



Australian Government

IP Australia

**TM**

**APPLICATION  
GUIDE**

# A guide to applying for your Trade Mark

TRADE MARKS

## **Privacy Notice**

IP Australia collects your personal information to provide our services. The *Trade Marks Act 1995* permits us to do this.

The Act also requires us to publish some of your personal information, including your name and your address. We publish these details in the Trade Marks register, the Trade Marks journal and in our databases. **All of these are available over the Internet.**

**If you do not want us to publish your home address, do not provide it to us.** You may use an Australian post office box or other valid Australian address instead.

IP Australia may also disclose some of your personal information to foreign IP offices and to people who request our bulk data products. We may also use your personal information to contact you for our market research.

Our **Privacy Policy** explains how we handle your personal information. Read the policy at **[www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)**

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This trade mark guide is designed to help you prepare and file a trade mark application in Australia. This guide does not cover every issue that may come up and you should not regard it as an authoritative statement on the relevant law and procedure. You should also note that the requirements may change from time to time and while we make every effort to ensure the information presented is accurate, you should check with IP Australia before relying on the information.

# What is a Trade Mark?

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## CHOOSING A TRADE MARK

A trade mark may be your most valuable marketing tool. With the right branding strategy, the public will identify a certain quality and image with goods and services bearing your trade mark. If you are considering a new product or service and you want to establish an identity for it, you should also explore a distinctive trade mark under which to market it.

## BENEFITS OF REGISTERING A TRADE MARK

As the registered owner, you:

- have the exclusive right\* to use your registered trade mark as a brand name for the goods or services specified in the registration
- have the exclusive right to authorise other people to use your registered trade mark for the goods or services specified in the registration
- have a registered trade mark which is personal property and can be sold
- have a registration which usually covers the entire Commonwealth of Australia
- may give the Australian Customs Service a notice objecting to the importation of goods that infringe your registered trade mark
- can be in a stronger position to stop other people from using your trade mark as their brand name on the goods or services covered by your trade mark registration.

\* *Note the Possible Limitations information on page 6*

## IS REGISTRATION OF A TRADE MARK COMPULSORY?

The short answer is no. However, if your trade mark is not registered and another person uses it, you may have to take *passing off* action under common law, or claim for a breach of Section 18 of the Competition and Consumer Act 2010 if you want to stop them. Protecting your trade mark without the benefit of registration can be more difficult and expensive than using the remedies available to owners of registered trade marks.

If you own a registered trade mark you have the right and the responsibility to protect it. You may take an infringement action against another person who uses your trade mark as their own on the same or similar goods or services. IP Australia grants trade mark rights but does not police or enforce them.

## GOODS & SERVICES

The description of goods or services you give determines the scope of protection that your trade mark provides.

### What do you need to list?

It is very important that you think carefully about what goods or services you want your trade mark to protect because you will not be able to expand your selection once the application is filed. Consider the exact nature of your business.

Consider the following questions before you file your application:

- Where do you derive your business income?
- What is the nature of your business?
- What are you known for doing by your customers/clients?
- What products or services does (or will) your business provide?

Trade mark scope is determined by 'use'. If you apply too widely you can be subject to 'non-use' action. You may not be able to enforce your rights to all the goods and/or services you have claimed if you do not use the mark on those goods and/or services.

Goods and services are divided into 45 classes under the Nice International System of Classification. For instance, cars are in class 12, while beer is in class 32. A list of the general headings of the 45 classes begins on page 20. You can find a more detailed explanation about specifying your goods or services on the trade marks section of the IP Australia website. Go to the Australian Trade Mark Online Search System (ATMOSS) and click on the Goods/Services link. You can contact IP Australia if you require more information on classification.

## HOW LONG CAN REGISTRATION OF A TRADE MARK LAST?

A trade mark can be registered indefinitely, provided the renewal fees, payable every ten years are paid when due.

## ARE ALL TRADE MARKS REGISTRABLE?

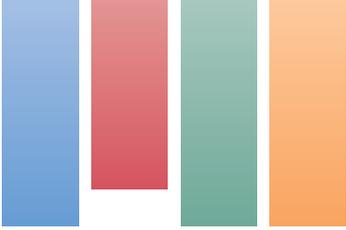
They are not. To be registrable a trade mark must meet conditions spelt out in the *Trade Marks Act 1995*.

