

FREQUENTLY ASKED QUESTIONS FROM OUR INTERNATIONAL ASSOCIATES AND CLIENTS

AUSTRALIA – TRADE MARKS

Is Australia a 'first to file' or a 'first to use' country?

Australia is a 'first to use' country.

Are multiple class applications allowable?

Multi-class applications can be filed in Australia.

Can one or more priorities be claimed when filing?

Yes. Australia is a party to the Paris Convention and grants priority to trade mark applications filed in other Convention countries within a period of six months. A priority claim must be made at the time of filing of a trade mark application, or up to 2 business days later.

What documents are required when filing an application?

A person claiming to be the owner of a trade mark may apply for registration of that trade mark in Australia by lodging a trade mark application with IP Australia in an approved form, accompanied by the prescribed fee.

No statement of use is required. The act of applying for registration of a trade mark will generally be taken to indicate use or intended use of that mark in Australia.

A power of attorney is not required, however, an address for service in Australia or New Zealand is required.

Are divisional applications allowable?

Yes. A divisional application can be made where an application for a trade mark has been made and that first application (referred to as the 'parent application') is still pending. A divisional application must be made for the same trade mark and can be filed for classes within the parent application or specific goods and/or services within the parent application.

It is also possible to file more than one divisional application, by putting in a further divisional application from either your parent application or divisional application.

What is the typical time from filing to registration?

The typical time from filing to registration is about 7 ½ months after an application is filed, presuming no objections are raised by IP Australia during the examination stage or by a third party during the opposition stage.

7 ½ months is also the earliest that a trade mark can be registered. This is to fulfill IP Australia's international obligations to allow 6 months for applicants to claim a priority based on an earlier overseas filing date.

How quickly does an examination report issue?

If IP Australia objects to registration of a trademark upon examination of the application, the first examination report will typically issue (for general applications) between 3 and 5 months after a general application is filed or (for applications filed via the TM Headstart process) between 1 and 3 months after a TM Headstart application has been converted to a standard application.

However, if an application claims Convention priority under the Paris Agreement, examination will automatically be expedited in which case the examination report would be received within about 2 weeks after filing. However, the earliest that a trade mark can be registered is 7 ½ months, even if examination of the application has been expedited because of a priority claim.

What issues are typically covered during examination?

Once a trade mark application is filed, the application will be examined by IP Australia for compliance with formalities (such as specifications of goods and/or services) and on absolute grounds, for example, whether the trade mark is capable of distinguishing the relevant goods and/or services and on relative grounds whether there is a conflict with prior similar applications or registrations.

If IP Australia raises obstacles to registration based on one or more grounds, an examination report will issue with a deadline of 15 months from the date of the report to overcome all objections raised in the report. This 15-month period can be extended for up to 6 months upon payment of fees to IP Australia, and for further periods of time in limited circumstances upon application to IP Australia. It is also possible to defer the deadline for addressing objections raised in the report in certain circumstances.

Can the application process be expedited?

Yes, it is possible to request an expedited examination of a trade mark application, where the applicant believes that it will be seriously disadvantaged because of the time taken between the date of filing the application and the date of examination. However, the earliest that a trade mark can be registered is 7 ½ months, even if examination of the application has been expedited.

Do I have rights if I have prior used a trade mark?

Yes. Trade mark rights can be established through use, whether or not the owner of the trade mark has applied to register the trademark in Australia.

Is there an opposition process?

Yes. Once a trade mark application is accepted by IP Australia, the application is advertised in the Australian Official Journal of Trade Marks. Any person may oppose the application by, first, filing a Notice of Intention to Oppose within 2 months of the date of advertisement.

On what grounds can an application be opposed?

The grounds on which a third party may oppose a trade mark application are the same as the grounds on which IP Australia can object to registration of a trade mark (except for one, being the ground that the mark cannot be represented graphically), as well as additional grounds.

