

# PROTECTING REGISTERED TRADE MARKS

## A trade mark is an important marketing device

Trade marks identify and differentiate your business from other businesses, and are connected with the reputation built by you for your business. For these reasons, your trade mark is valuable and worth protecting.

### What is a trade mark?

A trade mark can be a word, letters, an image (such as a shape or logo, which may incorporate words), a phrase, or even a sound or colour.

### Must a trade mark be registered to be protected?

A trade mark can be registered which gives the owner of the registered trade mark specified rights under the Trade Marks Act 1995 (Cth) (Act).

Trade marks that are not registered may also attract legal protection pursuant to the Australian Consumer Law (ACL) and the civil wrong, or tort, of passing off.

However, although the legal protection available under the ACL and the wrong of passing off may be available to both registered and unregistered trade marks, these legal protections are likely to be more difficult to establish than the infringement of a registered trade mark pursuant to the rights available to holders of registered trade marks under the Act.

### Protecting the trade mark used by your business:

There are steps you can take to protect the trade mark used by your business. These protective steps include:

- Be alert to the use of trade marks that resemble the trade mark used by your business. If you identify a similar trade mark being used, consider if the use infringes your trade mark and if you may have a right to prevent its use under the Act and/or the ACL and the wrong of passing off (refer below to information regarding infringement under the Act). If the trade mark is in the process of being registered, consider if you are in a



position to oppose the registration of the trade mark (refer below for information regarding opposition applications).

- Make sure your contact details, including the address for service of notices by IP Australia, are updated as required to enable receipt of important notices, such as the requirement to renew your trade mark and pay the appropriate renewal fees.
- Ensure your trade mark is renewed and appropriate fees are paid. The failure to do so when required may result in your trade mark being removed from the register. Caution: be aware of unofficial registers/services, especially if seeking payment from you – if in doubt contact Industry Legal Group or IP Australia.

Remember, the ® symbol may be used only with registered trade marks. Using the ® symbol indicates to others that the trade mark is registered. However, if the trade mark is used overseas, check the requirements for the use of the ® symbol in that country to ensure that local laws are complied with. It is an offence to use the ® symbol with unregistered trade marks, although the ™ symbol may be used.

Note: If you register a trade mark and do not use the trade mark then, after a period of time, an application can be made by a third party for its removal from the register. Also, if your trade mark becomes the generic name of a type of product or service, then a person may apply to the court to have the registration cancelled.

### Opposing the registration of a trade mark:

Before a trade mark is registered it is advertised in the Australian Official Journal of Trade Marks. An opposition to the registration of the trade mark may be lodged within two months of the advertisement on the basis of one or more of the grounds provided in the Act.

There are various grounds for opposition, including where a trade mark has been continuously used in respect of goods or services before a 'substantially identical' or 'deceptively similar' advertised trade mark was first used, the person applying for registration does not intend to use the trade mark or the trade mark registration application is made in bad faith.

### When is a trade mark infringed under the Act?

Under the Act a person infringes a trade mark when the person uses another sign as a trade mark that is 'substantially identical' with or 'deceptively similar' to the trade mark:

- in relation to the goods or services in respect of which the trade mark is registered; or



- in relation to goods or services of the same description, services closely related to the goods in respect of which the trade mark is registered, or goods closely related to the services in respect of which the trade mark is registered, unless the person using the other trade mark establishes that its use is not likely to deceive or cause confusion.

Note: A trade mark that is well known in Australia may be infringed by the use of another sign as a trade mark in respect of unrelated goods or services, if the other trade mark is 'substantially identical' or 'deceptively similar' to the well known trade mark, so that it is likely to indicate a connection between the unrelated goods or services and the trade mark that is well known in Australia.

### Takeaways

The key takeaways are to:

- be alert to the use of trade marks that resemble the trade mark used by your business;
- protect your trade mark through use; and
- update your contact details with IP Australia if they change.

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

### AAAA Member Benefits

Industry Legal Group provides legal advice to members. If you have any questions relating to the above article, please contact Industry Legal Group on 1300 369 703 or [aaaa@industrylegalgroup.com.au](mailto:aaaa@industrylegalgroup.com.au)