Trade marks that indicate the kind, quality, intended purpose or value of goods or services, or are common surnames or geographical names are usually not capable of distinguishing your goods or services. See page 4 for examples.

Trade marks which are the same or very similar to an earlier trade mark, or would mislead the public about the nature of the goods or services, are also difficult to register.

Some words are protected by law and cannot be registered as trade marks. Others are prohibited as trade marks, for instance, OLYMPIC CHAMPION.

Some words are subject to other legislation. For example, the use of the word CHAMPAGNE is governed by provisions of the *Wine Australia Corporation Act 1980*.



## WHAT MAKES A TRADE MARK “CAPABLE OF DISTINGUISHING”?

**Your trade mark needs to be something that other traders may not wish to use in the normal course of their trade.**

Everyday language and vocabulary should remain open for all. Granting exclusive rights to words like geographical names, common surnames and trade expressions would deprive others of their legitimate right to use these words in connection with their own goods and services.

The following are examples of trade mark types that other traders are *unlikely* to need to use:

- **Invented words** such as LOCAJ
- **Suggestive or emotive words** such as FORTUITOUS CAT for pet food
- **Words that don’t describe what they will be used on** such as ANVIL for computers.

The following examples of words used on their own, i.e. without an accompanying logo or other words, are ones that other traders are very likely to need to use. They would be very difficult not only to register as trade marks but also to enforce.

- **Descriptive words and phrases on their own**

A simple example would be an apple farmer trying to register the phrase THE BEST APPLES. Obviously other apple farmers have a legitimate need to be able to say that they grow the best apples too. It would be unfair on others to give one apple farmer exclusive rights to this phrase. Examples of some other trade marks that are extremely difficult to register include:

STRAWBERRY for drinks	(common flavour)
WARM for heaters	(describes function)
GLOBAL for freight shipping services	(indicates geographical range)

- **Geographical names on their own**

Geographical references or place names are usually very difficult to register, especially when the place has a reputation for certain goods or services. For example, it would be very difficult to register TASMANIA for apples or NEWCASTLE for steel production. Traders who provide goods or services from these areas need to be able to indicate their origins.

- **Short combinations of numbers or letters on their own**

Commonly used combinations of letters may be difficult to register. Common acronyms (such as CD-ROM) or abbreviations (such as AUTO or BILLPAY) are also difficult to register if they describe the goods or services specified. Short combinations of numbers and letters (such as QL9 or F-55) may be used as serial numbers.

- **Common surnames on their own**

Common surnames such as SMITH or JACKSON would also be problematic. Many Smiths and Jacksons in Australia need to be able to use their name in relation to the goods or services they provide. However, less common surnames like CREGAN or RUDNICKI have a higher likelihood of achieving registration.

- **Combination with other unique words or symbols can help**

Bear in mind that your registration is for the trade mark as a whole.

## TRADE MARKS, BUSINESS, COMPANY AND DOMAIN NAMES

Registration of a business, company or domain name **does not give you any proprietary rights** – only a trade mark can give you that kind of protection.

The same word(s) may be registered by different people as business names and trade marks. However, a registered trade mark owner can take legal action against a business name owner for infringing the trade mark if the business name owner uses it on goods or services similar to those the trade mark registration covers.

**Caution:** *When you register your business name, be careful that its use does not infringe someone else's trade mark. It is always wise to search trade mark databases. See Searching on page 7.*

A **trade mark** identifies a product or a service, distinguishing it from other traders' similar offerings. Registration of the trade mark gives the owner the legal right to exclusively use or control its use for the goods or services for which it is registered. Registration is obtained under the *Trade Marks Act 1995* and in most cases applies across Australia.

A **business name** is a trading name only. Legislative changes have resulted in a National Business Names registration System where, from 28 May 2012, existing state and territory business names have automatically been transferred to a new national register. You can find more information at [www.asic.gov.au/business-names](http://www.asic.gov.au/business-names).

A **company name** identifies a legally incorporated entity. If a company wishes to trade using a name other than its registered company name, it must register that trading name as a business name.

**Domain names** are Internet site addresses. Registration of a domain name gives you exclusive use of that Internet address but only for an agreed period of time.

**No proprietary rights in the name are gained through a business name, company name or domain name registration in itself.**

## TRADE MARKS AND PLANTS

The name of a plant variety cannot be registered as a trade mark because it is not capable of distinguishing one trader's plants from another.

