

TRADEMARK^{it}

The Power of Trademarks

Why Do You Need A Trademark?

Registration of your business or product name and logo as a trade mark provides you with simple long-term protection of a potentially valuable asset.

Registration of a trade mark in Australia gives you the exclusive right to use the mark for the nominated goods or services, subject to the Trade Marks Act 1995 and any conditions imposed by the Registrar of Trade Marks and applied by IP Australia, the Commonwealth Government department which administers trade marks.

Once a mark is registered, its owner receives a Certificate of Registration and the mark is recorded in the Trade Marks Register maintained by IP Australia.

Registration of a trade mark lasts indefinitely subject to use of the mark and payment of renewal fees every ten years. If renewal fees are not paid, the registration lapses and the trade mark is removed from the Register.

The Register also provides a mechanism by which the interests granted by the owner to other parties, such as licenses to use the mark or mortgages over it, can be recorded on the Register in a similar fashion to the way in which dealings in land are recorded on a Certificate of Title by State land registries.

Registering your trade mark provides a simple mechanism for defending your rights in the mark against infringement. If infringement is proven, the owner may be granted an injunction to restrain the infringing activity or may be awarded damages.

It is not necessary to register a mark in order to use it. Provided a mark is not already in use or registered for similar goods or services, a proprietor of a mark may use it and thereby acquire rights at common law. In certain circumstances you can take action on the basis of these common law rights to prevent another business from using a mark which is similar. For the most part, however, this depends upon establishing such things as a prolonged period of use on your part, that there is market confusion, or that the other party's conduct is misleading or deceptive.

The registered owner of a mark does not need to prove all these matters in order to prove infringement.

Why is a Trademark Powerful?

It is important to be aware of the differences between trade marks, company names, business names and domain names.

Of these only the registration of a trade mark gives you proprietary rights in a name.

Company names and business names (registered in Australia on a State by State basis) are largely administrative - allowing the Commonwealth and State governments and regulatory authorities to keep track of a business for various purposes including consumer protection. While a company or business name does identify your company or business, it does not provide you with automatic proprietary rights to the name, as a trade mark does. Nor does it protect individual product names or logos which can often be more valuable.

The relationship between domain names and trade marks is continually evolving, and varies from country to country. What has become clear however is that a domain name, like a company or business name, will not give you automatic proprietary rights to the name. In fact, it is more likely that you will only ever hold a licence to use a domain name, rather than own it or derive any proprietary rights from using it.

Owning a registered trade mark may however give you the right to evict the owner of a domain name which is the same as your mark if that domain name has been registered in bad faith.

One of the grounds for seeking eviction of a 'cyber squatter' is that the domain name is identical or confusingly similar to a trade mark or service mark in which you have rights.

In addition to the benefits of owning a registered trade mark in this regard, it is also possible to register a .com.au domain name on the basis of a trade mark registration rather than just a company or business name registration.

It is important and recommended that a basic trade mark search be carried out before you register either a business or company name to avoid infringing a registered mark.

Trademark^{it} provides a full suite of trade mark services. Contact us today -

- Freecall 1800 665 575 (International customers dial 61 3 8611 0400)
- Email us at info@trademarkit.com.au
- Apply for a trade mark search online at www.trademarkit.com.au

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