

ENTREMARK PRESENTS.....

“THE PROCESS OF REGISTRATION OF A TRADE MARK”

The essential features of a trade mark are:

- it is a name, symbol or logo;
- it is not descriptive of the goods or services to which you intend to apply it;
- it does not include a place name, such as Brisbane or Australia etc;
- it must be "capable of distinguishing" your goods or services from those of other traders;
- you were the first to use it in connection with those goods or services;
- it provides you with a monopoly in the name, and the right to prevent others from using it in connection with goods or services similar to yours.

The best names to trade mark are those that are:

- words that are made up (eg. Kodak); or
- words that have no connection with the product or service you wish to use them in connection with (eg. Apple Mac).

Applications

Applications are to be made in accordance with s.27 of the *Trade Marks Act* 1996, as follows:

- The applicant must be the owner of the trade mark and:
 - using the mark; or
 - an authorised user; or
 - a body corporate to whom the mark has been assigned for use
- the application must be filed in the prescribed form and in accordance with the regulations;
- the application is to include a representation of the trade mark;
- the application is to specify the classes in which the mark is to be registered and identify which goods and services within the class in respect of which registration is sought;
- the application may cover multiple classes (although multiple fees are payable accordingly);

Examination

Following lodgement of the application, the Registrar must examine it. He must accept the application (s.33(1)), unless:

- the application was not made in accordance with the Act; or
- there are other grounds to reject it.

The Registrar has absolute discretion in relation to which classification the goods and services should be registered in. There is no appeal from this decision (s.32).

If the Registrar rejects the application, the applicant has the right to make a response, and if still unsatisfied, to apply to the Federal Court (s.35).

Report

If the Registrar does not accept the application, a report is issued to the applicant which explains the deficiencies in the application. Upon receipt of the applicant's response, the Registrar may then:

- accept the application;
- provide the applicant with further opportunity to respond before finally rejecting the application.

Again, this decision may be appealed to the Federal Court.

Acceptance

A notice of acceptance is sent to the applicant and the mark is advertised in the Official Journal of Trade Marks.

Following advertising the mark may be either:

- registered upon payment of the required fee; or
- opposed.

Opposition must be in the approved form and filed within the prescribed period, with the Trade Mark Office (s.52).

Registration and Renewal

Registration is for a period of 10 years. It may be renewed for successive periods of 10 years, providing renewal fees are paid.

Removal for Non-Use

Trade marks must be used in order to remain registered. Application for removal of a mark for non-use can be made at any time after the expiry of 5 years from the original filing date (s.93(2)).

There are other grounds for removal also (s.92(4)).

Convention Priority Applications

Registration may be sought in any convention country to be effective from the date of the filing of the application in Australia, if application in that other country is made within 6 months of the filing of the Australian application (s.29).

Expedition

There is also a process of expedition, enabling acceptance within 2 to 4 weeks following:

- filing of an application for expedition; and
- payment of the prescribed fee.