A plant variety name or a common name for a plant describes a particular plant. However, while a trade mark does not name any particular plant, it identifies the trade source of the plant, ie the grower, producer or seller.

During examination of your application, your trade mark will be checked to see if it is a variety name recorded on the Plant Breeder's Rights Register. It will also be checked against the common trade name of a plant. You cannot register your trade mark if it occurs as a plant variety name or common name in these searches.

If you require more information on trade mark registration or plant breeder's rights, contact IP Australia on 1300 65 10 10.

## TRADE MARKS AND WINES

Before choosing a trade mark or designing a label under which wine will be imported, exported or sold on the Australian market, you need to be aware of the requirements of the *Wine Australia Corporation Act 1980* and regulations, as well as the requirements of the *Trade Marks Act 1995*.

For more information on class 33 applications see [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au) or Wine Australia [www.wineaustralia.com](http://www.wineaustralia.com)

## ARE THERE ANY POSSIBLE LIMITATIONS TO REGISTRATION I SHOULD KNOW ABOUT?

Some circumstances although uncommon may limit your exclusive rights. For example, if another person is using an unregistered trade mark which is the same, or very similar to yours, and they used it before you registered or started using yours, they could possibly claim ownership of the trade mark under common law. They might rely on this as a defence against an infringement action. Sometimes a business name or part of a company name may have been used in this way as an unregistered trade mark.

If another person is using an unregistered trade mark that is the same, or very similar to your trade mark, it could still be registered. That person may be able to produce evidence of prior use or honest concurrent use. It would then be possible for such a trade mark to subsequently be registered.

## SEARCHING

You can search the trade mark database before using a new trade mark and before filing an application to register it. Identical or similar trade marks for the same or closely related goods or services could result in your trade mark being rejected. The search could also save you trouble and money by alerting you to existing trade marks which are so similar to the one you plan to use, that you may face legal action from their owners.

When you search the trade mark database, look for other trade marks identical or similar to your own which may relate to the same or similar goods and services.

## APPLICANTS FOR BUSINESS NAMES

If you wish to check whether your business name is identical or very similar to a pending or registered trade mark, IP Australia provides the **Business Name Search Service\***. Go to [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au) and click on the Understanding Intellectual Property tab followed by the IP For Business tab.

For further information on this service or to apply for a search, contact IP Australia on 1300 65 10 10.

\* *Note that this is not the same search carried out when examining a trade mark.*

## BEFORE YOU APPLY

It is important to remember that once your trade mark application has been filed and the details published:

- you cannot substantially amend your trade mark, nominated goods or services or applicant name, so it's important to **get it right the first time**
- **we cannot refund your application fee.**

Read through this guide carefully before submitting your application. Following are some of the more common mistakes and misconceptions to look out for.

## COMMON MISTAKES

### **Applying for the name of your goods or services, or a description of these.**

Names and descriptions of products and services are extremely difficult to register as trade marks because other traders have a legitimate need to use them to indicate their similar goods or services. Achieving registration is gaining an exclusive right – this is why terms that other traders need to name or describe goods or services can be extremely difficult to register. Refer to: *What makes a trade mark capable of distinguishing* on page 4.

### **Applying to register the same or similar sign as a trade mark already applied for, or already registered, and covering similar goods or services.**

It's a good idea to search the ATMOSS database for trade marks similar to your own before you apply. You need to look for *similar*, not just *identical* trade marks covering goods or services like your own.

### **Changing your trade mark, or wanting to add goods or services to your application, after publication of details of the application.**

Only very minor changes can be made to a trade mark once an application has been filed and published. No goods or services may be added after publication.

### **Providing a business name or trading name as the owner of the trade mark.**

Business and trading names cannot own property. An application should be in the name(s) of the owners of the business name registration, or if the business is an incorporated entity, its company name.

### **Listing goods or services you don't trade in, or omitting those in which you do trade.**

Trade mark registration is for the goods or services you *actually* trade in or *intend to trade in* within the near future. Once your application is filed and published, you cannot add any goods or services.

It is important to list the goods or services from which you obtain your income or which you sell or provide to consumers. For example, if your business is to provide cleaning services, you should list cleaning services. Even though you might also display your trade mark on letterhead, business cards, or on the side of your vehicle for promotional purposes, your 'trade' is in cleaning services only.

