

# Protecting a trade mark in Australia

A trade mark may be a word, phrase, letter, number, sound, smell, shape, logo, picture or aspect of packaging used to distinguish your goods or services from those of other traders.

## Rights of a registered trade mark owner

The owner of a registered trade mark has the exclusive right to use, or authorise others to use, the trade mark in Australia for the goods and services for which it is registered. A registered trade mark owner is also entitled to take legal action to prevent unauthorised use of the trade mark.

Trade mark registration is not compulsory in Australia, however, it is strongly recommended because a registered trade mark is much simpler and more economical to enforce than unregistered rights.

## Pre-filing considerations

Anyone with a valid claim to ownership can apply to register a trade mark in Australia. However, applicants must use, or have an intention to use, the subject trade mark in relation to the goods or services included in the application.

When choosing a trade mark, applicants should avoid a mark that:

- describes the kind, quality, intended purpose or value of the goods or services;
- misleads the public about the nature of the goods or services;
- is a geographic name or a common surname;
- is similar to an existing mark which is used for similar goods or services; or
- is similar to an existing mark registered for similar goods or services.

It is therefore prudent to conduct a preliminary availability search to confirm whether a particular mark is free to use and register in Australia. Watermark provides pre-filing availability search services and valuable advice on filing strategies for clients seeking trade mark protection in Australia.

## From filing to registration

The Australian Trade Marks Office examines applications about three to five months after filing. If any issues are raised, the Office will issue an examination report. Applicants have 15 months within which to resolve any issues raised in an examination report, however, this deadline may be extended upon payment of fees.

If accepted, the details of a trade mark application will then be advertised in the Official Journal, which triggers a two month opposition period. If no opposition is filed, or no opposition is successful, the trade mark will proceed to registration. Following registration, trade mark rights accrue from the date the application was originally filed.

If no issues are raised during examination and no third party oppositions are filed following acceptance, the minimum time frame from filing to registration of a trade mark in Australia is around seven months.

## Maintaining a trade mark registration

Australian trade mark registrations remain valid for 10 years from the filing date, and may be renewed thereafter every 10 years upon payment of applicable fees.

It is important that registered trade mark owners use their trade marks to avoid potential cancellation of their registration for non-use.

## Victoria

T +61 3 9819 1664

## New South Wales

T +61 2 9888 6600

## Western Australia

T +61 8 9325 1900

E [mail@watermark.com.au](mailto:mail@watermark.com.au)

W [www.watermark.com.au](http://www.watermark.com.au)

B [www.intellectualassetmanagement.com.au](http://www.intellectualassetmanagement.com.au)

Twitter [@WatermarkIP](https://twitter.com/WatermarkIP)

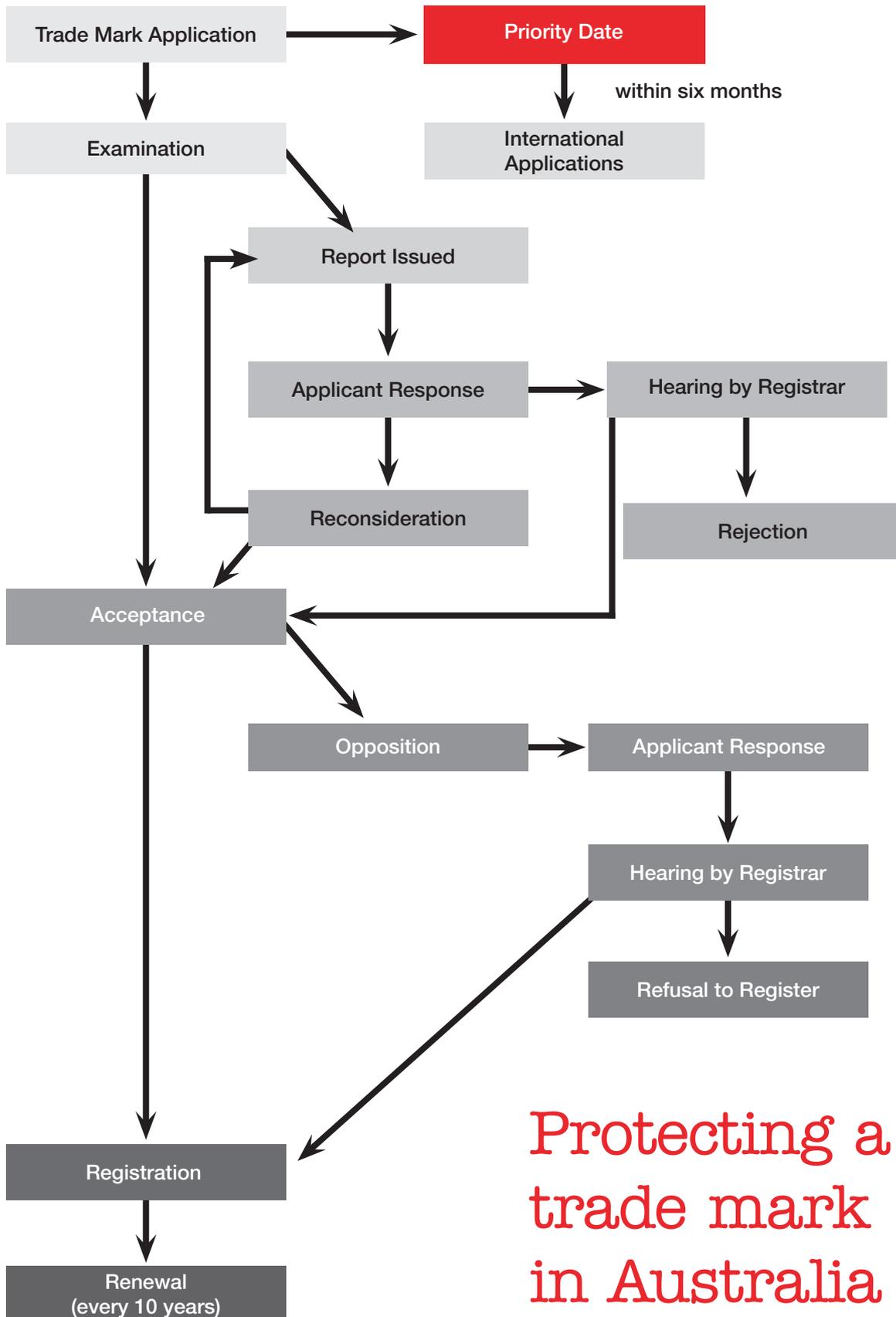
LinkedIn [Watermark Intellectual Property](https://www.linkedin.com/company/watermark-intellectual-property)

Trade  
Marks

The diagram overleaf shows in a simplified form, a process for obtaining trade mark protection.

For more information on Watermark's comprehensive range of intellectual property services please contact [mail@watermark.com.au](mailto:mail@watermark.com.au)





Protecting a trade mark in Australia