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PROTECTING YOUR TRADE MARK

Protecting your trademark is like coaching a successful football team—you need both a good offence and a good defence.

The offence starts with selecting a trade mark that you will be able to protect – this means spending the time to create or select a trade mark that will be hard for competitors to steal or copy.

Generic terms like "hot dogs" or "orange drink" are not protectable by trade mark. Names that are descriptive such as "Speedy Boat Hire" are potentially trademarkable, but are weak. You'd have a hard time defending them in court from a competitor who came up with a similar name.

You would get stronger protection with "suggestive" names—ones that creatively convey the unique nature of your business without stating exactly what your business is, such as "Banana Boat" for a suntan lotion, "Fasta Pasta" for an Italian restaurant chain, or "Blu-ray" for a laser disk player that uses a blue laser light.

The strongest and the best trademark protection comes from trade marks that are considered "fanciful" or "arbitrary." Arbitrary trade marks are ordinary English words that are used in a completely different context. Examples being "Apple" as the name of a computer or "Orange" as a musical instrument amplifier or "Dove" for chocolate.

Fanciful marks are names that are inherently distinctive because they're newly invented. You can find examples of them everywhere – from "Viagra" to "Smiggle".

Another form of protection in choosing a good trade mark is making sure that no one else is already using it. You could do a quick search on the IP Australia website. But that won't show you common-law trade mark use by businesses with a better right to a trade mark than you because they were the first to use it, even though they may never have got around to registering it. That's why we recommend a comprehensive search be undertaken before you apply for your trade mark.

The defence comes once you have begun using your trademark—and involves three strategies:

1. Using your trade mark correctly

Once you've got a trade mark registered you need to protect it by using it.

You should pay your renewal fees to IP Australia every 10 years to avoid your trade mark lapsing. Also, be sure to display the little R in a circle on your products and marketing materials which shows you have a registered trade mark. You don't need to include that little R every single time you mention your business's name. However, you should display it a lot, particularly in prominent places such as on your packaging and advertising and on signage outside your business, as well as on any publications. Most smart businesses display the little R at least 50% of the time.

You should also make sure that you assert your trade mark as a brand and not as a generic description of your goods and services, otherwise you could lose protection. This has occurred with words that were originally trade marks,



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such as “escalator”, “zipper”, “cornflakes” and “aspirin”. Today big brands like Xerox and Kleenex and Hoover work hard to remind the public that they are a brand, not a product category or description.

Also make sure that your “use” of the trademark is identical to the trade mark you have registered.

2. Police your trade mark

The best approach is to routinely monitor other businesses’ use of wording or images similar to yours so that you can identify any trade mark infringement early.

Some monitoring will likely happen naturally in the daily course of business as you keep an eye on your competitors’ comings and goings. You can also check for infringements yourself with Google Alerts or other search engines by instructing them to notify you on an ongoing basis about news stories and new websites that mention your trade mark including misspelled versions of your trade mark.

You can also engage us to provide a trade mark watching service for you.

3. Enforce your trade mark

If you find a possible infringement of your trade mark, you'll need to decide whether to go after the infringer and how aggressive you are prepared to be in enforcing your trade mark. This will partly depend on how strong your trade mark is and your likelihood of succeeding as well as your financial capacity to pay to enforce your trade mark.

Some trade marks infringement, whilst technically an infringement, may be minor or may occur in a business area where you do not trade and do not intend to trade. Accordingly, unless you have the budget of a McDonalds you may want to let such minor infringements go.

When you need to enforce your mark, have your lawyer draft a cease-and-desist letter. The tone of that letter would be dependent upon your financial capacity and your willingness to litigate. If your resources and resolve are limited the letter may ask that infringer to stop but may indicate that you would be prepared to live with a coexistence agreement, such as an agreement that the infringer will not operate in your geographic area or your particular business niche.

Whatever happens, if you let infringements of your trademark continue without any response at all, you risk losing the legal right to that trade mark. You should take some action even if it is only limited. Otherwise if you later decide to protect your trade mark if you haven’t taken you trade mark seriously it is unlikely that the Federal Court would be convinced to take your trade mark seriously.

4. Consider registering in foreign countries if selling your goods or services overseas

Registering your trade mark in Australia gives you exactly that – protection of your trade mark in Australia and its territories. If you are intending to market your goods or services overseas, particularly on the internet, it may be worth applying to register your trade mark in the countries in which you intend to trade.

There is unfortunately no such thing as a ‘global’ trade mark. However, almost all countries in the world now allow people and businesses in other countries to register trade marks in their jurisdiction.



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Further, almost 70 countries, including the United States, China and the European Union, belong to an organisation under the Madrid Protocol which allows people and businesses in member countries to apply for trade marks in their jurisdictions directly from their own member country. Australia is a member of the Madrid Protocol.

5. Do not change the spelling of your trade mark

One quick way to lose the protection of your trade mark is for you to use different variations of your trade mark including different spelling. In order to maintain protection you should always use the trade mark with the spelling exactly as registered on the Registry of Trade Marks and, if you want to change the spelling, make sure that new spelling is available to you and register that first.

6. Do not change the appearance of your trade mark

For the same reasons as above, changing the appearance of your trade mark, even just a little, can cost you the protection of the trade mark. If you want to change the appearance, say a different or varied logo, you should register the new variation first.

7. Apply your trade mark directly to your products

Even though this sounds obvious it is easy to make the mistake of applying your trade mark to your packaging and advertising but forgetting to apply the trade mark to the actual goods.