Listing 'retail services' is also a common mistake. If you are simply selling your own product or a product you have made for you, your application should list the product (goods). Retailing is usually applicable only where a large variety of other traders' goods are in one place for sale to the public, for example, a department store.

## COMMON MISCONCEPTIONS

**Thinking that simply filing an application (and seeing it appear on the database) means your trade mark is registered.**

Filing and publication are initial steps in the process. They don't mean your trade mark has been accepted for registration. Your application will not be registered until it has been examined, any problems resolved, it has been accepted, passed through the opposition period, and registration fees are paid.

**Assuming that registration of a business name, a domain name or a company name gives rights in that name.**

Registration of a business, company or domain name does not give you any proprietary rights – only a trade mark gives you that kind of protection.

**Thinking that registration of your business, company or domain name, means that trade mark registration will be automatic.**

Requirements for trade mark registration are quite different to business registration, company or domain names and different tests apply. Each is administered by a different body and serves a different purpose.

**Thinking that acceptance or registration of your trade mark is the end of the story.**

Even if your trade mark is advertised as accepted, there is a period of time after the date of that advertisement, in which anyone who believes your trade mark should not be registered may oppose it. If your application is opposed it is your responsibility to defend it. Only a very small proportion of acceptances are opposed.

Once your trade mark is registered, it can no longer be opposed. However, action can be taken to **remove** your trade mark from the register if you have not been using it, and action can be taken in the courts to have your trade mark registration **cancelled**. Again it would be your responsibility to defend such an action. A very small proportion of registrations will have such actions taken against them. More information about opposition, removal and cancellation is available on IP Australia's website.

**Thinking that IP Australia will monitor use of your trade mark and enforce your rights.**

It is your responsibility to look after your trade mark, even once it has been registered. IP Australia does not monitor or police the marketplace, nor provide assistance in identifying or prosecuting infringement matters. It is up to YOU to be vigilant in identifying and/or prosecuting infringers.

# The application process

## HOW TO APPLY

Once you have settled on what you consider an appropriate trade mark, and if you wish to seek registration for it, there are three main ways you can enter the application process.

- You can **request an assessment** of the likelihood of your trade mark achieving registration through **TM Headstart** (currently available online via our website) **prior** to filing your trade mark application. You can subsequently file a trade mark application via TM Headstart.

Or, you can **apply** to register your trade mark using one of the following options:

- Online at a discounted fee.
- By mail using either a form downloaded from the IP Australia website or a hard copy from our Customer Service Centre (1300 65 10 10) (standard fees apply).

Alternatively, you could consider seeking assistance from an IP professional such as a registered patent or trade mark attorney or lawyer experienced in trade marks. They can provide you with commercial advice about trade marks for your business.

## TM HEADSTART

This is a simple and fast service to assess the registrability of your proposed trade mark. It is available online from the IP Australia website.

### Checklist before using TM Headstart

- Have you decided on a trade mark?
- Do you know the goods or services you want to use your trade mark on?
- Can we contact you easily (by phone or e-mail) during business hours?
- Are you prepared to pay the fee? For details go to our website or contact IP Australia during business hours on 1300 65 10 10.
- Can you pay your fees online using MasterCard or Visa?
- Are you aware that your filing date will not be determined until after completion of the TM Headstart process?

For more information about TM Headstart, including the benefits and limitations of the service, visit the trade marks section of the IP Australia website.

# Applying for a Trade Mark

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## WHO CAN APPLY?

The following can apply for a trade mark:

- an individual
- a company
- an association – whether incorporated or not
- a combination of any of these
- a trust – provided the application is in the name of the trustees
- a corporation – provided the application is in the corporation’s name and not that of its directors or shareholders

The following cannot apply for a trade mark:

- a business name
- a trading name

## USE

Applicants must use, or intend to use the trade mark in relation to the goods or services identified in the application. If the trade mark is to be used by a yet to be formed body corporate, the applicant will need to assign the trade mark to the new body.

## COSTS

A basic fee applies for filing your application. Additional fees are payable at filing where:

- your application covers goods or services in more than one class
- you have applied for a series\* of trade marks.

If your application covers goods or services in more than one class, it is called a multiclass application.

If your application is accepted for registration, the appropriate registration fee must be paid before your trade mark can be registered.

