

Trade Mark Registration Services at Coleman Greig

The team at Coleman Greig thank you for your enquiry into our trade mark and other IP portfolio management services.

We aim to provide a turn-key solution to our clients' needs – offering expertise and value for money. We have extensive experience in not only advising and maintaining trade mark (and other IP) portfolios, but also in navigating the most cost effective way to achieve your trade mark and IP business goals.



We are currently assisting an array of clients with trade mark registrations (both domestically and internationally), Opposition actions against trade mark applications, Removal for Non-Use Application filing and defence, trade mark infringement matters, and general advice and management of trade mark applications in a variety of international territories.

Please find following a brief summary and general information on how we may assist you to obtain registered trade mark assets for your business, and indicative costs.

A. Why apply for a registered trade mark?

It is not essential to register a trade mark. Use of a trade mark with the intent and effect that it act as a 'badge of origin' over time can give rise to unregistered rights known as common law trade mark rights. Common law rights can be relied on to

- a) support a reputation in a trade mark and, if a can be demonstrated; then
- b) exclude others from use of the same or similar mark in relation to the same or similar goods and services.

The system of registering a trade mark overcomes the need to demonstrate a reputation in a mark before attempting to exclude others from using the same or similar mark.

So, registration is desirable not only because it easily enables a person to stop someone using a mark that is identical or very similar but it is also a valuable business asset that can be commercialised, licensed or sold.

In short, a business should attempt to register (at least) its name as a trade mark to:

- a) obtain an asset that can be sold or licensed;
- b) exclude from use by others of the mark on the same goods or services which can provide a competitive advantage and prevent new market entrants;
- c) demonstrate an owner's reputation in a mark without having to demonstrate that reputation on evidence in any court proceedings; be able to use the ®. If not registered, only the TM can be used; and
- d) registration can be held in perpetuity if renewal fees are paid. This is different to rights like copyright and patents which have a definite expiry.

B. Summary of trade mark process

A registered trade mark has two elements:

- the plain word or stylised logo; plus
- a specification being an identification of the goods or services to which the word or logo will be applied according to international 'classes'.

To be registered, a trade mark cannot be simply descriptive of the goods and services it purports to sell/provide. Third party traders must be able to use common words to describe the goods/services. However, a unique word name or a stylised (logo) version of descriptive words can be allowed if that version would distinguish the owner's goods from those of others in the field.

The primary steps in applying for a trade mark are:

- a) Application (preparation and filing);
- b) Examination Period where an IP Australia trade marks examiner reviews the application (mark + classes to ensure the overall mark meets the requirements under the Trade Marks Act 1995, and to evaluate if not descriptive and not identical or similar to another trader;
- c) Examination Reports are issued which advise any objections by the examiner or issues to overcome so the mark can proceed to Acceptance;
- d) Acceptance (when the examiner agrees that we have met all formal requirements and the application can proceed to registration)
- e) Opposition (a 2 month period after Acceptance and before Registration, when any interested member of the public can come forward and justify why you should not be granted a registered trade mark); and
- f) Registration (you can now stop other people using your mark in Australia)

Each Registration period lasts 10 years at which time a renewal fee must be paid for protection to continue for a further 10 years. This will be required every 10 years from Registration if the trade mark is to stay on the Register and remain protected.

C. Recommendation of what to file

We work with you to identify potentially registrable rights and provide you with a strategy to help minimise costs in the application process while achieving your commercial goals. A plain word mark provides the broadest monopoly rights but logos can provide adequate protection; the main priority is to register what you do use or intend to use. A trade mark must be used for genuine commercial purposes for the classes of trade registered, otherwise a mark that is not used, can be removed from the register by a third party as deemed invalid.

A trade mark is more than the word or logo. It has to specify the goods and/or services for which it will be used – the scope of monopoly. We help you identify how to obtain the broadest protection balanced with validity through use that is cost effective and achieves your commercial goals.

D. Costs

The costs turn heavily on what you need and what develops during the Application process, however the following provides an example of fees for a trade mark registration for one trade mark in one class.

Event	CG fee +GST	Fee type	IP Australia fee
Filing a standard trade mark application - including taking instructions from you; preparing the application including discussing and settling on the specification of goods and services for up to 3 classes; attending to and lodging Trade Mark Application with IP Australia; advising you of filing of application.	\$2,000.00	Fixed fee	\$400 per class
Examination - Monitoring for, review and considering examination reports; providing a strategy of response to an Adverse Report and to advance the application and client updates with filing timelines (when applicable).	Hourly rates	Variable	N/A
Reporting Notice of Acceptance - including receiving Notice of Acceptance, checking particulars and updating records and reporting Notice of Acceptance to you.	Included in Fixed Fee above	Fixed fee	N/A
Opposition - Monitoring for and considering Opposition actions; providing a strategy of response to overcome the objections and advance the application; client updates with filing timelines.	Hourly rates	Variable	Variable
Reporting Certificate of Registration - including Monitoring for and receiving Certificate of Registration, checking particulars and updating records and reporting Certificate of Registration to you.	Included in Fixed Fee above	Fixed fee	

E. IP Audit Review & Monthly Monitoring

Coleman Greig offers a comprehensive IP Audit Review service to assist you identify, assess and strengthen your IP Assets, ensuring they align with your business strategies. Our review can include trade marks, patents, copyrights, designs and trade secrets to uncover risks, opportunities and areas for improvement.

By evaluating your existing IP portfolio, we help you maximise its value, identify potential infringements or concerns, and ensure compliance with relevant laws and industry regulations. With our tailored IP Audit service and support, you can make informed decisions with actionable insights that strengthen your IP portfolio, protect your innovations and secure business success.

Additionally Coleman Greig offers a trade mark monitoring service for a small monthly fee to keep your IP safe and protected. We advise on new applications by third parties and/or competitors, which may impact the value of your IP portfolio.

As part of the Coleman Greig IP portfolio management services, we also report to you at the time your mark(s) may need your attention during the Registration period e.g. when your trade marks are vulnerable for a removal for non-use application by a third party or when international marks may require a declaration of use submission. This is a complimentary service we undertake on behalf of all clients we are listed as the address for service on. In the event an issue arises from that review, we will then propose applicable strategies and associated costs for consideration.

F. Additional Services

Through our international network of IP agents we can assist and advise on a wide variety of IP across multiple countries, including Madrid protocol filings, and pre-application analysis and strategies. This includes Trade Marks, Patents and Designs intellectual property.

Notice of Recent Scam Emails

Business and Intellectual Property (IP) rights owners should be aware of a new email scam circulating, where IP lawyers are being impersonated.

A number of our clients have reported to us that they have received unsolicited emails from persons purporting to be Trade Mark Attorneys from “Register your TM”, “TM Registry Filer” and/or “File Your TM”. These emails contain false information and offer urgent trade mark or patent assistance in an attempt to mislead recipients. In today’s email-heavy landscape, it is essential to remain vigilant when receiving correspondence from unfamiliar or external email addresses. If you receive an email regarding your IP that concerns you, then please send to us so we can help verify its legitimacy for you.

Contact

If you would like our assistance with your trade mark and IP portfolio, please reach out so we may discuss your individual needs further.



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Disclaimer: The information provided in the document is a general summary and is not intended to be nor should it be relied upon as a substitute for legal or other professional advice.

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