

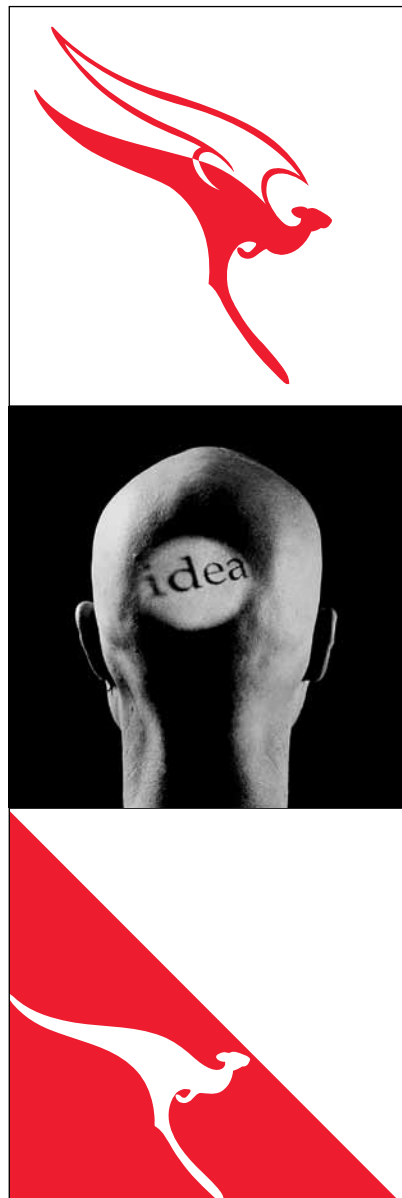


Australian Government

IP Australia

THE TRADEMARK APPLICATION KIT

An easy guide to applying for your Trade Mark



www.ipaustralia.gov.au



idea



Contents

What is a trade mark?	[2]
Entering the application process	[12]
Applying for a trade mark	[13]
Protecting your trade mark	[20]
Trade marks fees	[22]
Flowchart of an application	[25]
Contacting IP Australia	[26]

This application kit is designed to help you prepare and file a trade mark application in Australia. This kit does not cover every issue that may come up and you should not regard this kit as an authoritative statement on the relevant law and procedure. You should also note that the requirements may change from time to time and while we make every effort to ensure the information presented is accurate, you should check with IP Australia before relying on the information.



What is a **trade mark**?

Choosing a trade mark

A trade mark may be your most valuable marketing tool. With the right branding strategy, the public will identify a certain quality and image with goods and services bearing your trade mark. If you are thinking about a new product or service and you want to establish an image for it, you should also be thinking about a distinctive trade mark under which to market it.

Benefits of registering a trade mark

As the registered owner, you:

- ▶ have the exclusive right* to use your registered trade mark as a brand name for the goods or services specified in the registration;
- ▶ have the exclusive right to authorise other people to use your registered trade mark for the goods or services specified in the registration;
- ▶ have a registered trade mark which is personal property and can be sold;
- ▶ have a registration which usually covers the whole of the Commonwealth of Australia;
- ▶ may give the Australian Customs Service a notice objecting to the importation of goods that infringe your registered trade mark (see page 21); and
- ▶ can be in a stronger position to stop other people from using your trade mark as their brand name on the goods or services of your trade mark registration.

Is registration of a trade mark compulsory?

No. However, if your trade mark is not registered and another person uses it, you may have to take passing off action under common law, or claim for a breach of Section 52 of the *Trade Practices Act 1974* if you want to stop them. Protecting your trade mark without the benefit of registration can be more difficult and expensive than using the remedies available to owners of registered trade marks.

* Please note the Possible Limitations information on page 3

If you own a registered trade mark you have the right and the responsibility to protect your trade mark. You may take an infringement action against another person who uses your trade mark as their own on the same or similar goods or services. IP Australia grants trade mark rights but does not police or enforce those rights.

Are there any possible limitations to registration which I should know about?

Whilst uncommon, there are some circumstances which may limit your exclusive rights. For example, if another person is using an unregistered mark which is the same, or very similar to your mark, and their use of the trade mark started before you registered or started using your mark, they could possibly claim ownership of the trade mark under common law. They might rely on this as a defence against an infringement action. Sometimes a business name, or part of a company name, may have been used in this way as an unregistered trade mark.

If another person is using an unregistered trade mark that is the same, or very similar to your mark, such a mark could still be registered. That person may be able to produce evidence of prior use or honest concurrent use of their trade mark. It would then be possible for such a mark to subsequently be registered.

How long can registration of a trade mark last?

Indefinitely. Successful applications are registered for ten years from the date the application was filed.

Registrations continue as long as the renewal fees are paid every ten years.

Are all trade marks registrable?

No. To be registrable a trade mark must meet certain conditions that are spelt out in the *Trade Marks Act 1995*.

Trade marks that:

- ▶ indicate the kind, quality, intended purpose or value of the goods or services, or
- ▶ are common surnames or geographical names

are usually not capable of distinguishing your goods or services.

Trade marks which conflict with an earlier trade mark, or would mislead the public about the nature of the goods or services, are also difficult to register.

Some words are protected by law and cannot be registered as trade marks. Others are prohibited as trade marks under the *Trade Marks Act 1995*, for instance, OLYMPIC CHAMPION.

