

Guide to FAST TRACKING YOUR TRADE MARK APPLICATION

You may have come to the decision to trade mark your business name and logo as soon as possible in order to reduce the risk of a third party copying your branding. Unfortunately, a standard trade mark application takes a minimum of seven months from start to finish. This article will provide you with tips on what you can do to help expedite your trade mark application, including how to request an early examination.

TIP 1 - SEARCH IP AUSTRALIA'S DATABASE

You should thoroughly search IP Australia's database to ensure that there are no other similar trade marks that are already registered. The search will alert you if there are any similar or identical marks. If there are similar or identical trade marks the owners of those trade marks may oppose your application, which may cause significant delay and costs. Due to the intricacies of the search platform and the number of different search algorithms that are available.

TIP 2 - GET THE CLASSES RIGHT

When you register a trade mark you must provide a description of the goods or services you intend to use your trade mark in respect of. You should be careful to include all goods and services that you wish to include in your application as once the application has been filed you cannot substantially amend it. If you fail to register your trade mark in a class you may end up without the protection you actually need, causing further delay and costs or simply rendering your trademark useless. IP Australia provides a classification search to assist you in identifying the correct classes and descriptions of goods or services.

Again, due to the risks associated with getting this wrong, we recommend you get in touch with one of our experienced lawyers to assist you with this step.

TIP 3 - ENSURE YOUR TRADE MARK IS ORIGINAL

You must ensure that your trade mark is distinguishable and original. Names that are descriptive of their related products and services are often considered unoriginal and difficult to register because other traders have a legitimate need to use them to describe their goods or services. The same applies for trade marks that incorporate common Australian surnames. If your trade mark is not original, IP Australia will reject the trade mark application or request you to amend it. You must then attempt to overcome this issue by collating and submitting significant evidence of use, showing that the public have come to associate the mark with your business. This process can add up to eighteen months on the trade marking process. You may also forfeit your application fees if the issue cannot be overcome.

TIP 4 - FILE A TM HEADSTART APPLICATION

A TM Headstart application is a simple and fast service provided by IP Australia that assesses the likely success of your proposed trade mark before you file it publicly. The service provides you with a prior assessment of your trademark application that will assist you in identifying and correcting any potential issues that may arise, saving you time and money. IP Australia will generally respond to your application within a week, so you have certainty upfront as to whether your trade mark is sufficiently original and meets all other requirements of a trade mark. It is important to note that a TM Headstart application does not provide trade mark protection. If the results of the application are favourable, you will then need to proceed through the standard trade mark process which can still take a significant amount of time.

Note that trade mark protection is backdated to your original standard application date assuming it passes the examination and publication processes.

TIP 5 - REQUEST AN EARLY EXAMINATION

You may request an early examination of your application in certain circumstances, by submitting a "Request for Expedited Examination of a Trade Mark Application" to IP Australia.

Requests are more likely to be accepted where any delay in examining your trade mark could result in commercial or other disadvantage. For example, if you have legitimate concerns that someone such as a supplier may copy or imitate your trade mark and you need certainty that the trade mark is protected prior to entering into certain arrangements (such as a distribution agreement), then you may be successful in applying for early examination.

We have also seen successful expedited applications be made where the relevant business is looking at expanding into foreign markets and requires protection of their trade mark overseas.

KEY TAKEAWAY

We have successfully requested expedited examinations in respect of numerous trade marks on behalf of our clients. In the event that we do not consider an expedited application will be successful, we will generally recommend you undertake a TM Headstart application in order to find out the likely result of your application quickly. If you are considering trade marking your business name and/or logo, feel free to contact one of our team members today and we will assist you with the process.