

**Baldock Stacy & Niven** is a firm of lawyers with offices in Western Sydney and in Central Western New South Wales. We have a heritage going back more than 100 years to the firm's founding by Herbert Henry Lee in 1891.

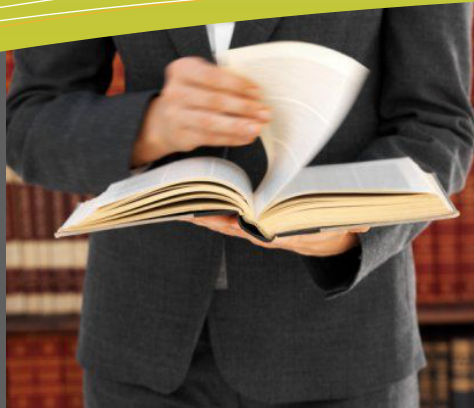
Over a century after the firm's founding our focus remains unchanged: a belief in the importance of understanding our client's needs, of adapting to the continuing challenges of business, and of delivering quality professional services in a timely and cost effective manner.

## Contact Us

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## Trademarks Guide

A short guide to the use and registration of trademarks in Australia

### Introduction

The identity of your goods and services is a major business investment and is worth protecting. This guide is intended to give you some practical points on trademarks. **Baldock Stacy & Niven** would be happy to assist you with your trademark questions. □



### What is a trademark?

A trademark can be a letter, number, word, phrase, sound, smell, shape, logo, picture, aspect of packaging or any combination of these. It is any sign that is used to distinguish goods and services of one trader from another. This means you can't register a trademark that directly describes your goods (e.g. radios) and services (e.g. electrician).

Trademark law exists partly to protect consumers, providing an indication of quality. That indication has a value for the trademark owner, embodying a goodwill that can be monetised and that is often significantly more valuable than manufacturing facilities or other tangible assets. It allows the owner of the mark to build/maintain a brand - evident in Nike's swoosh and the Coca-Cola ribbon. □

### Selecting a trademark

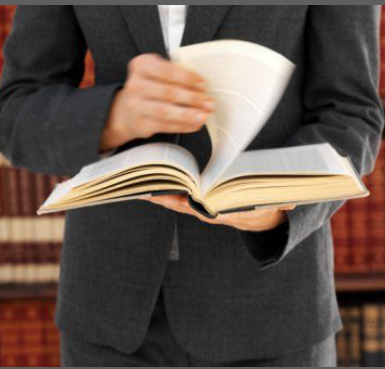
The most effective trademarks:

- are easy to pronounce
- are easy to spell
- are easy to remember
- are easy to reproduce verbally or in writing
- do not have different or controversial meanings in other languages
- are easy to distinguish from trademarks used by competitors.

It is best to choose a distinctive non-descriptive mark. A distinctive mark is easier and quicker to register. It is important to distinguish your mark from other marks for similar goods and services offered by your competitors. If possible use a unique font, colour combination, logo or device.

If you use a slogan in conjunction with a product or service, it can also be registered as a trademark (eg. "Simply the best from Sharp"). □





## Registering a trademark

**Trademark registration is not compulsory in Australia but it is advisable. There is protection against misrepresentation under the trade practices or fair trading legislation. It is also possible to take action under common law but this can be a time-consuming and expensive exercise.**

A registered trademark gives you the exclusive legal right to use, license or sell it within Australia for the goods and services for which it is registered.

You should always carry out a search of existing trademarks before using a mark or applying for registration. You may find yourself the subject of legal action if the trademark you propose to use is already registered or in use by someone else.

Initial registration of a trademark lasts for 10 years. After that time, you can continue to renew your registration for successive periods of 10 years on payment of the appropriate fee. A trademark can therefore have an infinite life representing significant business value. You must, however, use your mark in a bona fide way to avoid it becoming vulnerable to removal on the grounds of non-use. □



## Protecting your trademark

Trade marks in Australia can be protected:

- by registration with IP Australia under the Trademarks Act 1995 (Cth)
- at common law by an action known as the tort of passing off; or
- by the misleading and deceptive conduct provisions of the trade practices legislation.

Unlike many other forms of property, a trademark must be in use as a trademark for the registered holder to maintain its trademark rights.

