



## Procedure Outline

1. A search as to availability of **YOUR TRADEMARK/LOGO**. If the wording you use is merely descriptive or not distinctive (as is often the case), registration is less likely to be granted without apt and adequate distinguishing artwork;
2. A decision on how many classes of protection are claimed. There are 44 different categories of goods and services. So I would normally need a good outline as to the nature of your operations before I make a recommendation to you for consideration as to which class or classes in which you might register.
3. An application for a registered trademark, if it already includes artwork/logo is much less problematic, as a distinctive logo is easier. Simple words, particularly words commonly used in the English language, can fail as not being distinctive.
4. Artwork has to be in a particular IP Australia approved file format as to size and the like.
5. After application **IP Australia** looks at the application and, if it thinks fit, issues requisitions relating to any problems it sees. As a guide, you should assume that actual **IP Australia** lodgment and registration fees work upon the basis of \$450 per Mark per class when using the online lodgment Headstart system.
6. Satisfaction of any requisitions raised by IP Australia;
7. If IP Australia is otherwise satisfied, it will allow an application to proceed into the process. Thereafter it would be advertised and any member of the public (including your market competitors) would be able to lodge an opposition to registration. Though Opposition is common on less than 5% of applications;
8. If any opposition is lodged, it would be referred to you for response.
9. If not, the application should proceed to registration.
10. Trademark registration is unfortunately rather slow. Even a vanilla application, with no problems will take a minimum of 8 to 10 months but you can, of course, usually use "**YOUR TRADEMARK/LOGO**" before then.

## Unusual or In a Hurry

Commonly, where there is any doubt or anything unusual, to minimize costs, save time and maximize certainty, I lodge what is called a "**Headstart**" application with an initial fee to **IP Australia** per Mark per class.

Under this process, and application is lodged and **IP Australia** will come back within a week with any concerns it has in respect of the application as initially lodged. If it has any problems with the application, it will mention them and one has a few days within which one can to remedy the concerns raised by IP Australia.

Examples I can give you of issues raised by IP Australia in connection with the **Headstart** applications include requiring the consent of some existing registered trademark owner and wanting artwork to make the application distinctive, for example, where a client insisted on an application using common words only, the application was rejected by IP Australia and the client was required to add artwork [which carried an additional artwork lodgment fee], before the application was submitted to the second stage of the application process by payment of the balance of the **Headstart** application fee.

Even when IP Australia admits an application to the process by way of **Headstart** application, IP Australia reserves the right to reject the application on any ground, though I have rarely had any later change of view adverse to a client application by IP Australia.

Notwithstanding this, **Headstart** is a useful mechanism for flushing out any initial concerns IP Australia is likely to make in respect of an application.

An application can also be made for a slightly lower IP Australia lodgment fee without a Headstart Application, but one then waits months for even a clue of IP Australia's view of the application.

Successful trademark registration provides protection to the extent that the relevant goods/services are used consistently with the class claim in respect of which the application is made and registered.

If the mark is registered but not used in respect of the relevant goods or services there is potential for the mark to be struck down by other parties later on.

I can send fee schedule dealing with both IP Australia Fees and my fees, on request.

Please feel free to call for a quick chat.

If you have any queries or wish to discuss any of the above, please contact me through the website or by email [ross@eakin.com.au](mailto:ross@eakin.com.au) or call me 02 9265 3070.

20.05.21

The image contains a handwritten signature in blue ink that reads "Gregory Ross". To the right of the signature is a circular logo. The logo features a stylized "S" in the center, with the text "GOVERNMENT AND ADMINISTRATIVE LAW" around the top and "ACCREDITED SPECIALIST" around the bottom.

**Greg Ross**