

Trade mark searching and watching

Searching

When you are adopting a new trade mark it is prudent to conduct an infringement/availability search prior to commencing use of a trade mark in a particular jurisdiction.

Conducting such a search has dual benefits in that it

- i. identifies whether there is a risk of trade mark infringement associated with adopting the proposed mark and
- ii. provides an indication of the likelihood of being able to secure a trade mark registration for the proposed mark.

It is self-evident that it is sensible to have an infringement/availability search conducted prior to significant funds being expended on pre-launch marketing and labeling. Once the results of a search indicate that a proposed mark is available to be used and registered it is then sensible to immediately file a trade mark application to ensure that another party does not file a conflicting application in the interim.

Watermark is able to directly file trade mark applications in Australia, New Zealand and Papua New Guinea, and is also able to file international trade mark applications (under the Madrid Protocol) designating up to as many as 75 countries (including various European countries, China, Japan and United States). Where applicants wish to file separate national applications in foreign jurisdictions we are able to use the services of a suitable associate.

Searches Performed by Watermark

Australia

Our standard infringement/availability search includes a comprehensive search of the online records of the Australian Trade Marks Office, a review of the results obtained and the opinion of a trade mark practitioner as to whether there are any risks associated with adopting a mark in this country and whether it may be registered.

Our standard infringement/availability search also includes a number of other searches which are intended to provide an indication as to whether another party might potentially have common law rights (ie rights acquired merely by using a mark in trade) of relevance. Such common law searches include a search of the Australian Securities and Investments Commission's (ASIC) database for relevant company/business names, domain name registries and product/trade names guides, as well as various other databases where appropriate. If these common law searches identify an entity that warrants closer investigation it is then possible for Watermark to instruct an investigation service to undertake additional enquiries.

Overseas

If it is intended to export a product (or service) bearing a trade mark to another jurisdiction it is equally important to conduct an infringement/availability search in that jurisdiction and to seek trade mark registration where available. Watermark has access to the online records of various Trade Marks Offices throughout the world including New Zealand, United Kingdom, members of the EU, United States and Canada and is thus able to conduct searches in these countries without using the services of a foreign associate. Naturally where issues arise that require a detailed understanding of trade mark law in a particular jurisdiction we recommend that we contact a suitable associate for a second opinion. Where Watermark does not have direct access to the online records of a particular country (or where no online records exist), we work closely with an associate with whom we are familiar in order to provide a reliable and cost-effective service.

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

W www.watermark.com.au

B www.intellectualassetmanagement.com.au

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

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

Trade
Mark
searching

See overleaf for
Watching

For more information on Watermark's comprehensive range of intellectual property services contact mail@watermark.com.au



Trade mark searching and watching

Watching

The renown and goodwill associated with a trade mark (or a brand name as it is often known) can represent a valuable asset within a business. It is important to keep your trade marks strong.

Brands are usually protected via extensive marketing campaigns and it stands to reason that you would wish to protect that investment. From a trade mark perspective, this is best done by:

- i. ensuring that the trade mark does not conflict with the rights of other entities,
- ii. seeking and obtaining a trade mark registration as soon as possible,
- iii. correctly using a trade mark to ensure that it does not become recognised as the name of a product or service (ie become a generic term),
- iv. maintaining the trade mark's reputation by maintaining the price and quality of the products or services in respect of which the trade mark is used,
- v. preventing use of identical or deceptively similar trade marks on the same or similar goods or services, and
- vi. preventing registration of identical or deceptively similar trade marks for the same or similar goods or services.

Vigilance

Item (v) is important because if another party adopts and uses an identical or similar trade mark and is permitted to use that mark, the party will gradually derive its own rights that, in time, will potentially permit the party to obtain its own trade mark registration (ie via the honest concurrent use provisions of the Trade Marks Act 1995). The use of an identical or similar mark by another party will also potentially dilute the commercial magnetism associated with the original trade mark and possibly lead to deception and confusion arising in the marketplace.

Item (vi) is important to the extent that once a party obtains a trade mark registration it has a statutory defence to infringement (at least as far as Australia is concerned) and thus may use the trade mark with impunity. Once a trade mark registration has been obtained, the only way of preventing ongoing use of the mark would be to seek cancellation of the registration via legal proceedings.

So prudent trade mark owners should take steps to prevent ongoing use and registration of identical or deceptively similar trade marks by other parties (in respect of identical or similar goods or services). The best way to do this is to conduct a periodic watch of the Trade Marks Register for any applications which might potentially represent a conflict. Such a watch has dual benefits in that it (i) potentially identifies at an early stage that a party has commenced use of a similar mark or is proposing to commence use in the future so that intervening steps may be taken by the trade mark owner and (ii) places the trade mark owner in a position to file a Notice of Opposition in the event that the application is accepted during the examination process.

While it is important to maintain a watch on the Australian Register, it is also desirable to maintain a watch in those countries where an Australian business has export interests. This is particularly important for countries and systems where examination does not include a search of the Register for prior conflicting applications/registrations such as, for example, France, Germany and Italy, as well as the European Community Trade Mark system.

Watches Performed by Watermark

Watermark is able to tailor its watching services to address the specific needs of its clients. Traditionally watches are tailored to identify the lodgement with the Australian Trade Marks Office of applications for trade marks which might be considered as identical or deceptively similar to a designated trade mark. However, it is also possible to maintain a watch on a particular application number, a particular applicant or a particular trade mark class. Watches can also be conducted throughout the world and where Watermark is unable to directly conduct a watch in a particular country it uses the services of a cost-effective associate.

Readers wishing to obtain further information about watching should contact their Watermark attorney.

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