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Legal innovation

Trade mark registration process in Australia

Trade marks are an essential form of communication to consumers. They act to identify the source of goods and/or services and in doing so can create favourable brand statements as to quality, prestige and exclusivity. Many consumers base their purchasing decisions on these statements which can be represented in a variety of ways including on swing tags, labels, packaging and promotional material.

A successful trade mark will create strong consumer loyalty and spark demand in the market place which is translated into the goodwill of the business. The goodwill generated from a trade mark is a key indicator in sales revenue figures and is reflected on the balance sheet. Trade marks are a valuable business asset and it is vital they are protected.

The easiest way to protect a trade mark is to register it with the Australian Trade Marks Office. An Australia trade mark registration offers exclusive rights Australia wide to use the trade mark in respect of the goods and/or services in the registration and, among other rights, allows a registered owner to prevent the use of a similar trade mark in respect of similar goods and/or services to those in the registration.

Searching

Prior to filing a trade mark application, it is important to find out if the trade mark is available for both use and registration in Australia. A similar trade mark that is already filed or registered with the Australian Trade Marks Office may act as a block and prevent a later trade mark application from being accepted for registration.

The earlier application or registration may also represent an infringement risk if the applicant continues to use an unregistered trade mark. There are three common searches we can conduct to indicate or ascertain the availability of a trade mark:

- **Identical search:** a preliminary search as to whether the identical trade mark is registered or pending in Australia. This search gives some indication as to whether there could be blocks to registration or risks of infringement if the trade mark is used without registration. The cost of conducting an identical search is \$275 and preparation of an availability report outlining the findings (if any) of the search is \$550 per trade mark.

If you would like more
information on registering a
trade mark, please contact:

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- Availability search: a comprehensive search as to whether together with our recommendation as to the best way to protect the trade mark based on the search results there are any likely blocks to registration. This search does not examine the risk of infringing unregistered trade mark rights. The cost of a availability search is \$825 for standard results and \$990 for complex results.
- Freedom to operate search: a complete availability search as to whether the use of a trade mark is likely to infringe another's registered or unregistered trade mark rights and whether there are any likely blocks to registration. The cost of a freedom to operate search is \$1,320 for standard results and \$1650 for complex results.

We provide our clients with expert registrability advice to put them in a position to make commercial decisions relating to the use of their trade marks in Australia.

In addition to the above searches, it is possible to obtain a preliminary determination from the Australian Trade Marks Office. The office will conduct its own preliminary registrability search and provide the results in five working days. In certain circumstances, a preliminary determination can be obtained instead of conducting infringement and availability searches and we can advise further on this strategy.

Classes and fees

A trade mark can be registered in respect of goods and/or services categorised into 45 different classes. All possible goods and services of which registration can be obtained are allocated a class.

Prior to filing a trade mark application, a description of goods and services, also known as a 'specification', must be drafted which identifies each and every individual good and/or service in respect of which registration is sought. Trade mark applications must contain the specification and also identify the class numbers of the goods and/or services in the application.

We assist with the preparation of the specification based on how the applicant is using, or intends to use the trade mark so that broad protection is obtained. The cost of drafting a specification is calculated on a time basis and can take between one to three hours depending on the complexity of the application.

The number of classes in an application drives the cost of a trade mark registration. The below table sets out the cost of registering a trade mark in a number of classes, including IP Australia's fees, our professional fees and GST, and illustrates the incremental cost increase per class.

Classes	Application	Registration	Total
1	\$1210	\$550	\$1760
2	\$1815	\$825	\$2640
3	\$2420	\$1100	\$3520
4	\$3025	\$1375	\$4400

The above costs do not include any responses to correspondence issued by the Trade Marks Office, including receiving, reporting and responding to an Examiner's Report containing objections to registrations.



The application process

Once an application is finalised, it will be filed at the Australian Trade Marks Office. As set out in the diagram below, the Australian Trade Marks Office will take up to four months to examine the application, at which point, the office will either accept the trade mark for registration or issue an Examiner's Report. An Examiner's Report will contain the grounds the Examiner relies on to reject the application for registration. If an Examiner's Report is issued, it is necessary to file legal submissions to persuade the Examiner to withdraw its objections.

Once an application is accepted for registration, a two month opposition period begins. Any person may oppose the registration of a trade mark within the opposition period. If no oppositions are filed, the application will proceed to registration upon payment of the registration fees. The registration obtained is a property right and can be continually



International protection

An Australian trade mark registration only provides protection for use within the borders of Australia. If goods are being manufactured overseas, goods and/or services are being offered over the internet or international business expansion is a possibility, we recommend considering trade mark protection in overseas jurisdictions. We can assist with the international protection of trade marks. We are experienced in filing international trade mark applications using the Madrid Protocol and we have a trusted network of overseas agents that we use to file trade mark applications directly with the Intellectual Property Office of each country. We also have expertise in formulating a tailored filing strategy for international applications that is cost effective and meets the specific requirements of our clients.

For more information relating to the trade mark application process or trade mark

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