

ASSOCIATES INFORMATION SHEET TRADE MARKS IN AUSTRALIA & NEW ZEALAND**ASSOCIATES INFORMATION SHEET TRADE MARKS IN AUSTRALIA (AU) & NEW ZEALAND (NZ) v281119**

Please find following our information sheet for trade mark applications in Australia and New Zealand.

The information sheet is not exhaustive but covers most common items incurred during filing.

Should you require additional information or if you have any questions then please let us know.

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ASSOCIATES INFORMATION SHEET TRADE MARKS IN AUSTRALIA & NEW ZEALAND**1 PRE-FILING PROCEDURES****1.1 COMMON LAW SEARCH**

- 1.1.1 Australia and New Zealand are separate sovereign and legal jurisdictions and both in Australia and New Zealand rights can exist in unregistered trademarks. Registration of a trade mark is not a defence to infringement of an unregistered conflicting trade mark and official examination of a trade mark application will not include a search for conflicting unregistered trademarks. It is left to the applicant to conduct relevant clearance searches prior to using a trade mark.
- 1.1.2 Therefore it is prudent that a 'common law clearance search' is conducted before the applicant commences using the trade mark. Frequently this is conducted prior to filing the corresponding trade mark application, however, can be conducted at a later time but should be conducted before actual use of the trade mark occurs to mitigate the risk of infringing an unregistered trade mark.
- 1.1.3 There is no exhaustive collection or method of searching for unregistered trademarks. Therefore common law clearance searches have limitations.
- 1.1.4 The results of a common law clearance search can only be taken as an indication of the state of the trade mark environment and is only conclusive when you find a conflicting unregistered trade mark.
- 1.1.5 Nevertheless conducting a common law clearance search can increase the applicant's confidence in the state of the trade mark environment prior to using the trade mark, and can provide evidence of the applicant's due diligence and innocence in case infringement of an unregistered trade mark occurs. Therefore common law clearance searches are highly prudent even though not compulsory
- 1.1.6 Common law clearance searches can be conducted to a budget and the scope of the search will, of course, be limited by the agreed budget. As a recommendation, we suggest that a minimum budget equivalent to the costs of a register search be set aside for a common law clearance search.

1.2 REGISTER SEARCH

- 1.2.1 Australia and New Zealand are parties to the Madrid Protocol. Therefore a register clearance search for Australian and or New Zealand trademarks should also include a search of the Madrid protocol register as well as the national Australian and or New Zealand register as applicable to ensure all applicable registers are searched.
- 1.2.2 Of course in the absence of a voluntary register clearance search the earliest the applicant will find out about a prior conflicting trade mark will be during official examination of the trade mark.
- 1.2.3 If the applicant is not intending on using the trade mark until sometime after registration then the applicant may choose to rely on the result of the official examination procedure rather than conduct a voluntary private register clearance search prior to filing, however, the examination procedure will not of course avoid the prudence of a common law clearance search for the previously mentioned issue of unregistered trade mark rights.

2 NATIONAL APPLICATION PROCEDURE TO REGISTRATION**2.1 FILING STAGE**

- 2.1.1 Australia and New Zealand are separate sovereign and legal jurisdictions and if registration is required in either country then a national application must be filed before the corresponding national trade marks office.
- 2.1.2 Australia and New Zealand are operational signatories to the Madrid Protocol consequently International trade mark registrations can be afforded protection in Australia and New Zealand through the Madrid Protocol.

ASSOCIATES INFORMATION SHEET TRADE MARKS IN AUSTRALIA & NEW ZEALAND**2.2 EXAMINATION STAGE**

2.2.1 Once a trade mark application is lodged it will be examined by the trade marks office as to its inherent registrability, whether it conflicts with any one or more earlier trademarks that are either registered or are the subject of a pending application for registration, and whether it is precluded from registration for other reasons.

2.2.2 Typically examination will commence within two to four months of the filing of the trade mark application but this time is subject to the work load of the trade marks office at the relevant time. In any event, this period of time may be reduced in some circumstances by lodging a request for expedited examination.

2.2.3 If any adverse objections are raised during examination then these must be successfully overcome before the application can be accepted by the trade marks office.

2.3 ACCEPTANCE STAGE

2.3.1 If the application is in order then a notice of acceptance will be advertised in the relevant official Australian or New Zealand trade mark journal indicating that the application has been accepted.

2.3.2 Applications that are accepted are then subject to an opposition period [two month period in Australia] | three month period in New Zealand] during which third parties may oppose the application by way of a formal opposition procedure.

2.3.3 The opposition period commences from the date the notice of acceptance is advertised in the respective official trade mark journal.

2.3.4 In our experience, very few trademarks are opposed and even fewer are successfully opposed.

2.4 REGISTRATION STAGE

2.4.1 If the application remains unopposed then the trade mark will be registered in Australia and New Zealand in due course. Payment of registration fees are no longer required in Australia for applications filed after 10 October 2016.

2.4.2 The initial term of registration in Australia and New Zealand is 10 years and in both cases may be extended by 10-year terms on the timely payment of a renewal fee.

2.4.3 In any event, the earliest a trade mark can be registered typically will be a minimum of six months from the priority date of the application to allow obligations under the Paris Convention to be exhausted.

3 INFORMATION REQUIRED TO LODGE A TRADE MARK APPLICATION**3.1 FILING REQUIREMENTS | AUSTRALIA**

3.1.1 Information we require from you to prepare and file a trademark application is set out on our website or click the following link| www.spc.com.au/auftrm.htm

3.2 FILING REQUIREMENTS | NEW ZEALAND

3.2.1 Information we require from you to prepare and file a trademark application is set out on our website or click the following link| www.spc.com.au/nztrm.htm