Some words are affected by other legislation. For instance, the use of the word CHAMPAGNE is governed by provisions of the *Australian Wine and Brandy Corporation Act 1980*.

What makes a trade mark “capable of distinguishing”?

Your trade mark needs to be something that other traders don’t need to use in the normal course of their trade.

Everyday language and vocabulary should remain open for all to use. Granting exclusive rights in words such as geographical names, common surnames and trade expressions would deprive others of their legitimate right to use these words in connection with their own goods and services.

The following are examples of trade mark types that other traders are *unlikely* to need to use:

Invented words such as LOCAJ;

Suggestive or emotive words such as FORTUITOUS CAT for pet food; or

Words that don’t describe what they will be used on such as ANVIL for computers.

The following points are examples of words used on their own, ie not with accompanying logo or other words. These are types of words that other traders are very *likely* to need to use and consequently would be very difficult not only to register as trade marks but also difficult to enforce:

Descriptive words and phrases on their own

A simple example would be an apple farmer trying to register the phrase THE BEST APPLES. Obviously other apple farmers have a legitimate need to be able to say that they grow the best apples too. It would be unfair on other apple farmers to give one apple farmer exclusive rights to this phrase.



Examples of some other trade marks that are extremely difficult to register include:

STRAWBERRY for drinks	(common flavour)
WARM for heaters	(describes function)
GLOBAL for freight shipping services	(indicates geographical range)

Geographical names on their own

Geographical references or place names are usually very difficult to register, especially when the place has a reputation for certain goods or services. For example, it would be very difficult to register TASMANIA for apples or NEWCASTLE for steel production. Traders who provide goods or services from these areas need to be able to indicate the origin of their goods or services.

Short combinations of numbers or letters on their own

Some combinations of letters are commonly used. Both may face difficulty in achieving registration. Common acronyms (such as CD-ROM) or abbreviations (such as AUTO BILLPAY) are also difficult to register if they describe the goods or services specified. Short combinations of numbers and letters (such as QL9 or F-55) may be used as serial numbers.

Common surnames on their own

Common surnames such as SMITH or JACKSON would have problems achieving registration, as there are many Smiths and Jacksons in the Australian population who need to be able to use their name in relation to the goods or services they are providing. However, a less common surname such as CREGAN or RUDNICKI has a higher likelihood of achieving registration.

Combination with other unique words or symbols can help

You should keep in mind that your trade mark registration is for the trade mark as a whole.

Words or phrases that other traders would need to use can often be registered if they are accompanied by or combined with other unique words or symbols. For example, the phrase SOUTH SYDNEY PLUMBING would be difficult to register on its own. If the phrase appears with a unique feature that forms a prominent part of the trade mark (for example, a cartoon elephant) this would make it much more likely to be registrable. This is because it is unlikely that another trader will need to use the trade mark as a whole.

Trade marks, business names, company names and domain names

Registration of a business, company or domain name **does not in itself give you any proprietary rights** – only a trade mark can give you that kind of protection.

The same word(s) may be registered by different people as business names and trade marks. However, the registered trade mark owner can take legal action against the business name owner for infringing the trade mark if the business name owner uses it on goods or services similar to those covered by the trade mark registration.

Caution: *When you register your business name, be careful that its use does not infringe someone else's trade mark. It is always wise to search the trade mark databases first. See Searching on page 8.*

A trade mark identifies a product or a service, distinguishing it from the similar products or services of other traders. Registration of the trade mark gives the owner the legal right to exclusively use or control the use of the mark for the goods or services for which it is registered. Registration is obtained under the *Trade Marks Act 1995* and in most cases covers the whole of Australia.

A **business name** is a trading name only. However, a business name is only valid in the state(s) it is registered.

A **company name** identifies a legally incorporated entity. If a company wishes to trade using a name other than its registered company name, it must register that trading name as a business name.

Domain names are site addresses on the Internet. Registration of a domain name gives you exclusive use of that Internet address but only for an agreed period of time.

No proprietary rights in the name are gained through business name, company name or domain name registration in itself.



Trade marks and plants

The name of a plant variety cannot be registered as a trade mark because it is not capable of distinguishing one trader's plants from another.

A plant variety name or a common name for a plant describes a particular plant. However a trade mark does not name any particular plant, it identifies the trade source of the plant, ie the grower, producer or seller.

During examination of your application, your trade mark will be checked to see if it is a variety name recorded on the Plant Breeder's Rights Register. It will also be checked to see if it is in use as the common name of a plant in the trade. You cannot register your trade mark if it occurs as a plant variety name or common name in these searches.

If you require more information on trade mark registration or plant breeder's rights registration, please contact IP Australia on 1300 651 010.

Trade marks and wines

Before choosing a trade mark or designing a label under which wine will be imported, exported or sold on the Australian market, you need to be aware of the requirements of the *Australian Wine and Brandy Corporation (AWBC) Act* and regulations, as well as the requirements of the *Trade Marks Act*.

For more information refer to our brochure for class 33 applications available under Trade Marks forms and publications at **www.ipaustralia.gov.au**. You could also contact either the AWBC via **www.awbc.com.au** or (08) 8228 2000, or IP Australia on 1300 651 010.

Goods & Services

The description of goods or services you provide determines the scope of protection that may be given by registration of your trade mark.

What do you need to list?

It is very important that you think carefully about what goods or services you want protected by your trade mark, as you will not be able to expand your list of goods or services once the application is filed. When considering what goods or services to list, consider the exact nature of your business.

