

Workshop- Session 1

12:35 – Leigh Whicker Room



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Brand Protection in the Tourism Sector



#2019TiCSA

2019 SA Tourism Conference



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Expert advice,
human approach.

Brand Protection – Tourism Sector

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What we will cover today:

1. Protection of your brand
2. What is a trade mark?
3. Why register a trade mark and what does a trade mark protect?
4. Do your homework
5. Trade mark application process
6. Tips and tricks for trade mark registrations
7. Domains and Social
8. Q&A

But first...

Whilst we are lawyers, this is **NOT** legal advice.

This workshop, and all materials provided are general information only. I have not considered your individual circumstances.

But first...

Do not rely on this lecture or any of the materials as legal advice.

If you have a legal issue, **please contact a lawyer.**

Protection of your brand

- Protection of branding is becoming *increasingly important* in the tourism industry.

You don't want to find yourself in a situation
where:

- you have just started a distillery or micro- brewery or perhaps a wedding function and accommodation business;

or alternatively

- you have been operating a restaurant or hotel for years ...

only to discover....

Protection of your brand

- That ***another*** business has registered a trade mark for the same or similar branding to your own for the same or similar goods and/or services you provide.
- The **risk** of not protecting your business and related branding through trade mark registration, as early as possible, is that others may copy your idea and proceed to obtain legal protection.

Protection of your brand

- They can then reap the benefit of the goodwill you have built up.
- You might then find yourself in a similar situation to **Taco Bell**

Protection of your brand

- **Taco Bell** (Aust Co), a Mexican restaurant (apparently the first in Sydney) had been trading in Sydney since 1970 and registered the business names of 'Taco Bell' and 'Taco Casa' in 1974, only to have the Taco Bell (US) enter the market in 1981 and register their brand for protection prior to Taco Bell (Aust Co).
- Taco Bell (Aust Co), was then involved in 4 years of legal proceedings.
- If Taco Bell (Aust Co) was successful in the Federal Court, however if it had obtained trade mark protection for its branding in the early stages of its business it could have exercised its exclusive intellectual property (IP) rights to prevent Taco Bell (US) operating anywhere in Australia.

What is a trade mark?

A **trade mark** is a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other

Trade Marks Act 1995 (Cth) – s17

Why register a trade mark and what does a trade mark protect?

- The purpose of registering a trade mark is to **protect your business' brand** in the marketplace.
- Registering a trade mark in Australia helps you **protect your brand nation-wide**.
- It also offers you **exclusive enforceable legal rights** and can be a powerful tool in identifying and promoting the goods and services offered by your business.
- As your business grows, ensuring you have IP rights relating to your business (e.g. legal rights in relation to your branding) becomes more important as **the value of your business will increasingly align with the growth in profile of your business in the marketplace**.

Why register a trade mark and what does a trade mark protect?

1. To act as a **badge of origin**
2. To allow consumers to **identify products** and know their **quality**
3. To **protect traders' goodwill/reputation**
4. To **enshrine value in brands.**

Campomar Sociedad, Limitada v Nike International Ltd (2000) 202 CLR 45.

Do your homework!!!

- **If you are just starting a business**, choosing a name and brand is one of the most important decisions you will make. Ideally you want a brand that distinguishes your business from competitors and is neither too descriptive nor too similar to another brand.
- **If you are an established business**, and your name and brand is already in existence and known in the marketplace there are other matters that need to be considered when making the decision to protect your brand.

Do your homework!!!

- In either situation, obtaining advice on factors to take into account when deciding on your branding and its protection is crucial.
- This includes conducting searches of existing trade marks to give you some clarity and options around whether the chosen brand is/is not already taken or protected.

Do your homework!!!

- The **risk of not doing your homework** in the early stages of operating your business to see what branding is protected in your industry, is that:
- you could end up infringing another business's IP rights. This could also lead to wasted expense on design and marketing that may never be used as a result, as well as the added expense of rebranding once these obstacles are identified.
- Obtaining legal advice in relation to protecting your brand can ensure that any obstacles are **identified**, **addressed** and **strategies** to protect your businesses IP can be established.

Before I explain the trade mark process...

You need to know that
registration of a business name
DOES NOT
provide an exclusive legal right to use that name.