Grounds for opposing registration of a trade mark include:

- s 39 - the trade mark contains or consists of a sign that is prescribed in the Trade Marks Regulations 1995 (Cth) for the purpose of section 39(2)(a) of the Act (eg, a representation of the Arms, or of a flag or seal, of the Commonwealth or of a State or Territory), or so nearly resembles the prescribed sign as to be likely to be taken for it.;

- s 41 - the trade mark is not capable of distinguishing the applicant's goods and/or services from those of other traders.
- s 42 - the trade mark is scandalous or its use would be contrary to law.
- s 43 - the trade mark is likely to deceive or cause confusion.
- s 44 - the trade mark is substantially identical with, or deceptively similar to, a prior application or registration and relates to similar goods or services or closely related goods or services.
- s 58 - the applicant is not the owner of the trade mark.
- s 58A - if a trademark application has been accepted by IP Australia under s 44(4) on grounds of prior use, the opponent has earlier and continuous use of a substantially identical or deceptively similar trade mark.
- s 59 - the applicant does not intend to use the mark.
- s 60 - the trade mark is similar to the opponent's trade mark that has acquired a reputation in Australia and, due to that reputation, use of the applied-for mark is likely to deceive or cause confusion.
- s 61 - the trade mark contains or consists of a false geographical indication.
- s 62(1) - the application, or a document filed in support of the application, was amended contrary to the Act.
- s 62(2) - the application was accepted on the basis of false evidence or representations.
- s 62A - the application was made in bad faith.
- s 177 (for certification marks only) - the trade mark is not capable of distinguishing the goods and/or services certified by the applicant or an approved certifier from the goods and/or services not so certified.
- s 187 (for defensive marks only) - if it is not likely that the use of the trade mark in relation to the claimed goods and/or services will be taken to indicate that there is a connection between those goods and/or services and the registered owner.

Can a registration be removed and, if so, on what basis?

Yes. A person can apply to IP Australia to remove a registered trade mark for non-use on the ground(s) that:

1. The trade mark has not been used for a continuous period of 3 years ending one month before the filing of the removal application and either (for applications made before 24 February 2019) at least 5 years have passed since the filing date or (for applications filed on or after 24 February 2019) at least 3 years have passed from the date the trade mark was entered into the Register.

2. On the date the trade mark application was filed, the applicant for registration had no intention in good faith to use, authorise use of, or assign the trade mark in Australia, and the registered owner has not used the trade mark in Australia, or has not used the trade mark in good faith in Australia. An application on this ground may be made at any time after the trade mark application has been filed.

A person can also apply to the court to cancel a trade mark registration, including if the trade mark is no longer capable of distinguishing the goods and/or services covered by the registration (for eg, because it has become a generic term) or if the person can establish any of the grounds on which registration of the trade mark could have been opposed.

When does a registration need to be renewed?

A trade mark registration is in force for a period of 10 years from the date of application (or its convention priority date, if applicable), and can be renewed every 10 years upon payment of the renewal fees.

A trade mark registration can be renewed 12 months before the renewal is due, or up to 6 months after the due date. If payment is made after the due date, late-payment fees apply.

Can Australia be designated in a Madrid International Application?

Yes. Australia is a member of the Madrid Protocol. Accordingly, overseas trade mark owners can seek trade mark protection in Australia either by filing an application directly in Australia or by filing an international application via the Madrid Protocol nominating Australia as a member country in which protection is sought.

What do I do if I receive a provisional refusal in respect of an Australian Madrid designation?

If IP Australia objects to registration of an international registration on one or more grounds, IP Australia will issue a provisional refusal, which will be sent to the International Bureau. The provisional refusal will set out the grounds for objecting to the application and contain advice regarding the options to overcome the objection. The provisional refusal will also contain advice that the holder must provide an address for service in Australia or New Zealand if they wish to respond to the provisional refusal. Accordingly, if an overseas applicant receives a provisional refusal in respect of an Australian Madrid designation, the applicant should engage an associate in Australia or New Zealand to respond to the report.

The above comments are provided as a guide only and we encourage you to contact us to discuss your specific circumstances.

About Wrays

Wrays is a leading IP specialist firm in Australia, bringing together the right combination of experts to protect, grow and defend our client's intellectual property assets locally and globally for more than 100 years.

And when you combine our passion for achieving the best result with our broad capability across the IP spectrum, it's our clients who enjoy the benefits. In day-to-day reality, this means bringing the right people in the room every time and working together across disciplines to deliver what's needed.

It doesn't stop there. Through our extensive local and global networks, we can connect clients with like-minded experts who deliver supporting services, such as private equity, tax advisors, corporate and employment law, as well as IP specialists around the world servicing other jurisdictions.