It may be useful to consider the following questions:

- ▶ Where do you derive your business income?
- ▶ What is the nature of your business?
- ▶ What are you known for doing by your customers/clients?
- ▶ What products or services does (or will) your business provide?

Goods and services are divided into 45 classes under the Nice international system of classification. For instance, cars are in class 12, while beer is in class 32. A list of the general headings of the 45 classes begins on page 29. You can find a more detailed explanation about specifying your goods or services on the Trade Marks section of IP Australia's website www.ipaustralia.gov.au. (go to the ATMOSS trade marks search and click on the Goods/Services link). You can contact IP Australia on 1300 651 010 if you require more information on classes for your goods or services.

Searching

You can search the Trade Marks database before using a new trade mark and before filing an application to register it. Identical or similar trade marks for the same or closely related goods or services could block your application for registration. The search could also save you trouble and money by alerting you to existing trade marks which are so similar to the one you plan to use, that you may face legal action from the owners of those trade marks.

When you search the Trade Marks database, look for other trade marks that are identical or similar to your own trade mark, and which relate to similar goods and services.

The Trade Marks database is accessible online in the Trade Marks section of IP Australia's website www.ipaustralia.gov.au. Click on 'Search the trade mark database using ATMOSS' to start your search.



You can also use the facilities at our state offices to search for similar trade marks (see page 27 for contact details). Professional searches are available from patent and trade marks attorneys, legal practitioners and trade mark search firms.

Applicants for business names

If you wish to check whether your business name is identical or very similar to a pending or registered trade mark, IP Australia also provides a search service, the **Business Names Applicant Search Service***.

For further information on this service or to apply for a search, please contact IP Australia on 1300 651 010.

* Please note that this is **not** the same search carried out when examining a trade mark.

Before you apply

It is important to remember that once your trade mark application has been filed and its details published:

- ▶ you cannot substantially alter your trade mark or add goods or services; and
- ▶ **we cannot refund your application fee.**

Please read through this application kit carefully before submitting your trade mark application. Below are some of the more common traps to look out for.

Common mistakes

Applying for the name of your goods or services, or a description of these.

Names and descriptions of products and services are extremely difficult to register as trade marks because other traders have a legitimate need to use these terms to indicate their similar goods or services. Achieving registration is gaining an exclusive right – this is why terms that name or describe goods or services can be extremely difficult to register. For more information, see *What makes a trade mark capable of distinguishing* on page 4.

Applying to register the same or similar sign as a trade mark that is already applied for, or already registered, and covers similar goods or services.

It's a good idea to search the trade mark database (ATMOSS) for trade marks similar to your own before you apply. You need to remember to look for *similar*, not just *identical*, trade marks covering similar goods or services to your own.

Changing your trade mark, or wanting to add goods or services to your application, after details of the application have been published.

Only very minor changes can be made to a trade mark once an application has been filed and published. No goods or services may be added after publication.

Providing a business name or trading name as the owner of the trade mark.

These names cannot own property. The application should be made in the name(s) of the person(s) who own the business name registration, or if the business is an incorporated entity, its company name.

Listing goods or services you do not actually trade in, or omitting the goods or services you do trade in.

Trade mark registration is for the goods or services you *actually* trade in or *intend to trade in* within the near future. Once your application is filed and published, you cannot add any goods or services.

It is important to list the goods or services from which you obtain your income or which you sell or provide to consumers. For example, if your business is to provide cleaning services, you should list cleaning services. Even though you might also display your trade mark on letterhead, business cards, or on the side of your vehicle for promotional purposes, your 'trade' is in cleaning services only.

Listing 'retail services' is also a common mistake. If you are simply selling your own product or a product you have had made for you, then your application should list the product (goods). Retailing is usually only applicable where a large variety of other traders' goods are gathered together in one place for sale to the public, as for example, in a department store.

Common misconceptions

Thinking that simply filing an application (and seeing it appear on the database) means your trade mark is registered.

Filing and publication are initial steps in the process and do not mean your trade mark has been accepted for registration.

Your application will not be registered until it has been examined, any problems resolved, it has been accepted, passed through the opposition period, and registration fees paid.



Assuming that registration of a business name, a domain name or a company name gives rights in that name.

Registration of a business, company or domain name does not in itself give you any proprietary rights – only a trade mark can give you that kind of protection.

Thinking that registration of your business, company or domain name as a business, company or domain name, means that trade mark registration will be automatic.

Requirements for trade mark registration are quite different to requirements for registration of business, company or domain names and different tests will apply. Each is administered by a different body and serves a different purpose.

Thinking that acceptance or registration of your trade mark is the end of the story.

Once your trade mark is advertised as accepted, and for three months after the date of that advertisement, anyone who believes that your trade mark should not be registered may **oppose** its registration. If your application is opposed it is your responsibility to defend this action. Only a very small proportion of acceptances are opposed.

Once your trade mark is registered, it can no longer be opposed. However, action can be taken to **remove** your trade mark from the register if you have not been using it, and action can be taken in the courts to have your trade mark registration **cancelled**. Again it would be your responsibility to defend either of these actions. A very small proportion of registrations will have these actions taken against them. More information about opposition, removal and cancellation is available on IP Australia's website www.ipaustralia.gov.au.