\* *Series — You can apply to register more than one trade mark on one application if the trade marks are essentially the same. To qualify as a series application, the differences between the trade marks must be extremely minor. Some additional information about series trade marks is included in the instructions for completing the Application Form.*

*A full list of fees can be found on IP Australia’s website or by contacting the Customer Service Centre on 1300 65 10 10. (GST does not apply to these fees)*

## NON-TRADITIONAL TRADE MARKS

Applications for trade marks containing or consisting of sounds, scents, shapes, colour or aspect of packaging should be accompanied by a concise and accurate description. All trade marks must be capable of graphic representation.

## HOW TO PAY

You may file your completed application with the correct fees:

- Online (your personal or business credit card will be required when you pay online) at **[www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)**.
- At our IP Lodgement Points (cash, cheque, money-order, debit or credit card). For your nearest IP Lodgement Point and to find when it's open check our website.
- By post (cheque, money-order, payment form for credit card) — to the **Registrar of Trade Marks, IP Australia, PO Box 200, Woden ACT 2606**.
- By fax (using the payment form for credit card) to our secure business transactions fax **(02) 6283 7999**.
- Electronic Funds Transfer (EFT) for approved customers only. To arrange contact **1300 65 10 10**.

Payment forms are available from our website. We accept MasterCard or Visa. Cheques should be payable to IP Australia.

## CARE IS NEEDED

Be careful when completing your application. After you file it, the nominated goods or services cannot be extended and only very minor amendments are allowed to the trade mark. If you need assistance with filling in the paper or online application forms, choosing the correct classes for your goods and services or calculating the correct fees, call IP Australia during business hours or email **[assist@ipaustralia.gov.au](mailto:assist@ipaustralia.gov.au)**.

## LOOKING AFTER YOUR APPLICATION

You can file and manage your own application or use a registered patent or trade marks attorney or a solicitor experienced in trade mark matters.

## EXAMINATION

Applications are examined in order of filing.

The period of time taken between filing and examination of applications can vary considerably due to significant fluctuations in the workload of IP Australia. Current waiting time, can be found on IP Australia's website or by contacting our customer service centre.

If you believe that you will be seriously disadvantaged because of the time taken between filing and examination, you may request early examination of your application. There are no fees associated with lodging such a request but it must be accompanied by a declaration detailing the reasons for your request. Requests are assessed on their individual merit and are more likely to be accepted if any delay in examining your trade mark may result in commercial or other disadvantage.

Your application will be assessed against the requirements of the *Trade Marks Act 1995*. If it meets these, it will be accepted for registration. If not, you will be sent a report detailing issues that need to be addressed to which you should reply in writing.

You may ring the examiner to discuss your application and how you might proceed with it. However, IP Australia staff cannot give you legal or business advice and you may choose to seek professional advice.

## TIMEFRAMES

The *Trade Marks Act 1995* allows you 15 months from the date of the examiner's first report to meet any requirements and to have your application accepted by the Registrar. If you need additional time, you may request and pay for extensions of time. From 15 to 21 months, extensions will be granted on payment of the appropriate fee, providing the request is made before the date specified in the examiner's report.

After 21 months, an application for an extension of time may only be made under the provisions of section 224 of the *Trade Marks Act 1995*. If you wish to apply for an extension of time just before the end of 21 months you will need to pay the appropriate fees as well as supplying a declaration setting out the grounds for extension.

Not all of these requests are accepted, and fees are not refundable.

If your trade mark application is not accepted and you allow it to run out of time, it will **lapse**.

## AFTER ACCEPTANCE OF YOUR APPLICATION

When your trade mark is accepted for registration, the details of the application will be advertised in the *Official Journal of Trade Marks*.

**For a period of time after the advertisement date, anyone who believes that your trade mark should not be registered may oppose its registration.**

**If your application is opposed it is your responsibility to defend it.** Only a very small proportion of acceptances are opposed. The opposition process can sometimes be lengthy, complex and costly. If you are considering defending an opposition, you may wish to seek professional advice.

IP Australia's trade mark Hearings section administers the opposition process.

## REGISTRATION

If no opposition is filed against your application, or if opposition is unsuccessful, your trade mark will be registered when you pay the registration fee. It is in your interest to pay as soon as possible, certainly no later than six months from the date acceptance is advertised. IP Australia will send you a Certificate of Registration and record your details in the *Register of Trade Marks*.

Your trade mark will be registered from the date you file your application, not from the date it was examined or accepted.

