

If you like it then you should have put an ® on it

Intellectual property protection is all about investing in your company's identity. It is the basis upon which you create familiarity with your consumers and distinguish yourself from your competitors.

Companies often neglect to protect their IP on the false assumption that this is a business expense on the wrong side of the balance sheet or that their IP is safe. However, you need to protect your brand like you would your first born or your favourite pet. Time and time again we are approached by businesses and individuals who have attempted to navigate IP Australia's trade mark applications via Trade Mark Headstart.

Trade mark registration is a legal process: it is a potential minefield. It is not like registering a business name (which offers you no brand protection). Common problems with DIY registrations and Trade Mark Headstart include:

1. Trade mark applications being allowed to lapse because no (or insufficient) legal submissions are lodged to overcome objections raised.
2. Owners receiving incorrect "advice" from IP Australia about registrability.
3. Trade marks being registered incorrectly (either in format or class) – which causes problems down the track.

Insufficient protection has given birth to a much bigger problem. The latent discovery of substantially similar trade marks can be very costly and whilst there are legal avenues to challenge these problems, the average business does not have the resources for a big court battle.

Dismissing the importance of correct trade mark registration leaves the door wide open for other businesses to capitalise on your success and reputation by adapting substantially similar branding. Whilst trade mark protection does not guarantee that your brand will not be infringed it certainly puts a very big and scary guard dog at your door. We don't all have Madonna's ability or budget for constant image transformation: you need to properly protect your investment from the start.

The 2005 Federal Court decision in *Shahin Enterprises Pty Ltd v ExxonMobil Oil Corporation* highlights the importance of early trade mark filing when preparing the roll-out of a new brand to ensure that ownership rights remain secure. In this case Shahin decided to operate a number of its business activities under the brand ON THE RUN. Shahin registered business names and undertook a substantial amount of work including shop fit-outs, advertising materials and signage so as to brand various outlets with "On the Run". In June 1999, Exxonmobil filed an application to register the Australian trade mark ON THE RUN in classes 4 (petrol and oils), 25 (clothing), and 32 (beer and non alcoholic drinks). Shahin opposed Exxonmobil's application for registration of that trade mark but had no evidence that goods sold in the convenience stores were sold under or by reference to the "On the Run" brand.

"Not all businesses have a Disney sized legal budget but every trade mark holder's rights are the same".

The Federal Court found for Exxonmobil and dismissed Shahin's opposition. This result was based on the principle that a trade mark must be physically used in relation to goods or services so as to distinguish those goods or services from the goods or services provided by others. Merely conducting a business under a name does not necessarily constitute use of a trade mark in relation to the particular goods or services sold by the business.

This decision was extremely costly for Shahin and it could have been avoided with correct legal advice during the start up stages of the business.

In 2009, US retailer Abercrombie & Fitch (A&F) filed suit against Beyonce Knowles stating that her planned signature fragrance entitled "Sasha Fierce" infringed on the clothing giant's registered trade mark "Fierce".

The retailer stated that Beyonce intended to market a "Sasha Fierce" perfume (evidenced by her sworn trade mark application), arguing that the product would violate its existing trade mark and confuse customers, who may believe the fragrance is associated with A&F. A cease and desist letter was sent by A&F's solicitors in addition to the filed court action. This dispute was resolved without further court intervention and A&F successfully protected its trade mark's rights. Beyonce did not go ahead with the perfume brand saving excessive marketing and legal costs in pursuing the "Sasha Fierce" brand.

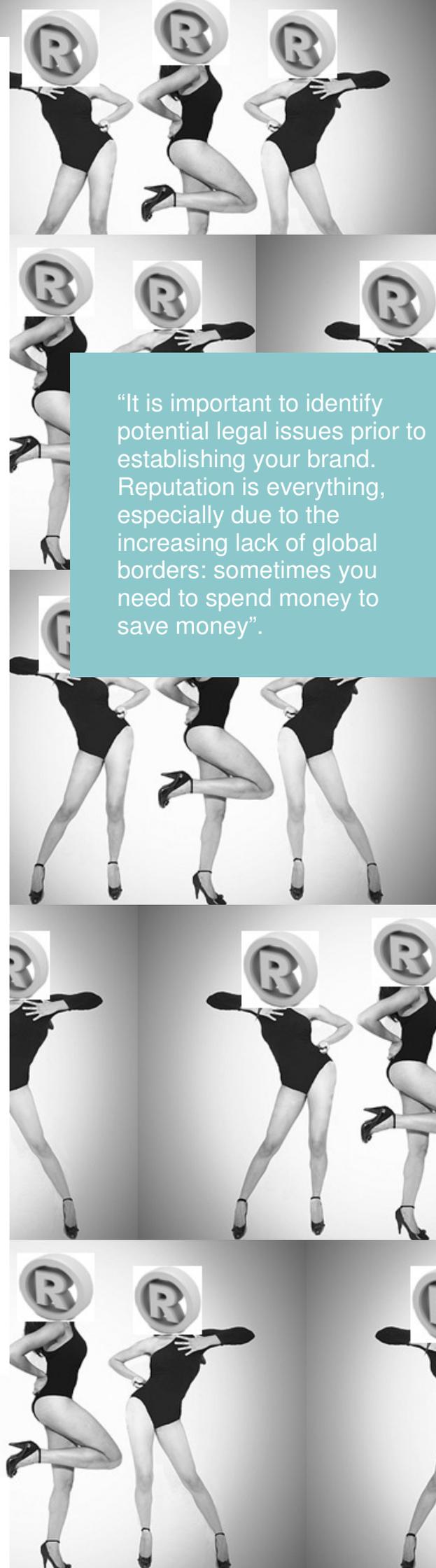
Accordingly, it is important to identify potential legal issues prior to establishing your brand. Reputation is everything, especially more so due to the increasing lack of global borders. When it comes to brand protection, you need to spend money to save money in the long run. Obtain legal advice to determine:

- The registrability of your trade mark.
- Any current or potential future conflicts with competitors.
- How to keep your trade mark registered.
- Strategies to challenge trade mark applications for those marks that are substantially identical or deceptively similar to your registered trade mark.
- How to use and exploit your trade marks once registered.



IP protection is an investment into the value and goodwill of your company. Utilising the experience of a trade mark lawyer will ensure you do not get caught out on avoidable mistakes and allow you to tip the scales in the right direction. Your business goals should be to convert IP from a depreciable asset into a growing one.

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