Thinking that IP Australia will monitor use of your trade mark and enforce your rights. It is your responsibility to look after your trade mark, even once it has been registered. IP Australia does not monitor or police the marketplace, nor provide assistance in identifying or prosecuting infringement matters. It is up to YOU to be vigilant in identifying and/or prosecuting infringers.



Entering the application process

Once you have settled on what you consider an appropriate trade mark, and if you wish to seek registration for that trade mark, there are three main ways you can enter the application process.

- ▶ You can **request an assessment** of the likelihood of your trade mark achieving registration through **TM Headstart** (currently only available online via our website www.ipaustralia.gov.au/trademarks/tmhs_start.shtml) **prior** to filing your trade mark application. You can also subsequently file a trade mark application using this service.

Or, you can **apply** to register your trade mark using any one of the following options:

- ▶ To apply for a trade mark online at a discounted fee, visit <http://pericles.ipaustralia.gov.au/ols/tmeform>; or
- ▶ By mail using the paper copy of the application form (standard fees apply), which can be downloaded at www.ipaustralia.gov.au/pdfs/trademarks/tm00001.pdf you can also request a hard copy of this form by calling our Customer Contact Centre on 1300 651 010.

Alternatively, you could consider seeking assistance and/or advice from an IP professional such as a registered patent or trade marks attorney or lawyer experienced in trade marks. These professionals can provide you with commercial advice about trade marks for your business.

TM Headstart

This is a simple and fast service to assess the registrability of your proposed trade mark and is only available online from the IP Australia website **www.ipaustralia.gov.au/trademarks/tmhs_start.shtml**

Checklist before using TM Headstart

- ▶ Have you decided on a trade mark?
- ▶ Do you know the goods or services you want to use your trade mark on?
- ▶ Can we easily contact you (by phone, fax or e-mail) during business hours?
- ▶ Are you prepared to pay the \$90 per class Entry fee, understanding that you will need to pay an additional \$90 per class when/if you decide to complete the filing process for your trade mark?
- ▶ Can you pay your fees online using MasterCard or Visa?
- ▶ Are you aware that your filing date will not be determined until after completion of the TM Headstart process?

For more information about TM Headstart, including the benefits and limitations of the service, please visit the Trade Marks section of IP Australia's website.



Applying for a trade mark

Who can apply?

An applicant for a trade mark must have legal personality and may be an individual, a company, an incorporated association or a combination of these. A business name or trading name is not acceptable as the name of the applicant. If a trade mark is owned by a corporation, the application should be made in the corporation's name and not in the name of directors or shareholders. A Trust is to apply in the name of the Trustees.

An association, whether incorporated or not, may apply for a collective trade mark.

Use

Applicants must use, or intend to use the trade mark in relation to the goods or services identified in the application. If the trade mark is to be used by a body corporate about to be formed, the applicant will need to assign the trade mark to the new body.

Costs

There is a basic fee for filing your application. Additional fees are payable at filing where:

- your application covers goods or services in more than one class; or
- you have applied for a series* of trade marks.

If your application covers goods or services in more than one class, it is called a multiclass application.

If your application is accepted for registration, the appropriate registration fee must be paid before your trade mark can be registered.

* Series — You can apply to register more than one trade mark on one application if the trade marks are essentially the same. To qualify as a series application, the differences between the trade marks must be extremely minor. See the section on 'Trade Marks Fees' for current costs (page 22). Some additional information about series trade marks is included in the instructions for completing the Application Form.

Special trade marks

Applications for trade marks containing or consisting of sounds, scents, shapes, colour or aspect of packaging should be accompanied by a concise and accurate description of the trade mark. All trade marks, including these special trade marks, must be capable of being graphically represented.

How to apply and pay

You need complete an application form, which can be downloaded at www.ipaustralia.gov.au/pdfs/trademarks/tm00001.pdf or obtained by calling our Customer Service Centre on 1300 651 010. Please read the instructions carefully as they will help you complete the form.

Alternatively you can apply online (if paying by credit card) using the online application form on IP Australia's website **www.ipaustralia.gov.au**.

If you have any questions please contact IP Australia on 1300 651 010.

The relevant fees must accompany your application. Please see pages 22 – 24 in this kit for a list of fees.

You may file your completed application with the correct fees:

- ▶ Online (your personal or business credit card will be required when you pay online) at **www.ipaustralia.gov.au**.
- ▶ At our state offices (cash, cheque, money-order, debit or credit card)
- ▶ For the address of your nearest State Office and their opening hours, check our website at:
<http://www.ipaustralia.gov.au/resources/contacts.shtml>
- ▶ By post (cheque, money-order, 'Payment' form for credit card) — to the **Registrar of Trade Marks, IP Australia, PO Box 200, Woden ACT 2606**.
- ▶ By fax (using the payment form for credit card) to our secure business transactions fax **(02) 6283 7999**.
- ▶ Electronic Funds Transfer (EFT) for approved customers only.
To arrange please contact **1300 651 010**.

Cheques should be made payable to IP Australia. We accept MasterCard, Visa.



Care is needed

Please be very careful when completing your application. After you file your application, the goods or services cannot be extended and only very minor amendments are allowed to the trade mark. If you need assistance with filling in the paper or online application forms, or with choosing the correct classes for your goods and services, or with calculating the correct fees, please phone IP Australia during business hours on 1300 651 010, or email **assist@ipaustrialia.gov.au**.