**The earliest date your trade mark can be registered is seven and a half months after an application is filed.** This fulfils our international obligations to allow six months for applicants to claim a priority date based on an overseas filing.

### **Can someone oppose my trade mark even after registration?**

They can't however there are actions that can be taken against a registered trade mark.

**Removal action** — Another person can apply for your registered trade mark to be removed from the Register, either because you have not used it or because your use of the trade mark has not been in good faith. If you do not oppose the action, your trade mark will be removed. **It is your responsibility to defend your trade mark registration by opposing the removal action and providing evidence of your trade mark use.**

**Court action** — Another person can apply directly to a court for a court order to remove or cancel your trade mark registration. **Again, defence is your responsibility.**

## **WARNING — UNOFFICIAL REGISTER/SERVICES**

Unsolicited mail from unknown sources on the subject of patent and trade mark registration should be treated with caution. In cases where the credibility of correspondence is questionable, it would be prudent to seek professional advice.

Companies reported to have sent unsolicited material to trade mark owners include:

- **TMP, Trade Mark Publishers, Austria but with a street address in Sydney**
- **Commercial Centre for Industry and Trade (based in Switzerland)**
- **Company for Economic Publications Ltd (based in Austria)**
- **Company for Publications and Information Anstalt (based in Liechtenstein)**
- **Edition The Marks KFT**
- **European Institute for Economy and Commerce – EIEC (based in Belgium)**
- **Globus Edition SL (based in Spain)**
- **INFOCOM (based in Switzerland)**
- **Institute of Commerce, Trade and Commerce (based in Switzerland)**
- **IT & TAG (based in Switzerland)**
- **TM Collection (based in Hungary)**
- **ZDR-Datenregister GmbH (based in Germany)**
- **I.B.F.T.P.R – International Bureau for Federated Trademark & Patent Register**
- **RIPT – Register of International Patents and Trademarks**
- **Gaia Almanach LTD**
- **International Patent and Trademark Register based in Nurnberg, Germany**
- **TM Worldwide (based in Hungary)**
- **Federated Institute of Patent and Trademark Registry, based in Florida, USA**

Note that the above list is not comprehensive, and it is possible that correspondence will come from other companies. For more information, refer to our website. The companies above are not associated with IP Australia and have no official or government authority. The services they offer do not affect official trade mark registration or trade mark rights in Australia or to the best of our knowledge, in any other country. Before paying a fee for any IP related service, IP Australia recommends that you carefully consider whether the service will provide any protection or other value.

## AT ANY STAGE

At any stage after filing your application, you may apply in writing to record:

- changes in the details of your application/registration  
*Note: Goods or services cannot be extended and only very minor amendments are allowed to the trade mark itself*
- another party's claim of interest to, or right in, your trade mark
- an assignment or transmission of your trade mark to another party.

## IMPORTANT POINTS

- The name and address of the applicant(s) will be published on our database and will be available on the Internet.
- In some circumstances, other information in relation to the prosecution of your application may be made available upon request to third parties.
- A trade mark does not have to be registered. However if you use an unregistered trade mark, we suggest that you search our database of registered and pending trade marks. This will help ensure that you don't inadvertently infringe the rights of registered trade mark owners.
- Although <sup>TM</sup> can be used with your trade mark at any time, <sup>®</sup> can be used only with a registered trade mark.
- An application for a trade mark must be examined before the trade mark can be registered. You cannot claim that the trade mark is registered until you receive the Certificate of Registration.
- If your trade mark is registered, it is protected from the date you filed your application — not from when it was examined or accepted.

## REMEMBER

You **must** have an address for service in Australia. All correspondence from this office will be sent to that address and it is very important that you advise us of changes.

## RENEWAL

The initial period of registration of your trade mark lasts for ten years from the filing date.

You can renew your registration up to 12 months before or six months after the expiry date. Late fees apply if the registration is renewed after the expiry date.

Two months before the expiry date we will send you a reminder notice telling you how to renew your registration. It is important that you notify our office if your address changes.

The Registrar will renew your trade mark registration when the renewal fee is paid.

# Protecting your Trade Mark

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## INFRINGEMENT

It is your responsibility to protect your trade mark. If someone uses it without your permission, they may be infringing and you should seek legal advice as soon as possible. IP Australia grants trade mark rights but does not police or enforce them.

