



Trade Marks & Licensing

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Trade Marks

- A trade mark is a word, phrase, letter, number, sound, smell, shape, logo, picture or packaging that your business uses to represent its products and services.
- It's the “get up” that distinguishes your goods or services from your competitors.

Trade Marks

THERE ARE A NUMBER OF IMPORTANT
THINGS YOU MUST DO TO PROTECT YOUR
BRAND

1. Choose a Distinctive Name

- Choose a name or logo (and possibly the “get up” i.e. the colours, font and/or images) which represents your business.
- Avoid any name that is descriptive of your products and services.
- Whilst it may be tempting to choose a descriptive term or a non-distinctive name, it will severely hamper the prospects of registrability and the ability to add brand value to your business.

2. Check Availability

- Undertake an online search for identical and similar trade names (“a common law” search) as well as a search of the Trade Marks Office Register in Australia and possibly in the overseas markets that will be important to you.
- Don’t forget to check the ASIC register.
- Be aware of the brands that your competitors are using!

2. Check Availability cont'd

- Remember if you choose a name that is too similar to an existing trade mark or brand (whether registered or not), you run the risk of an action for trade mark infringement or misappropriation of reputation.
- Make sure your brand can work well in the key overseas markets as a rebranding just for overseas use will be costly.

3. Acquire Ownership of your Brand

- If an external consultant creates your brand mark make sure the underlying rights in the design (including any copyright) have been assigned to you.
- If you don't then you do not “own” the trade mark!

4. Register the Trade Mark

- Registering a trade mark is the best way to protect your investment as it gives you the exclusive right to:
 - » use the trade mark throughout Australia for commercial purposes;
 - » assign, transfer or sell the rights to the trade mark to another business;
 - » protect the trade mark/brand against an unauthorised user.

5. Overseas Protection

- An Australian trade mark provides protection only within Australia.

- Protection can be sought in key overseas markets by:
 - » Filing an application directly into each country; and/or
 - » Filing a single international application through the World Intellectual Property Organization (WIPO) nominating the Madrid Protocol countries for which protection is sought.

6. Registration in China

- The registration process can be lengthy therefore you should seek to register your trade mark well in advance of any plans to manufacture/sell your product in China;
- Develop and consistently use the Chinese character version of the mark with the English language mark;
- Consider registration of any logo under the Chinese copyright system;
- Record your registered trade mark with the Chinese Customs Office;
- Maintain control of any use of your trade mark by a third party licensee or authorised user.

7. Maintain and Enforce Brand Guidelines

- Your trade mark identifies the goods or services that you offer.
- To maximise your reputation/goodwill use your brand consistently in respect of all matters including font, colour, position and prominence.
- Avoid brand dilution!

8. Differentiate your Mark from Surrounding Text

- When using your trade mark always use different font size, style or colour from the surrounding text to indicate clearly that it is a trade mark. This will also tend to highlight your trade mark and enhance brand value.
- Use your trade mark as an adjective (XEROX photocopier; UGG sheepskin boots); never as a verb or a noun.

9. Use of Trade Mark Symbols

- The ® symbol can be used once your trade mark is registered.
- It is a criminal offence to use the ® symbol in any other context.
- If your trade mark is not registered, use the TM symbol.

10. Use It or Lose It!

- Make sure you use your trade mark.
- Your trade mark should appear on any brochures, advertising, your website, letterheads and invoices.
- It is absolutely crucial that your trade mark also appears prominently on any product and packaging.
- Keep clear records of how the trade mark has been used over time as well as the date of first use.

11. Do Not Allow Unrestricted Use of Your Trade Mark

- If you license or franchise your trade mark, you must control how the authorised third party uses the trade mark.
- Licence arrangements become particularly important if you do not directly operate in a particular country and there is a need to rely on the licensee's use to avoid having your trade mark removed for non-use.

12. Register Your Trade Mark with Customs

- If your product is susceptible to counterfeiting, your business can be helped by lodging a Notice of Objection with Customs.
- Customs will seize any counterfeit product bearing your registered Trade Mark entering the country.
- The scheme is a very cost-effective way of protecting your trade mark rights and your business!

13. Monitor the Market for Infringers

- Your trade mark is an asset of the business and therefore it needs to be protected.
- Maintain a constant watch of the market for any misuse of your mark and take action if you see others trying to trade off your reputation.
- Do not assert trade mark infringement unless your trade mark is registered.

14. Update your Registration on Brand Refresh

- A trade mark registration only protects the trade mark in the form in which it is registered.
- If your brand is redesigned or refreshed, you will need to file a fresh trade mark application to protect your rights in the revised mark.
- Don't forget to acquire ownership of all the underlying IP rights prior to filing.

Licensing

- Your brand and associated registered trade mark is an important asset of the business.
- You must use a trade mark to avoid losing it!
- Licensing is one way to maintain your rights and to build your brand reputation and identity in the marketplace both locally and overseas.

Licensing cont'd

- To licence your trade mark you should ensure that there is an appropriate trade mark licence agreement in place.
- You must exercise actual and sufficient control over how the licensee uses your trade mark.
- The licensee must acknowledge you as the owner of the mark and its use as a licensee.

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