Looking after your application

You can file and look after your own application or you can use the services of a registered patent or trade marks attorney or a solicitor experienced in trade mark matters.

Examination

Applications are examined in order of filing.

The period of time taken between filing and examination of applications can vary considerably due to significant fluctuations in the number of applications lodged at any given time. For the current waiting time, please refer to IP Australia's website at http://www.ipaustralia.gov.au/trademarks/process_howlong.shtml or contact us on 1300 651 010.

If you believe that you will be seriously disadvantaged because of the time taken between filing and examination, you may request that your application be examined sooner. Although there are no fees associated with lodging an application to expedite, it must be accompanied by a Declaration (witnessed) detailing the reasons for your request. Requests are assessed on their individual merit and are more likely to be accepted if any delay in examining your mark is likely to result in a particular commercial or other form of disadvantage.

When your application for registration is examined, it will be assessed to see if it meets the requirements of the *Trade Marks Act 1995*. If your application meets all the requirements, it will be accepted for registration. If not, you will be sent a report setting out any requirements that need to be addressed. You should reply in writing and address the matters which have been raised.

You may ring the examiner to discuss your application and how you might proceed with it. However, IP Australia staff cannot give you legal advice on what are essentially business decisions. You may choose to seek professional advice from registered patent and trade marks attorneys or solicitors experienced in trade mark matters.

Timeframes

The *Trade Marks Act 1995* allows you 15 months from the date of the examiner's first report in which to meet any requirements identified by the examiner and to have your application accepted by the Registrar. If you need additional time, you may request and pay for extensions of time. From 15 to 21 months, extensions will be granted on payment of the appropriate fee, providing the request is made before the date specified in the examiner's report.

Late requests and requests for extensions beyond 21 months must be accompanied by the appropriate fee and must be made on specific grounds. You must also provide a Declaration (witnessed) supporting the ground(s) and setting out the reason(s) why you need further time.

Not all of these late requests or requests for extensions beyond 21 months are accepted, and fees are not refundable.

If your trade mark application is not accepted and it runs out of time, it will **lapse**.

After acceptance of your application

When your trade mark is accepted for registration, the details of the application will be advertised in the *Official Journal of Trade Marks*.

For three months after the advertisement date, anyone who believes that your trade mark should not be registered may oppose its registration.

If your application is opposed it is your responsibility to defend this action. Only a very small proportion of all acceptances are opposed.

If registration of your trade mark is opposed, the opposition process can sometimes be lengthy, complex and costly. If you are considering defending an opposition, you may wish to consider seeking the



assistance of a trade marks attorney or solicitors experienced in trade mark matters.

Oppositions are administered by the Trade Marks Hearings section within IP Australia. More information about opposition proceedings is available on the IP Australia website www.ipaustralia.gov.au or by calling IP Australia on 1300 651 010.

Registration

If no opposition is filed against your application, or if opposition is unsuccessful, your trade mark will be registered when you pay the registration fee. It is in your interests to pay the registration fee as soon as possible. The fee should be paid no later than six months from the date acceptance is advertised.

IP Australia will then send you a Certificate of Registration and record the details of your trade mark in the *Register of Trade Marks*.

Your trade mark will be registered from the date you filed your application, not from the date it was examined or accepted.

The earliest date your trade mark can be registered is seven and a half months after an application is filed. This fulfils our international obligations to allow six months for applicants to claim a priority date based on an overseas filing.

Can someone oppose my trade mark even after registration?

No, however there are actions that can be taken against a registered trade mark.

Removal action — Another person can apply for your registered trade mark to be removed from the Register because you have not used your trade mark or because your use of the trade mark has not been in good faith. If you do not oppose the removal action, your trade mark will be removed. **It is your responsibility to defend your trade mark registration by opposing the removal action and providing evidence of your trade mark use.**

Court action — Another person can apply directly to a court for a court order to remove or cancel your trade mark registration. **Again it is your responsibility to defend your trade mark registration.**

Warning — unofficial register/services

Trade mark owners may be sent unsolicited documents from companies which offer, for a fee, to register trade mark information for the implied purpose of protecting trade mark rights. Some of these companies identify themselves as

- ▶ **Globus Edition SL, Palma de Mallorca, Spain**
- ▶ **Company for Economic Publications Ltd, Vienna, Austria**
- ▶ **IT & TAG, Switzerland**
- ▶ **Company for Publications and Information Anstalt, Liechtenstein**
- ▶ **INFOCOM, Schaan, Switzerland**
- ▶ **Edition The Marks KFT**
- ▶ **International Bureau for Federated Trademark & Patent Register**
- ▶ **Gaia Almanach LTD**
- ▶ **Commercial Centre for Industry and Trade, Switzerland**
- ▶ **European Institute for Economy and Commerce EIEC, Belgium**
- ▶ **Institute of Commerce, Trade and Commerce, Switzerland**
- ▶ **TM Collection, Hungary**
- ▶ **ZDR - Daten register GmbH, Germany**
- ▶ **Register of International Patents and Trademarks (RIPT)**

These companies are sending documents resembling invoices to trade mark owners which offer 'entry' of trade mark details in an annual publication. They are usually sent after the trade mark details have been advertised in the Official Journal.

These companies **are not** associated with IP Australia and have no official or governmental authority. The service they offer does not provide official trade mark registration or trade mark rights in Australia or any other country.

