

Good Trade Mark Practice



Do's and Don'ts of IP Protection

To protect your creative endeavours and maximise their commercial value, a few simple rules must be observed*.

Do

✓ Check name availability

Before investing expense, time and emotional energy into a name, check that no-one else is already using it. Undertake searches for identical or similar trade marks, domain names and business and company names. Also do an Internet search. Searching for similar trade marks is difficult. Consult your Trade Mark Attorney for assistance.

✓ Choose a distinctive name

Distinctive names and logos make the best trade marks because it is easier for people to associate them with you. The best trade marks consist of made up words or logos or existing words which have no necessary connection with the particular good or service.

✓ Acquire ownership of your trade mark

If a consultant creates or designs your trade mark, ensure you obtain from the creator/designer a written assignment of all intellectual property rights in the trade mark. Failure to do so may mean you don't own the trade mark. Keep the assignment document in a safe place.

✓ Register your trade marks

Trade mark registration is the best way to protect your investment in a trade mark. Only registered trade marks can be protected by an infringement action. Registration also shows people that you are serious about your trade mark. Register your trade mark in key overseas markets too if relevant. A Trade Mark Attorney can help you register.

✓ Maintain and enforce brand guidelines

Brand guidelines help ensure consistent use by setting out the form in which the trade mark is to appear including matters such as font, colour, position and prominence.

✓ 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.

Don't

✗ Choose a non-distinctive name

Non-distinctive names are difficult to register and are hard to protect because it is difficult to show sufficient reputation in the name. Problematic trade marks include surnames, geographic references, terms which describe the good or service, superlative terms (excellent, fantastic) and generic terms. While it is tempting to choose a descriptive term, this can severely limit registrability and the ability to add brand value.

✗ Choose a name that is already taken

By undertaking searches, this problem can generally be avoided. Avoid clever misspellings or imitations of well-known or famous brands. 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. Also, there will be confusion in the market and it will be difficult to achieve brand distinctiveness.

✗ Use the trade mark as a verb or a noun

Some well-known trade marks have failed because they lost their association with the original trade mark owner and became generic eg aspirin, escalator. Always use your trade mark as an adjective (HOOVER vacuum cleaner) and never as a noun (Buy our hoovers) or a verb (Hoover your carpet). Using the word "Brand" after your trade mark can reinforce that it is a trade mark eg BANDAID brand plastic strips.

✗ Use the trade mark inconsistently

Your trade mark identifies the goods or services that you offer. You take great care in ensuring the quality of your goods or services and it is important to follow the same rules with your trade mark. To maximize reputation and protectability, always use the trade mark in the same form. Otherwise, people may become confused about what the trade mark is and the reputation in the trade mark will be diluted.

Do

✓ Use ® or ™

If you have a registered trade mark, always insert the ® symbol after your trade mark. You can only use this symbol once the trade mark is actually registered, not during the application phase. If your trade mark is not registered, use the ™ symbol to indicate that it is your trade mark.

✓ Put your trade mark on packaging

In addition to using your trade mark in advertising, it is important to ensure that your trade mark appears prominently on the product or packaging. This will again reinforce your title to and reputation in the trade mark and establish use of the trade mark.

✓ Register your trade mark with Customs

If your product is susceptible to counterfeiting, your business can be helped by putting a Customs Notice in place. This Notice allows Customs to seize any counterfeit product entering the country that bears your registered trade mark.

✓ Maintain a folder of trade mark use

Keeping a comprehensive folder of samples of how you have used the trade mark over time can avoid time consuming and tedious searching if it becomes necessary to defend the trade mark. Samples should include brochures, packaging, advertising, website use, letterheads, invoices etc.

✓ Update your registration on brand refresh

Trade mark registration only protects the trade mark in the form in which it is registered. If you do a brand redesign or refresh and change the form of the trade mark, it is very important to file a new trade mark application to protect the revised mark. Otherwise, your existing registration may be vulnerable to removal for non-use and you will not be able to sue for trade mark infringement of the revised trade mark.

Further Assistance

For further information and an initial consultation at no cost, please call Shelston IP on 02-9777-1111. We will advise you on the most suitable form(s) of protection to pursue and how to go about it. We will also provide a complimentary reference guide outlining the procedures, requirements and approximate costs of patents, trade marks and designs.

**Please Note: This list is not exhaustive and should not be relied upon as a substitute for professional advice.*

Don't

✗ Use ® for unregistered trade marks

It is a criminal offence to use the ® symbol next to your trade mark where you do not have the trade mark registered in the particular country. This is an issue even if you do have the trade mark registered in another country. For trade marks which are not registered in the particular country, use the ™ symbol.

✗ Allow unrestricted use of your trade mark

If you license or franchise your trade mark or others sell your goods, it is important to control how they use your trade mark. This can be done by including written restrictions and controls in the contract. Control is particularly important if you don't directly operate in the jurisdiction and rely on their use to avoid having your trade mark removed for non-use.

✗ Allow others to infringe your trade mark

Your trade mark is a valuable asset. Like other assets, it should be protected to maximize its value. Actively survey the market for misuse of your mark and take action if you see others trying to trade off your reputation. Of course, obtain advice from a trade mark attorney before making any infringement claims as you may be liable for costs or damages if you make unjustified threats of trade mark infringement. (For example, there is no infringement unless your trade mark is registered.)

✗ Register a mark that you don't use

Registration takes time and money. If a trade mark is not used for a certain period, someone else can apply to have it removed. This happens most often when you seek to enforce your trade mark and prevent the party seeking removal from using it. By using your trade mark in the form registered and maintaining evidence of use, you should be able to enforce your mark.

✗ Use your mark overseas without research

Some trade marks that work well or sound good in English (or in your local language) may have a very different meaning or implication overseas. Before you put significant time or money into building your brand, check that the name will work well in key overseas markets. A rebranding just for overseas use can add substantial cost, particularly if advertising materials and packaging have to be reworked.