## INFRINGEMENT OF TRADE MARKS ON THE INTERNET

Doing business over the Internet has significant implications for owners of registered trade marks, because of the possibility of inadvertent infringement of overseas registered trade marks. Many trade mark owners do not realise when they begin trading over the Internet that they are entering a global marketplace. Registration of a trade mark in Australia does not give any rights to that trade mark overseas. If you offer goods or services for sale via the Internet, you may be sued for infringement in a country where someone else owns the trade mark.

To minimise the risks of liability over unintentional Internet infringement, Australia recently joined other member states of the World Intellectual Property Organization (WIPO) in establishing guidelines that protect trade mark owners on the Internet. The text of the guidelines and explanatory notes are contained in document SCT/7/2, which is located at [www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=1922](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=1922).

Trade mark owners need to be aware of the potential risks they face in Internet trading. You should seek legal advice on the best ways you can avoid or minimise those risks. Most importantly, you should seek legal advice if you receive notice from an overseas trade mark owner alleging infringement.

Trade mark owners considering the Internet should weigh up the potential benefits for their business of applying for overseas registration of their trade mark. (See **International Trade Mark Registration**, on page 18.)

## GENERIC USE

Once registered, it is important to ensure that your trade mark continues to be regarded as such. If it becomes known as the generic name for your goods or services and ceases to be recognised as a trade mark, a third party application to the courts to have the registration cancelled may be successful.

## REMOVAL OF TRADE MARK FROM REGISTER FOR NON-USE

A third party can apply to have your trade mark removed from the Register. If you haven't used it for three years or if you had no intention of using it when the application was filed. The person applying for removal is often a trade mark applicant who is being hindered by your registered trade mark. **If you do not oppose the action, your trade mark will be removed.**

## OBJECTING TO IMPORTATION OF GOODS

You can give a notice to the Australian Customs Service, objecting to the importation of goods which infringe your registered trade mark.

For more information contact the Australian Customs Service on 1300 363 263.

## INTERNATIONAL TRADE MARK REGISTRATION

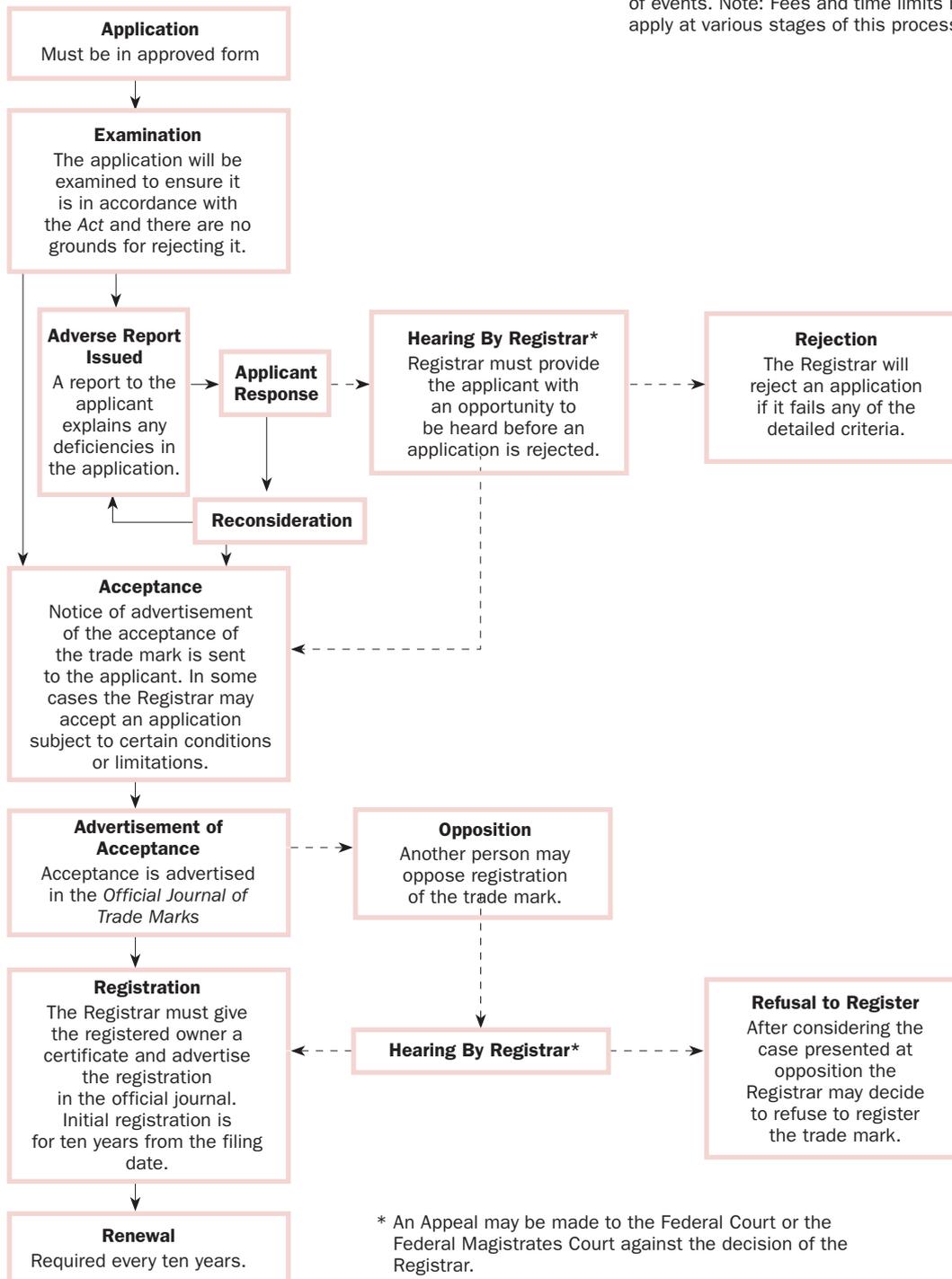
### Do you want protection for your trade mark overseas?

