

# Overview of Trade Marks in Australia

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## What is a trade mark?

A trade mark is a ‘badge of origin’ and is used to distinguish the goods (or services) of one person provided in the course of trade from those of another. A trade mark needs to be a ‘sign’ and this can be a letter, word, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent or any combination of these. Some examples of trade marks are a particular shape for BBQs, the colour orange for electronic communications products, and the sound ‘pip pip pip’ for long-distance telephone services.

A trade mark can be described as a “packet of information” and under economic theory this provides a justification for trade mark protection as it allows consumers to reduce their search costs in choosing between products. The “packets of information” may also be used to associate more abstract ideas with a particular product, such as the notion of ‘cool’ or other ideas people are attracted to such as freedom, success and power. While the products themselves may not be able to deliver any tangible form of these ideas, the association of the idea with the product is a powerful tool in making the product more appealing to the consumer. This is becoming a very important aspect of trade marks.

## Registration and duration of trade marks

For a trade mark to be registrable, it must be inherently adapted to distinguish, not likely to deceive or cause confusion, and not deceptively similar to any trade marks registered in Australia or being used here with a strong reputation. The requirement of distinctiveness means that a sign will not usually be registrable if it is ordinarily used to indicate kind, quality, quantity, intended purpose, value, geographical location or time of production. Trade marks must be registered in connection with particular goods or classes of goods. Once a trade mark is registered, it is possible for this intellectual property right to be perpetual, provided the registration fees continue to be paid and the mark continues to be used. This is in contrast to other forms of intellectual property that have limited life spans, such as designs or patents.

## Protection of trade marks

A trade mark does not need to be registered, but there is greater protection if it is. Unregistered trade marks can be protected by the common law doctrine of passing off, but this is not as easy as an action under the Trade Marks Act 1995 (Cth). If someone else uses the trade mark, or one that is substantially identical or deceptively similar, in connection with the goods for which the mark has been registered, the owner can take

action to stop the infringing mark from being used and to get compensation from damage the infringement may have caused.

Francis Abourizk Lightowers Commercial & Technology Lawyers have extensive expertise in the registration and protection of trade marks. Our focus is on the creation, development and protection of strong intellectual property assets that will be a significant force in your business.

If you wish to discuss these matters please contact Peter Francis at Francis Abourizk Lightowers, Commercial and Technology Lawyers.

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