

Costs and procedures for obtaining Trademarks

Searching

Australia

Rights to a Trade Mark can be accrued in two different ways, firstly by registering the Trade Mark, and secondly by using the Trade Mark rights accrued as the reputation of the mark builds (so called "Common Law" Trade Marks). To determine whether rights are registered or not can be checked by a search through the records of the Trade Marks Office. We can conduct searches at quite low costs where no opinion is to be given. If a search is to cover only a narrow range of goods and the trade mark is a word or words then the cost is likely to be of the order of \$200. If the search is for a broad range of goods the cost will be higher. If the search is to cover a graphic the cost is likely to be a little higher and of the order of \$400 to \$800 for a narrow range of goods. The results of a searches are generally available within a few days although graphic searching generally takes a little longer, but can mostly be done on an urgent basis on the same day if required.

Overseas Countries

Databases

Database searches are available for a range of countries. These include USA, Canada, United Kingdom, Italy, France, Germany, and several other European Countries. Results from these searches can be achieved within the same time frame as searches in Australia. A drawback with these searches is however that there is often a significant time delay with new applications being added to the databases. The costs of these database searches can be expected to be within the range of \$300 to \$400 per country for a word mark for a narrow range of goods. An initial relatively unreliable scan can also be conducted for about \$350 for Australia, United States and United Kingdom. Such a scan is often used to determine which of several Trade Marks may have any prospects for registration or is clear of infringement difficulties.

Searches by Associates

The most reliable searching in many overseas countries is to have one of our associates conduct a search through the Trade Mark records of the respective Trade Marks Office. Typically such searches take some 2 to 4 weeks and cost in the order of \$1000.

Common Law Rights

There is no absolute way of determining whether Common Law rights exist for a particular Trade Mark. In Australia in some instances potential Common Law Trade marks can be checked by searches through Trade Journals, Telephone indexes, ASIC company records, Corporate Affairs Business names records. The cost is considerably higher than searching through the records of the Trade Marks Office due to the time taken and availability of information. We can undertake a common law rights search for \$800.

Trade Mark Application Procedure

Australia

A Trade Mark application must nominate the goods, or services, for which registration is sought. A single application can nominate goods or services that fall within one or more "classes" but additional fees are payable for extra classes. If the goods or services of a potential infringer fall outside of the specific description nominated in the registration or similar goods or services there will be no infringement, so it is important to ensure that the scope of protection covers goods and services that are required for a defensive registration. Where a combination of Trade Marks, such as a word and a device, are to be registered it is generally desirable to register the Trade Marks separately to ensure that variations of each of the Trade Marks cannot be used.

The cost of filing a single application is \$490, where the application is filed in more than one class the cost of each further class is \$380. We are able to offer discounts where several applications are filed at the same time, or where the statement of goods and services is straightforward e.g. wines.

Examination

After applications have been prepared and filed. There is a waiting list of between 3-4 months before the Trade Marks Office conducts their own search for conflicting applications or registrations, and makes an assessment as to whether the Trade Mark is inherently registrable or not. The examination process occurs automatically and no specific request is required. It is possible to achieve expedited examination in specific cases, on request and together with evidence that there is a genuine commercial conflict that requires resolution or considerable funds are about to be invested in the trade mark.

Often a First Examiner's report will issue with objections. In a straightforward case the cost of correspondence and research for countering the Examiner's objection may cost between \$120-\$400. Where there are some complexities, for example, where evidence is required to demonstrate that the Trade Mark has acquired distinctiveness in the trade, then the costs can be expected to amount from between \$700 to \$1200.

Typically a period of 15 months from the date of the Examiner's report is given to place the application in order for acceptance. An additional 6 months can be obtained with the payment of monthly extension fees.

Acceptance and Registration.

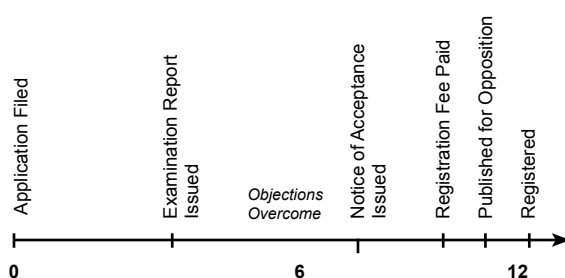
Once the Examiner is satisfied that the application should be allowed the application is said to be accepted. The application will not however proceed to registration until around 7 ½ months from the application date to allow the filing of Convention application claiming priority from overseas filings. It is possible for a third party to oppose the grant of the Trade Mark within a time window of 3 months from the date that acceptance is published. This deadline can be extended by a potential opponent for a further period of 3 month. It is very rare to encounter opposition proceedings unless there is a commercial conflict. A registration fee is payable to progress the application to grant at a cost of approximately \$448 and each additional class \$382.

The overall cost of obtaining a registered Trade Mark in a single class can be expected to be of the order of about \$1500.

Duration and Renewal

The duration of a registration at present is 10 years however the registration can be renewed indefinitely for periods of 10 years. The cost of the renewal in one class is \$575 and each additional class \$454.

Set out below is a typical time line diagram for a Trade Mark application.



Overseas applications

Unlike for Patents and Registered Designs it is not as critical to maintain a "priority date". It is possible to file into an overseas country at any time providing that there are no conflicting registrations or common law rights (where applicable). The costs of filing an application in a single class to an overseas country varies considerably, however applications typically range from \$1200 to \$2000.

The Trade Mark offices of most overseas countries, like Australia, also have substantive examination and usually a registration fee is payable. A typical total cost of achieving registration in overseas countries for a single class can be expected to be in the range of \$3500 to \$7000.

Regional registrations are also possible for the countries of the European Union by way of a Community Trade Mark (CTM). Such a registration covers the following countries:

Austria, Benelux (Belgium, the Netherlands and Luxembourg), Bulgaria, Cyprus, the Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Malta, Poland, Portugal, Romania, the Slovak Republic, Slovenia, Spain, Sweden and the United Kingdom.

The approximate cost of achieving registration by way of the CTM can be expected to be in the order of \$7500 to \$10000.

Australia is also a member of the Madrid Protocol which enables filing of an "International Registration". Unfortunately some of Australia's trading partners within Asia are not yet members and therefore this protection is somewhat limited. However more countries are becoming party to the Protocol and therefore depending upon the countries of interest it may be a viable option (a list can be provided upon request). The Madrid registration must be based upon a home registration or application for a period of 5 years. Accordingly an application would also be required in Australia. The cost will vary depending upon which countries are covered. We can provide a quote if the countries of interest are identified.

Also please note that many countries require evidence that the Trade Mark has been used, either before registration, some time after registration, or before renewal. Accordingly a Trade Mark application can be filed too early in overseas countries if use is not anticipated for some time.