal Group provides advice in relation to all aspects of trade marks including whether a trade mark is required and due diligence around that mark. ILG can also assist with registering a trade mark and in enforcing your intellectual property rights.

Please contact Industry Legal Group on 1300 369 703 or [aaa@industrylegalgroup.com.au](mailto:aaa@industrylegalgroup.com.au) if you require any assistance.