Registration of a business name with ASIC:

- is a **statutory requirement** that provides a transparent link to the name under which a business operates; and
- is **not a defence** to a claim of trade mark infringement.

Trade mark application process

- Once you have made the decision to protect your branding by applying to register a trade mark, the next step is to decide on the **type of mark to apply for**.
- Business names and logos are registered as separate trade marks.
- Applying to register a business name or brand name as a trade mark is called a **'word mark'**. A word mark protects the words and gives the registered owner exclusive rights to use the words regarding its business and similar businesses.

QANTAS



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Trade mark application process

- Applying to register an image or graphic only or a combination of a graphic and at least one word is called an **'image mark'**.
- An image mark protects the overall impression of the image including the shape, font and style however any words contained in that image mark do not receive individual protection.



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Trade mark application process

Some things to remember.....

- Word marks can be more difficult to register than image marks due to conflicts with currently registered marks or because IP Australia considers the words are not inherently distinctive.
- Image marks can be easier to register as there are many ways to present a mark to make it distinctive; however this can provide less protection for the brand name itself as the words are not specifically protected.

Trade mark application process

- Once you have decided on the trade mark/s you want to apply for, we recommend lodging a '**TM Headstart Request**' with IP Australia. This service allows potential applicants to understand what issues may arise before committing to a formal application, without there being any record on the register of trade marks.
- IP Australia responds with a report **within 5 business days** of the request being lodged. Once that report is received you have 5 business days to convert the request into a formal application for registration. If you do not convert the request it then lapses and no further action is necessary.

Trade mark application process

Formal application

- If you proceed to a formal application, the minimum time from application to completed registration is **7.5 months** as a result of IP Australia's international obligations.
- Protection of the **priority** of your mark commences from the date that your request is converted to a formal application. That priority is only lost if the application is rejected or lapses.

Trade mark application process

- There are **many stages during the process** when you can decide not to proceed (such as responding to objections from IP Australia Examiners or other mark holders or third parties).
- If IP Australia accepts the trade mark application and passes examination, it will then issue a Notice of Acceptance.
- Your trade mark is then **advertised** in the Australian Official Journal of Trade Marks to give the public the chance to oppose registration during the **2 months** from the date of advertisement.

Trade mark application process

- If there is no opposition to your trade mark, and registration fees are paid, you then receive your **Certificate of Registration**.
- Registration of your trade mark is for **10 years**.
- If someone **infringes your registered trade mark** you can institute legal proceedings against them for a trade mark infringement claim.

Possible consequences of a trade mark infringement claim

- Injunction
- Profits or damages
- Costs (this can include up to 60-70% of legal costs)
- Infringer having to select a new name, branding, logo etc. and the associated costs (marketing, design, reputation) of starting to build a reputation again

Choosing your trade mark

Kodak XEROX

**Brown and sons
wine makers**

Stylish clothing



Made up words

**Descriptive/
laudatory words**

But I love my generic name!

- Add elements (reduce protection)

just *Delicious*

classic | stylish | divine

- Acquire distinctiveness

How to acquire distinctiveness

reputation



How to acquire distinctiveness

- Social engagement
- Press and media coverage
- Letterhead and stationery
- Industry publications
- Marketing spend
- Radio/TV/Print adverts
- Experts in the field

Use it or lose it!

- Use in trade or commerce
- In Australia
- In relation to the relevant class

How class-y do you want to get?



Geographical limitations



A matter of convention



Paris Convention

Day 1

Day 180

Application in Country 1

Application in Country 2

Same date of protection (Day 1)

Master of your domain

- Registrar requirements
- Domain squatters
- Bad faith registrations

A/UDRP

- Fast
- (Relatively) cheap
- Requires:
 - Bad Faith
 - Trade mark rights
 - Misuse of mark

When domains and trade marks collide

- Can a domain be a trade mark?



Imposters on Social



Licensing agreements and franchises

- Who controls the brand?
- Who registers the brand?
- Usage rights
- Ability to enforce
- Non-Use

What if you don't have a TM?

- Copyright in logos
- Unregistered rights
- Australian Consumer Law

Questions?

- @Wallmans_lawyers
- @paulgordon
- Wallmans.com.au