At any stage

At any stage after filing your application, you may apply in writing to record

- ▶ changes in the details of your application/registration.
Note: Goods or services cannot be extended and only very minor amendments are allowed to the trade mark itself.



- ▶ another party's claim of interest to, or right in, your trade mark; or
- ▶ an assignment or transmission of your trade mark to another party.

Important points

- ▶ The name and address of the applicant(s) will be published on our database and will be available on the Internet.
- ▶ In some circumstances, other information in relation to the prosecution of your application may be made available, upon request, to third parties.
- ▶ A trade mark does not have to be registered. However if you use an unregistered trade mark, we suggest that you search our database of registered and pending trade marks (www.ipaustralia.gov.au). This will help ensure that you do not inadvertently infringe the rights of registered trade mark owners.
- ▶ Although TM can be used with your trade mark at any time, ® can only be used with a registered trade mark.
- ▶ A trade mark is not registered as soon as the application is filed. The application must be examined first. You cannot claim that the trade mark is registered until you receive the Certificate of Registration.
- ▶ If your trade mark is registered, the protection given by registration is from the date you filed your application — not from the day it was examined or accepted.

Remember

You **must** have an address for service in Australia. All correspondence from this office will be sent to that address and it is very important that you advise us whenever you change that address.

Renewal

The initial period of registration of your trade mark lasts for ten years from the filing date.

Registration of your trade mark can be renewed within 6 months before or after its expiry date. Late fees apply if the registration is renewed after the expiry date.

Two months before the expiry date we will send a reminder notice to your address for service telling you how to renew your registration. Therefore it is important that you notify our office if your address for service changes.

The Registrar will renew your trade mark registration when the renewal fee is paid.



Protecting your trade mark

Infringement

It is your responsibility to protect your trade mark. If someone uses your trade mark without your permission, they may be infringing your trade mark and you should seek legal advice as soon as possible. IP Australia grants trade mark rights but does not police or enforce those rights.

Infringement of trade marks on the Internet

Doing business over the Internet has significant implications for owners of registered trade marks, because of the possibility of inadvertent infringement of trade marks registered in other countries. Many trade mark owners do not realise when they begin trading over the Internet that they are entering a global marketplace. Registration of a trade mark in Australia does not give any rights in relation to that mark overseas. If you offer goods or services for sale via the Internet, you may be sued for infringement in a country where someone else owns the trade mark.

To minimise the risks of liability arising from unintentional Internet infringement Australia recently joined other member states of the World Intellectual Property Organization (WIPO) in establishing guidelines designed to protect trade mark owners who trade over the Internet. (The text of the guidelines and explanatory notes are contained in document SCT/7/2, which is located at www.wipo.int/meetings/en/doc_details.jsp?doc_id=1922)

Trade mark owners need to be aware of the potential risks they face when trading over the Internet. You should seek legal advice on the best ways you can avoid or minimise those risks. Most importantly, you should seek legal advice if you receive notice from an overseas trade mark owner alleging that you are infringing their trade mark via the Internet.

Trade mark owners contemplating trading over the Internet should also consider the potential benefits for their business of applying for registration of their trade mark overseas. (See **International Trade Mark Registration**, on page 21.)



Generic use

Once registered, it is important to ensure that your trade mark continues to be regarded as a trade mark. If your trade mark becomes known as the generic name for your goods or services and ceases to be recognised as a trade mark, an application to the courts to have the registration cancelled may be successful.

Removal of trade mark from Register for non-use

A person can apply to have your trade mark removed from the Register. Such applications can be made if you have not used your trade mark for a period of three years, or if you have not used your trade mark and you had no intention of using the trade mark when the application was filed. The person applying for removal is often a trade mark applicant whose registration is being hindered by your registered trade mark. **If you do not oppose the removal action, your trade mark will be removed.**

Objecting to importation of goods

You can give a notice to the Australian Customs Service, objecting to the importation of goods which infringe your registered trade mark.

For more information please contact the Australian Customs Service on 1300 363 263.

International trade mark registration

Do you want protection for your trade mark overseas?

There are two different ways Australian trade mark owners can seek trade mark protection overseas. An application can be filed directly with each country, or a single international application can be filed through IP Australia nominating the countries in which protection is required. This single international application operates under the Madrid Protocol and there are more than 65 member countries party to the Madrid Protocol.

If you are interested in finding out more about international applications then you should visit our website **www.ipaustralia.gov.au**.



Trade marks fees

Please note that these fees are subject to change. GST does not apply to these statutory fees under Division 81 of the GST Act 1999.

TM Headstart

Submission of a TM Headstart request — these are the fees that apply at the time of submitting the request, for changes requiring a re-assessment, and for filing a trade mark application resulting from a TM Headstart request:

Part 1 (Entry) fee:	\$90 per class
Re-assessment fee:	\$90 per class
Part 2 (Filing) fee:	\$90 per class

The TM Headstart entry fee is payable only online. Re-assessment and Part 2 fees are payable online or over the phone with an IP Australia staff member during business hours. Once you have paid the Part 2 fee, subsequent standard trade mark fees apply.

Applying

These are the basic fees that apply to a typical application only.

There are a number of other fees that apply to other actions that may be required on your trade mark application.

Application for registration of a trade mark — these are the fees that apply at time of filing (except for online filing — see below):

Application to register a trade mark	\$180 per class
Application to register a series of trade marks	\$330 per class

* There are additional conditions which series applications must meet — see page 13.