Infringement of a trademark occurs where a person uses a trademark or sign that is substantially identical with or deceptively similar to a registered trademark in use by another in relation to certain goods or services. The tort of passing off is a common law action used to prevent trader A from misusing trader B's goodwill or reputation by misrepresenting that A's goods or services are those of or related to B.

Most passing off actions are brought in conjunction with an action for breach of the misleading and deceptive conduct provision of the trade practices legislation. The two actions are similar, although under the trade practices provision it is not necessary to prove customers have actually been misled.



## Use of Symbols for Trademarks

The use of the symbols <sup>TM</sup> and ® is not recognised by Australian statute law.

Whilst consumers attach some significance to these symbols, we suggest that a more explicit trademark notice should be used in conjunction with these symbols

<sup>TM</sup> is usually used to refer to an unregistered trademark

® is usually used to refer to a registered trademark

## Using Trademark Notices



If your trademark is registered, you should ensure that a trademark notice such as *Registered Trademark* appears on all marketing materials, packaging, accompanying product literature such as instruction manuals and product labels.

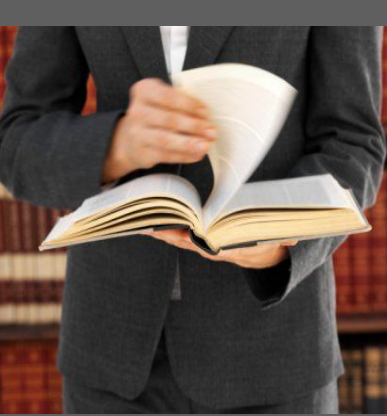
Trademark notices are not a mandatory requirement under the Trademarks Act, but we suggest that it is highly desirable to publish a trademark notice immediately next to your trademark whenever it is used.

A trademark notice can take the form of a written statement or the use of a symbol such as <sup>TM</sup> or ®.

You also have rights in an unregistered trademark, so if your trademark is not registered, declare your ownership on all of your marketing materials, packaging, accompanying product literature and product labels with a trademark notice such as <sup>TM</sup> or *Trademark of the Ford Motor Company*.

Link your trademark and the trademark notice with an asterisk, that is, put an asterisk after where the trademark first appears in a brochure and then reference the asterisk at the bottom of the brochure (eg. *\*Registered Trademark of Sony Corporation*).

Never use your trademark as a noun and only use it as an adjective (ie. Don't say "Buy a Xerox" says "Buy a Xerox Photocopier"). □



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## Using your Trademark

You should ensure that you advertise your products and services and make sure that you approve all uses of your trademark in all brochures, point-of-sale material and television, radio and print advertising. You should also make sure that your trademark is clearly and accurately reproduced on any promotional or retail merchandise that is being produced.

Ensure that you maintain quality control over the quality of the goods or services associated with your marks and any marketing materials produced. Check the quality of the reproduction of your trademark whenever it is used. ☐

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## About Us - Baldock Stacy & Niven

### Who are we?

Baldock Stacy & Niven is a firm of lawyers with offices in Western Sydney and in Central Western New South Wales. We have a heritage going back more than 100 years to the firm's founding by Herbert Henry Lee in 1891.

### What is our aim?

Over a century after the firm's founding our focus remains unchanged: a belief in the importance of understanding our client's needs, of adapting to the continuing challenges of business, and of delivering quality professional services in a timely and cost effective manner.

### Who are our clients?

Baldock Stacy & Niven has a wide range of city and country clients from various industries and lifestyles. We offer a broad legal practice offering professional legal advice and service in many varied areas.

### How do you arrange to see us?

If Baldock Stacy & Niven are already your solicitors please ring and speak to the solicitor you normally deal with.

If Baldock Stacy & Niven are not your solicitors, please ring Stuart Niven in our Parramatta Office on (02) 9891 6444 to make an appointment.

*The material in this brochure is not a substitute for legal advice and is only of general informational value. No person should act or refrain from acting solely on the basis of this brochure. It does not constitute legal advice and your possession of this brochure does not create a client/lawyer relationship. If you would like to discuss your particular circumstances please contact Baldock Stacy & Niven and we would be pleased to be of assistance to you.*

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**Baldock Stacy & Niven**  
Solicitors and Notaries