

What is a trade mark?

A trade mark is a 'sign' that identifies and distinguishes the goods and services of one trader from those of another. A trade mark acts as a shortcut to allow consumers to efficiently identify the nature, quality and origination of a product or service. In this way trade marks are valuable assets that can act as a 'badge of origin', and that can help build profile, develop reputation, and achieve commercialisation objectives. Some of the most familiar trade marks are Apple®, Microsoft® and Google®. In the context of agriculture, farming and food recognisable trade marks include Roundup Ready®, Plumpy'nut® and FairTrade®.

What can be registered as a trade mark?

A trade mark can be made up of words, symbols, letters, numbers, slogans, drawings and symbols. A trade mark can also include the packaging and shape of a product, and in many countries trade marks are available for sounds, colours and smells. MGM, for example, have a registered trade mark for their mascot lion's roar in the United States, and Goodyear Dunlop have a registered trade mark for a 'floral fragrance/smell reminiscent of roses as applied to tyres' in the United Kingdom.

While there are differences in the precise requirements for trade mark registration from country to country there are some common criteria. Perhaps most importantly a trade mark needs to be distinctive. The distinctiveness requirement goes to the heart of trade mark protection and ensures that consumers can distinguish the goods or services of one trader from another, and means that generic, descriptive or geographical names are generally excluded from trade mark protection.

In addition to being distinctive, a trade mark must satisfy a number of other requirements and a trade mark application may be refused or opposed on various grounds including:

- the mark is not capable of 'graphical representation' in that it is not clear and capable of reproduction;
- the applicant does not intend to use the trade mark;

- the mark is confusingly similar or identical to an existing trade mark;
- the mark violates public order, community standards or is contrary to the law.

Is there an international trade mark?

Generally speaking you need to apply for a trade mark in the country in which you want protection. In order to avoid the need to register separately with each national or regional office, however, the Madrid System for the International Registration of Marks - which is administered by the World Intellectual Property Organization (WIPO) - allows applicants to submit one application with WIPO, who then forward the application to different national offices for consideration. There are also regional application processes such as those administered by the European Community Trademark (EUTM) and African Intellectual Property Organization (OAPI).

Classes of goods and services

Trade marks do not apply to all goods and services. When you register your mark you need to nominate the class, or classes, of goods and services in which you will use your trade mark. The Nice Classification system is used in approximately 150 trade mark offices around the world to standardise the classification of goods and services for the purposes of the registration of marks. The Nice Classification system sets out 34 broad classes for goods and 11 broad classes for services.

Duration of protection

Registered trade marks are generally protected for an initial period of ten (10) years, which can be renewed indefinitely.

Collective, certification and well-known Marks

In addition to standard trade marks there are several other categories of marks. These include:

- **Collective marks** may be granted to an association or collective group, and used by members of that group to distinguish their good or services based on their association with that group;
- **Certification marks** may be granted to anyone who can certify that the products involved meet established standards related to quality, origin or some other characteristic;
- **Well-known marks** are marks that have a high degree of consumer recognition. Significantly, well-known marks do not need to be registered in a particular class of goods or services to get protection in that class.

Infringement and defences

Trade mark infringement occurs when a person uses, without permission, a mark that is substantially identical with or deceptively similar to an existing trade mark.

There are very few defences to trade mark infringement; instead a number of acts may be deemed not to constitute infringement including uses in good faith and comparative advertising.

The TM and ® symbols, and passing off?

Trade mark owners regularly signal their mark with the symbols TM or ®. While it is not compulsory to use these symbols there are some important points worth noting:

- using TM or ® you let consumers and other traders know that the owner is asserting trade mark rights;
- you need to have a registered trade mark to attach the ® symbol to goods or services. Unauthorised use of the ® (that is, on marks that are not registered) is an offence;
- you do not need to have a registered trade mark to attach the TM symbol to your goods or services. The TM symbol is most often used in situations where there is a non-registrable right, similar to trade mark, such as passing off. Passing off may be relevant if a person or company misrepresents an association with another person's business, and is actionable without a registered trade mark. Often, a passing off action is brought in conjunction with a trade mark dispute (if there is a registered trade mark) or instead of trade mark dispute (if there is not a registered trade mark).

This fact sheet was produced as part of a collaboration between the CGIAR Consortium and the Australian Centre for Intellectual Property in Agriculture (ACIPA) to research international intellectual property issues relating to agriculture.

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