

A Presentation x Christine Moody
for LWN099 IP Law @ QUT Law School 2018



**TIPS + TRICKS
TO ACHIEVE
DISTINCTIVENESS
FOR TRADE MARK
REGISTRATION**

christinemooddy.com.au



**TM is for
Trade Mark
+ R is for
Registered TM!**

Don't clown around... trade marks are valuable!

Trade Marks Ring Master

85%

VALUATION OF COMPANY IS TM

According to a 2015 report by Ocean Tomo, intangible assets (trade marks) represent 85% of company's market value

10

MOST VALUABLE GLOBAL BRANDS

Amazon, Apple, Google, Samsung, Facebook, AT&T, Microsoft, Verizon, Walmart, and ICBC

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AUSTRALIA'S MOST VALUABLE BRANDS

Telstra, CommBank, ANZ, Woolworths, Coles, NAB, Westpac, BHP Billiton, Optus, and Rio Tinto

Familiar brands to help explain TMs

A trade mark can be one of these OR any combination of any of these:

- > Letters—BMW or IBM
- > Numbers—4711 perfume
- > Words—Addidas, Nike, and Qantas
- > Phases—Nike's—"Just do it"
- > Sound—Vegemites—Happy little Vegemite song
- > Smell—E-Concierge's Eucalyptus scent in golf tees
- > Colour—Single colour—Cadbury's purple; and two colours, Commonwealth Bank's yellow and black
- > Shape—Coca-Cola bottle or Toblerone's triangular-shaped chocolate bar
- > Device—McDonald's 'M'
- > Aspect of packaging—Philadelphia Cheese's silver packaging.



All the fun of the Trade Mark fair!!!



Roll up, roll up... the amazing benefits of trade marks

- > Don't have to register your trade mark
- > Can be your most valuable marketing tools
- > Badge of origin for your goods and services
- > Gives you the exclusive right to use the registered mark (s 20)
- > 'R' symbol puts others on notice to respect your trademark
- > As a piece of commercial property you can licence i.e., McDonald's Franchises (s 21)
- > *Campomar Sociedad v Nike.*

Take your seats and enjoy the TM show...

WHAT IS PROCESS OF REGISTRATION?

1. **Application**
2. **Initial examination**
3. **Examination report**
4. **Followed by Accepted**—application is advertised in the 'Australian Official Trade Marks Journal' decision
5. **Opposition**—another person (“an interested party”) can lodge an objection to a trade mark within two months of the advertised date
6. **Registration**—after two months if no objections, the trade mark, then proceeds to registration—once the fees are paid
7. **'R'**—change from 'TM' to an 'R' on your trade mark.

But there are some hoops to jump through before starting the registration process...

You need to decide:

- > If you have a trade mark
- > What are the suitable classes for your goods and services...there are 45 classes (35 goods and 11 services classes)
- > What is the exact nature of your business is so you can decide the most appropriate classes
- > Which trade marks you are going to register as they must be used or intended to be used or in the course of trade (s 17)
- > Registered trade marks can be removed from the register if you are not using them (s 92)—*Lodestar Anstalt v Campari America*
- > Search IP Australia's resources for research.



Upcoming shows... Strategies to achieve Trade Mark distinctiveness!

- > The trade mark must be “specific enough to distinguish a proprietor’s goods or services from those of all other proprietors” s 41(2) ...therefore best to avoid:
 - > Descriptive marks or generic terms (even if the spelling is changed) i.e., 'Strawberry Milk' or 'Straawberrie Mylk'
 - > Geographic words i.e., 'Tasmanian' Apples
 - > Commonly used acronyms or terms i.e., 'USB' or 'AppStore'—*Apple Inc v Registrar of Trade Marks*
 - > Common surnames i.e., Smith or Jackson
 - > Using part of an existing Trade Mark i.e., 'Olympic' Champion
 - > Those subject to legislation i.e., 'Champagne'—*Wine Australia Corporation Act.*

**Let's pitch our tents + work together
to achieve trade mark registration...**



Upcoming shows... design for distinctiveness!

To give your trade mark the best chance of registration, there are five important design stages and prior to the application:

1. Understand the strategic plan of the business and the industry section as well as current and future plans
2. Complete an initial search of trade marks in the same sector
3. Create a design brief that includes the competitor's trade marks and other important company information
4. Ensure every piece of the trade mark is 'registrable' and register separately i.e., 'Pacific Ale' in Stone & Wood logo—*Stone & Wood Group v Intellectual Property Development Corporation*
5. Use IP Australia's search tools—repeat at every design phases i.e., at initial concepts stage to final design.

