

Trade Marks for Inventions

Why?

You have just sought to protect your new and useful invention by filing an application for a patent. You therefore recognise the importance of the protection of Intellectual Property (IP).

Once your patent is granted, you may wish to commercially exploit the invention. This might be by marketing, capital raising, research and development, or business development.

A registered trade mark can be a valuable tool in this commercial process. It will identify your business as the source of the goods and/or services which are the subject of your patent and as a result distinguish them from those of other traders. This can lead to brand loyalty as the public will associate a certain quality or image with the goods and/or services bearing your trade mark, giving you a competitive edge in order to grow your business.

Brand loyalty is important as, unlike a patent, a trade mark remains valid as long as you actively use, defend and maintain it. Therefore you can continue to rely on the brand loyalty you build up during the life of your patent after its expiry.

The right IP strategy can ensure the continuing success of your invention.

How?

Selecting a good name is vital to the success of your trade mark. You should consider the long term strategy of the mark you develop. For example:

- does the trade mark translate well into other languages if you intend to seek registration of it and use it in other countries?
- will the trade mark be a master brand or a sub brand to compliment existing, or intended new, goods and/or services?
- is the trade mark you are considering available for use and registration for your goods and/or services in the countries in which you intend to use it?
- is the domain name available for the trade mark you have chosen?

A trade mark can be a word, phrase, letter, number, sound, smell, shape, logo, picture, aspect of packaging or a combination of these.

Only trade marks which are capable of distinguishing your goods and/or services from other traders are registrable. As a result, it can be difficult to register a trade mark that is descriptive or that denotes the kind, quality, intended purpose or value of the goods and/or services, or if it conflicts with an earlier mark. You should therefore choose a distinctive mark, or combine a distinctive word with a more descriptive one, and then consider instructing a professional to carry out a search to determine the availability of your trade mark.

Next

Once you have obtained registration of your trade mark, and you begin to build up consumer awareness and loyalty in it, it is important to ensure that your rights are not diminished or lost.

Your trade mark can become a generic term such as ZIPPER, LINOLEUM and ESCALATOR, and as a result, you could diminish or even lose your rights in it. To protect your trade mark:

- Distinguish your trade mark from surrounding text such as putting it in capital letters or in a different font.
- Use the trade mark in the form in which it is registered.
- Do not use your trade mark as a verb. For example “ROLLERBLADING is fun” would be use of the ROLLERBLADE trade mark as a verb, whereas “skating on ROLLERBLADE inline skates is fun”, would not be.
- The mark should be followed by a generic term (ie. the common descriptive name of the product/service). eg. “KLEENEX facial tissues”.
- Use your trade mark with the ® symbol to show that it is registered. Until your trade mark is registered, you can only use the symbol ™ to put others on notice that the name for your goods and/or services is a trade mark.

Next (cont)

Allowing other traders to use the same or a similar trade mark to yours for the same or similar goods and/or services can also result in the strength of your brand being diminished. Therefore you should watch the marketplace and also the Trade Marks Register for similar marks, and take prompt action to stop those marks from being used or from becoming registered.

Now

IP is a precious and valuable asset, and as a result it is important to develop an effective IP strategy, both in Australia and overseas. Please contact us for more information or if you wish to discuss a protection strategy for your IP.

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