Online filing

A reduced fee applies only when filing your application online using the official online form which is available at www.ipaustralia.gov.au.

Application to register on-line using the official Goods & Services pick-list	\$120 per class
Application to register on-line not using the official Goods & Services pick-list	\$160 per class
Application to register a series of trade marks on-line using the official Goods & Services pick-list	\$270 per class
Application to register a series of trade marks on-line not using the official Goods & Services pick-list	\$310 per class

* There are additional conditions which series applications must meet — see page 13.

Registering

Registration of your trade mark occurs after your trade mark has been examined, accepted for registration and has passed through any opposition. A trade mark is initially registered for a period of ten years (from the original filing date) and continues indefinitely as long as the renewal fees are paid.

Registration fees, which must be paid within six months of acceptance, are:

Registration of a trade mark	\$250 per class
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Renewing

Registrations continue as long as the renewal fees are paid every ten years:

Renewal of registration of a trade mark	\$300 per class
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Please note: These fees are correct at the time of publication, however fees may change from time to time. Please visit www.ipaustralia.gov.au/trademarks/fees_index.shtml or call IP Australia's Customer Service Centre on 1300 651 010 for up to date information on fees.

Fees payable when registering in more than one class

You may, for example, want to apply to register a trade mark for perfume, clothing and sunglasses.

Perfume is in class 3, clothing is in class 25, and sunglasses are in class 9.

You should file a multiclass application covering classes 3, 9 and 25.

There are 3 classes so the fee you would have to pay at filing is \$540 (\$180 x 3), or \$360 (\$120 x 3) if filing online using the official online form with the goods and services pick list.

If your trade mark is accepted for registration you would then have a registration fee to pay. This would be \$750 (\$250 x 3).

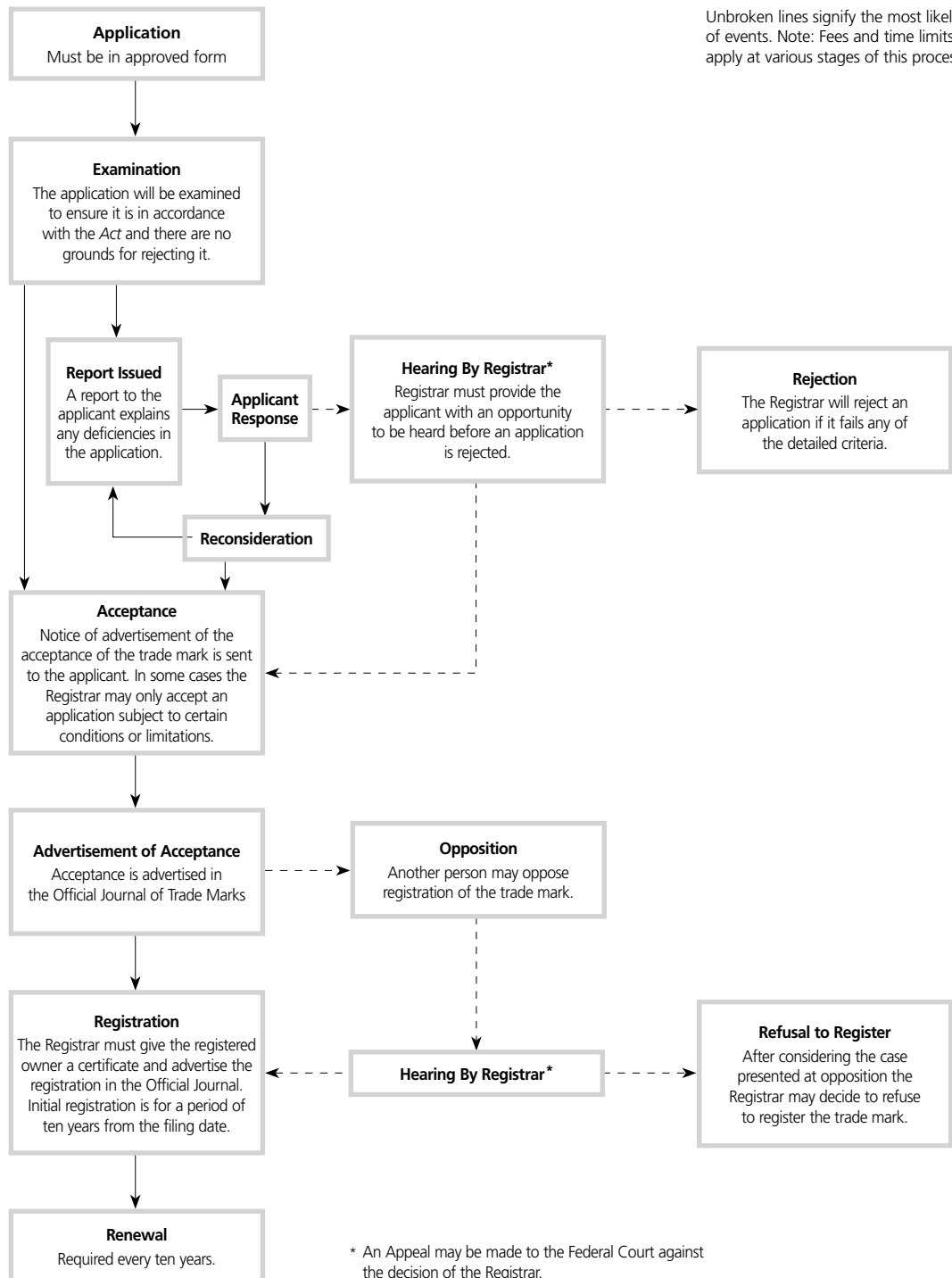
(*These fees are correct at the time of publication)

A list of the general headings of the 45 classes begins on page 29.

