

The Pitfalls of Self-Filing a Trade Mark

We increasingly come across individuals or businesses that are self-filing trade marks and managing their own portfolios. Their reasoning – why pay a lawyer to do it, when I can do it cheaper? Well, here are a few reasons that might make you reconsider self-filing a trade mark

Searching and preliminary registrability advice

We recommend a search is undertaken to see if there are earlier filed trade marks that may pose an issue to your application. Trade marks are listed on a publicly available database, which means anyone can search. But do you know what you are searching for?

In conducting a search, an experienced trade mark lawyer will apply the same rationale and legal tests that a Trade Marks Examiner will when reviewing your application. This goes beyond a search for identical trade marks – it means considering whether earlier filed trade marks are sufficiently similar to prevent your registration, and the likelihood that objections can be overcome.

An experienced lawyer will also consider whether your trade mark is likely to gain registration, taking into account the restrictions prescribed by trade marks legislation. For example, a trade mark that is descriptive of the goods and services in the application will nearly always receive an objection.

If the path is clear, that's great. If it's not, you may wish to amend or reconsider your trade mark before you incur IP Australia application fees. The search results may also influence the filing strategy. It may require careful drafting of the specification and advice on whether to file a logo or word mark.

Preparing the description of good and services

All trade mark applications must designate specific goods and services. The description will ultimately define your scope of trade mark protection, so it's important to get it right. A trade mark lawyer will help you gain the broadest protection possible. Sometimes that might mean preparing an expansive description of what you do, and sometimes it might mean being more specific to avoid objections based on earlier filed trade marks, or to limit the risk that your trade mark is considered descriptive of your goods or services.

The below example illustrates a common mistake. The first description might be exactly what your business offers, but it's narrow. The second description is broader.

Narrow – managing the construction of carbon neutral buildings

Broad – Building project management; building construction services; repair, installation, maintenance and renovation services

Imagine with this example that a competitor is looking to use your exact trade mark to market the installation of solar panels. Which of the above descriptions would you want to rely on?

There are 45 different classes into which goods and services fall. It's important to accurately identify which classes are relevant to your business so you don't receive unnecessary objections. For example, 'digital photographs' are class 9 goods; 'printed photographs' are class 16 goods, 'photograph albums' are class 16 goods; and 'photograph frames' are class 20 goods.

Failing to include the appropriate classes in your application may mean you cannot allege trade mark infringement should someone use your trade mark in relation to the unspecified goods.

Choosing the right trade mark

The right trade mark should:

- a) Be the trade mark you are actually going to use.
- b) Be registrable – to avoid potential Trade Marks Office objections.
- c) Provide you with broad protection – should it be a word mark, a logo or a combination?

Of course, deciding which trade mark is the right trade mark may be influenced by the search results.

Receiving Trade Mark Office objections

When a trade mark lawyer or attorney files your trade mark application, they will be listed as your agent. This means they will receive all genuine correspondence relating to your trade mark. If the Trade Marks Office raises an objection to registration, they will receive the report and advise you of the ways you can overcome the objection. You don't need to monitor your application or interpret Trade Marks Office correspondence.

There have also been an increasing number of unauthorised third parties corresponding with trade mark applicants, requesting payment of fees. If you file your own trade mark, be careful not to pay illegitimate invoices.

Maintenance of Trade Mark Portfolio

Trade marks must be renewed every 10 years. If you miss a renewal, registration may lapse and you can lose your protection. As long as you have an agent, they will remind you of all renewals and manage the process.

For more information on the trade mark application process, please contact:

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