

# TRADE MARKS

## A GUIDE FOR JOURNALISTS

### WHAT IS A TRADE MARK?

A trade mark is a mark used to distinguish the goods and services of one trader from those of another. Trade marks are one form of intellectual property (often shortened to 'IP').

### WHAT CAN BE REGISTERED AS A TRADE MARK?

A trade mark can be a word, slogan, sound, smell, shape, logo, picture, aspect of packaging or a combination of these.

### WHAT IS THE DIFFERENCE BETWEEN A TRADE MARK AND A BRAND?

A brand is a promise that is made by a trader to its customers. A trade mark is the way that brand is communicated to the consumer. For example, a trader may market its products as luxury items. The brand is the promise of luxury associated with the products. The associated trade mark may be a symbol or name that the consumer uses to identify the trader's goods. "Brand" is a marketing term, not a legal one.

### DO TRADE MARKS HAVE TO BE REGISTERED?

No. However, if unregistered, trade marks are not protected by the *Trade Marks Act 1995* (Cth). Instead, Passing Off law protects unregistered trade marks.

### WHY REGISTER TRADE MARKS THEN?

Registered trade marks are easier (and therefore cheaper) to enforce than unregistered trade marks. See [http://www.choylawyers.com.au/protecting\\_brands.htm](http://www.choylawyers.com.au/protecting_brands.htm). Suing under Passing Off law can be difficult and costly.

By registering a trade mark, a trader can prevent other traders from using the mark. This can be a very powerful and valuable commercial right.

### HOW ARE TRADE MARKS REGISTERED?

See [http://www.ipaustralia.gov.au/trademarks/process\\_index.shtml](http://www.ipaustralia.gov.au/trademarks/process_index.shtml)

### WHAT DO THE SYMBOLS ® AND TM MEAN?

® can only be used with registered trade marks.

TM can be used with any mark, whether registered or not.

### DO I HAVE TO USE THE SYMBOLS IN MY STORY?

No. Companies will often prefer that the symbols are used but it is not necessary.

### CAN I REFER TO A TRADE MARK WITHOUT PERMISSION FROM THE OWNER?

Yes.

But you will need to be careful not to misrepresent the ownership of the mark and the goods to which it relates. Do not say that a mark represents someone else's goods or services.

### WHAT NORMALLY HAPPENS IF A TRADE MARK IS INFRINGED?

Trade marks are protected through legal proceedings.

Normally the first step is for the owner to send a letter of demand requiring unauthorised use of the trade mark to stop.

This may be bypassed in cases where the unauthorised use must stop urgently or else great damage will be suffered by the rightful owner. In such cases the owner may apply for an injunction.



The next step in either case is to bring legal proceedings (normally in the Federal Court). If successful, the owner can claim monetary compensation (damages) and an order to prevent further infringement, as well as repayment of a portion of the legal costs.

#### WHAT ARE TRADE MARKS WORTH?

It is difficult to place an exact value on trade marks (or for that matter, any form of intangible property), because there are many different valuation methods, all of which incorporate subjective judgments. Each valuer has a preferred method. Annual surveys are published by valuers of leading brands, and some trade marks can be valued at many millions of dollars (see [www.brandchannel.com](http://www.brandchannel.com)).

#### WHAT IS THE MEANING OF 'COUNTERFEIT', 'PIRATED', 'BOOTLEG' AND 'INFRINGEMENT'?

**"Infringing"** means any product that breaches intellectual property rights. Counterfeit and pirated products are a subset of infringing products. Also included are products which simply have one feature that is too similar to a registered trade mark – an example could be El-Cheapo Cola packaged in a bottle resembling the Coca-Cola bottle, even though the name and graphics are different. The El-Cheapo product is not a counterfeit or pirated version of the Coca-Cola product but by using the same bottle it may be an infringement.

**"Counterfeit"** means products that infringe patent rights, utility model rights, design rights, or trade mark rights – a typical example is a fake Louis Vuitton handbag which can look identical to the genuine article and is difficult to tell apart.

**"Pirated"** mean products that infringe copyrights on music works, films, broadcasting programs, and game software – a typical example is a CD with a copy of Rolling Stones music, packaged to appear like the original.

**"Bootleg"** means an audio recording that was not officially released by the artist – a typical example is an unauthorised recording made at an actual live concert. While the packaging may bear the artist's logo, it will not normally be made to look identical to an authorised product (see pirated).

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#### WILL REGISTERING A TRADE MARK IN AUSTRALIA PROVIDE INTERNATIONAL PROTECTION?

No. Each country has its own trade mark register and trade mark law. To get protection in another country the trade mark must be registered in that country.

#### WHAT ARE THE COMMON MISTAKES MADE BY JOURNALISTS?

##### **"He has patented the word"**

Words cannot be patented. They may be registered as trade marks.

##### **"She copyrighted the name"**

Names and slogans cannot be copyrighted. It may be possible to register them as trade marks.

##### **"He trademarked the invention"**

Trade marks do not protect inventions. Patents protect inventions. Trade marks are, however, able to protect the name and logo which are used to market an invention to the public.

#### WHY ARE THERE TWO SPELLINGS – 'TRADE MARK' AND 'TRADEMARK'?

'Trade mark' is spelt as two words in Australia, UK and Commonwealth countries. It is spelt as one word in the USA and rest of the world.

#### SOME RESOURCES

IP Australia (Australian Trade Marks Office) - [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)

Brand Channel (discussion website for brand matters) - [www.brandchannel.com](http://www.brandchannel.com)

Brandweek (US marketing industry magazine) - [www.brandweek.com](http://www.brandweek.com)

B& T (Australian advertising and marketing industry magazine) - [www.bandt.com.au](http://www.bandt.com.au)

Ad News (Australian advertising and marketing industry magazine) - [www.adnews.com.au](http://www.adnews.com.au)

#### STILL HAVE UNANSWERED QUESTIONS?

Phone or email Trevor Choy - 03 9602 1000 or [tc@choylawyers.com.au](mailto:tc@choylawyers.com.au)

Or visit [www.choylawyers.com.au/mediahelp.htm](http://www.choylawyers.com.au/mediahelp.htm)



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