For extra assistance in choosing the correct classes for your goods or services, or for up to date fees information please contact IP Australia on 1300 651 010 during business hours, or email assist@ipaustralia.gov.au



Flowchart of an application



Unbroken lines signify the most likely course of events. Note: Fees and time limits may apply at various stages of this process.



Contacting *IP Australia*

IP Australia staff are happy to help you and answer your queries. However we cannot assist clients on legal matters or provide business advice. You may wish to consult a registered patent or trade marks attorney, a solicitor experienced in intellectual property matters, or your business advisor.

IP Australia subscribes to the **Telephone Interpreter Service**. If you need help communicating in English, you can phone the interpreter service on 131 450 for the cost of a local call from anywhere in Australia. We also have a TTY number for hearing impaired customers. Phone (02) 6283 2363 to use TTY.

All written correspondence regarding trade marks should be directed to The Registrar of Trade Marks.

Postal address: **PO Box 200, WODEN ACT 2606**

Phone: **1300 651 010**

General Enquiries—contact IP Australia for general information relating to patents, trade marks, designs or plant breeder's rights and for assistance with subscriptions, sale of publications and electronic communication.

Fax: **(02) 6283 7999**

Business Transactions Fax—for lodgement, filings and business related correspondence such as financial and confidential material. Faxes received at this secure number are receipted at Australian Eastern Standard/Daylight Saving time.

Email: **assist@ipaaustralia.gov.au**—for general enquiries. However, filing of documents and payments are not available through this address.

Website: **www.ipaustralia.gov.au**—for information relating to intellectual property, to submit online applications, and to download forms and other documents.



State Offices

Our state offices are open from 9am - 5pm Monday to Friday (excluding public holidays). We have an office in the following capital cities:

Adelaide; Brisbane; Canberra; Hobart; Melbourne; Perth and Sydney

For the address of your nearest State Office check our website at <http://www.ipaustralia.gov.au/resources/contacts.shtml> or call 1300 651 010

Customer Service Charter

Customer Service Charter

IP Australia is committed to being a customer-focused organisation. Our Customer Service Charter outlines our service level commitments to customers and we measure our compliance each quarter. For more information and to read our charter online, go to **www.ipaustralia.gov.au/service**, or phone **1300 651 010** to obtain our Charter booklet.

Communicating electronically with IP Australia

The date which you provide information to IP Australia can be critical to the certainty of your intellectual property rights.

IP Australia has implemented a set of business rules which establish that when you communicate with us electronically (eg. email, fax or online) using our preferred contact numbers and methods, the date and time of communication will be Australian Eastern Standard/Daylight Saving time.

Our preferred means of electronic communication are:

- ▶ IP Australia's website—**www.ipaustralia.gov.au**;
- ▶ our business transactions fax number—**(02) 6283 7999**; or
- ▶ email—**assist@ipaustralia.gov.au**

Communications sent to other contact points electronically will be processed in accordance with the date and time at the place of receipt. These communications will not gain the benefits provided by the *Electronic Transactions Act* such as security and certainty of receipt.

The *Electronic Transactions Act* business rules address a range of issues including:

- ▶ identifying the appropriate form of electronic communication to use for different types of correspondence;
- ▶ choosing electronic payment options;
- ▶ receiving notifications; and
- ▶ utilising supported electronic formats.

Further details on IP Australia's electronic communication business rules can be found at **www.ipaustralia.gov.au/pdfs/general/eta.pdf**



Classes of goods and services

Please note: If your goods or services are not listed, or you need help completing the application form, contact IP Australia by phone on 1300 651 010, or by email at assist@ipaaustralia.gov.au.

Classes of goods

1. Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry
2. Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colourants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists
3. Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices
4. Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks for lighting
5. Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides
6. Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores
7. Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand operated; incubators for eggs
8. Hand tools and implements (hand operated); cutlery; side arms; razors
9. Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus
10. Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials
11. Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes
12. Vehicles; apparatus for locomotion by land, air or water
13. Firearms, ammunition and projectiles; explosives; fireworks
14. Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments
15. Musical instruments
16. Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks
17. Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal

18. Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery
19. Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal
20. Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics
21. Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except glass used in buildings); glassware, porcelain and earthenware not included in other classes
22. Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastic); raw fibrous textile materials
23. Yarns and threads, for textile use
24. Textiles and textile goods, not included in other classes; bed and table covers
25. Clothing, footwear, headgear
26. Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers
27. Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile)
28. Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees
29. Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats
30. Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice
31. Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt
32. Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages
33. Alcoholic beverages (except beers)
34. Tobacco; smokers' articles; matches

Classes of services

35. Advertising; business management; business administration; office functions
36. Insurance; financial affairs; monetary affairs; real estate affairs
37. Building construction; repair; installation services
38. Telecommunications
39. Transport; packaging and storage of goods; travel arrangement
40. Treatment of materials
41. Education; providing of training; entertainment, sporting and cultural activities
42. Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software
43. Services for providing food and drink; temporary accommodation
44. Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services
45. Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals



Australian Government

IP Australia

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