There are different ways Australian trade mark owners can seek trade mark protection overseas. An application can be filed directly with each country, or a single international application can be filed through IP Australia nominating the countries in which protection is required. This single international application operates under the Madrid Protocol to which more than 85 countries are signatories.

Visit our website if you are interested in finding out more about international applications.

# Flowchart of an application

Unbroken lines signify the most likely course of events. Note: Fees and time limits may apply at various stages of this process.



## CLASSES OF GOODS AND SERVICES

**Please note: If your goods or services are not listed, or you need help completing the application form, contact IP Australia on 1300 65 10 10, or by email to [assist@ipaustralia.gov.au](mailto:assist@ipaustralia.gov.au)**

### Classes of goods

- CLASS 1: Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
- CLASS 2: Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
- CLASS 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
- CLASS 4: Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.
- CLASS 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.
- CLASS 6: Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.
- CLASS 7: Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs; automatic vending machines
- CLASS 8: Hand tools and implements (hand-operated); cutlery; side arms; razors.

- CLASS 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus.
- CLASS 10: Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.
- CLASS 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
- CLASS 12: Vehicles; apparatus for locomotion by land, air or water.
- CLASS 13: Firearms; ammunition and projectiles; explosives; fireworks.
- CLASS 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
- CLASS 15: Musical instruments.
- CLASS 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.
- CLASS 17: Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.
- CLASS 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas and parasols; walking sticks; whips, harness and saddlery.
- CLASS 19: Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.
- CLASS 20: Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

- CLASS 21: Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.
- CLASS 22: Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.
- CLASS 23: Yarns and threads, for textile use.
- CLASS 24: Textiles and textile goods, not included in other classes; bed covers; table covers.
- CLASS 25: Clothing, footwear, headgear.
- CLASS 26: Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.
- CLASS 27: Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).
- CLASS 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.
- CLASS 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats.
- CLASS 30: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.
- CLASS 31: Grains and agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds; natural plants and flowers; foodstuffs for animals, malt.
- CLASS 32: Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.
- CLASS 33: Alcoholic beverages (except beers).
- CLASS 34: Tobacco; smokers' articles; matches.

**Classes of services**

- CLASS 35: Advertising; business management; business administration; office functions.
- CLASS 36: Insurance; financial affairs; monetary affairs; real estate affairs.
- CLASS 37: Building construction; repair; installation services.
- CLASS 38: Telecommunications.
- CLASS 39: Transport; packaging and storage of goods; travel arrangement.
- CLASS 40: Treatment of materials.
- CLASS 41: Education; providing of training; entertainment; sporting and cultural activities.
- CLASS 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.
- CLASS 43: Services for providing food and drink; temporary accommodation.
- CLASS 44: Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.
- CLASS 45: Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.

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