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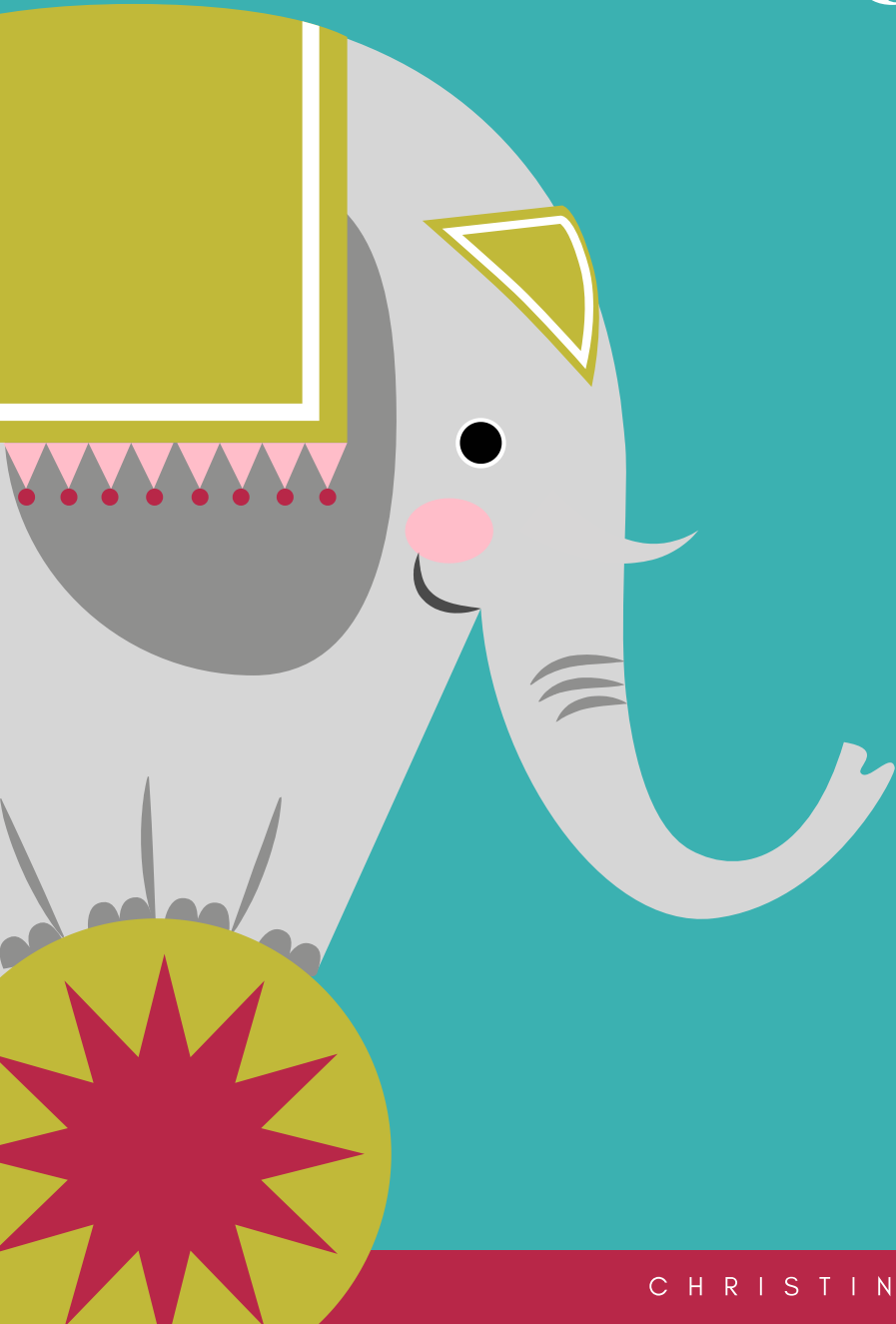


NEXT SHOW...



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Curtain call....



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Curtain call....

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Curtain call....

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Aston v Harlee Manufacturing Co (1960) 103 CLR 391

Cantarella Bros Pty Ltd v Modena Trading Pty Ltd (2014)
254 CLR 337

Chocolate Guylian NV v Registrar of Trade Marks
(2009) 82 IPR 13

*Campomar Sociedad, Limitada v Nike International
Limited* [2000] HCA 12

E & J Gallo Winery v Lion Nathan Australia Pty Ltd
(2010) 241 CLR 144

JT International SA v Commonwealth (2012) 97 IPR 321

*Kenman Kandy Australia Pty Ltd v Registrar of Trade
Marks* (2001) 56 IPR 30

*Koninklijke Philips Electronics NV v Remington Products
Australia Pty Ltd* (2000) 48 IPR 257

Lodestar Anstalt v Campari America LLC [2016] FCAFC
92

*Stone & Wood Group Pty Ltd v Intellectual Property
Development Corporation Pty Ltd* [2018] FCAFC 29

C. Legislation

Copyright Act 1968 (Cth)

Copyright Amendment (Digital Agenda) Bill 1999 (Cth)

Competition and Consumer Act 2010 (Cth)

Trade Marks Act 1995 (Cth)

Trade Marks Regulations 1995 (Cth)

Wine Australia Corporation Act 1980 (Cth)