



**Rostron Carlyle**  
S O L I C I T O R S

THIS DRAWING, INCLUDING ANY PATENTED OR PATENTABLE  
FEATURES, EMBODIES **CONFIDENTIAL** INFORMATION  
AND ITS USE IS CONDITIONED UPON THE USER'S  
AGREEMENT NOT TO REPRODUCE THE DRAWING IN WHOLE  
OR IN PART. NOR THE MATERIAL DESCRIBED THEREON NOR  
TO USE THE DRAWING FOR ANY PURPOSE OTHER THAN  
SPECIFICALLY PERMITTED IN WRITING.

Intellectual property

## What is a registered trade mark and what rights does it protect?

Section 17 of the *Trade Marks Act 1995* (Cth) (**Act**) provides that “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 person”.

The term sign as defined by section 6 of the Act ‘includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent’. Therefore trademarks can include logos, slogans, brand names, or any combination of the above elements.

Not all trade marks can be registered. A trade mark will not be registered by IP Australia if it is not capable of distinguishing goods or services from the same or similar goods or services in the market. In other words a trade mark that is deceptively similar to an existing one in the same category will not be registered.

Section 10 of the Act provides that a trade mark is taken to be deceptively similar to another trade mark if it so nearly resembles the other trade mark that it is likely to deceive or cause confusion’. In the recent case of *Coco-Cola Company v Shea* [2009] ATMO 49 (**Coke**) opposed an application for registration for trade mark protection of the “Naughty Mother” phrase in class 32 (non-alcoholic drinks). It was claimed by Coke that this was deceptively similar to its 3 existing registered Mothers, pursuant to section 44 of the Act and also section 52 of *the Trade Practices Act 1974* (Cth). The Hearing Officer upheld Coke's application on the following grounds:

**Mother was the main feature** – the word Mother was dominant in both marks and that a customer seeking a Coke branded Mother would be likely to ask for a Mother. The word Mother as it applied to drinks was highly distinctive;

**Contradictory terms** – The Hearing Officer accepted Coke's argument that Naughty Mother may be seen by consumers as a newer more exciting version of the existing brand that was associated with sweet feminine connotations.

### Registration specification

Applicants for a trade mark must nominate the class number(s) that is appropriate to the goods and services in each group and multi-class applications are allowed. Classes are uniform internationally. Schedule 1, Part 1 of the *Trade Marks Regulations 1995* (Cth) describes the 34 categories for goods and Part 2 describes 11 categories for services and their breakdown.

### What does registration protect?

The registered owner of the trade mark obtains exclusive rights to use the trade mark in relation to the goods and services with respect to which it is registered. This explains why for example the capitalised letters "PKF" could be used by PKF Accountants and PKF Flooring Supplies.

Section 120 of the Act provides that "*a person infringes a registered trade mark if the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered*".

### What remedies are available for trade mark infringement?

A Court may grant an injunction to restrain the use of a deceptively similar trade mark and either damages or account of profits at the plaintiff's option as provided by section 126 of the Act.

### What are the advantages of registering a trade mark rather than relying on a common law trade mark?

In the case of a common law trade mark, an applicant needs to prove the existence of the trade mark by reference to its reputation in the marketplace. This requirement is not necessary for a registered trade mark. Therefore a common law trademark is more difficult and costly to enforce and provides less certainty in relation to enforcement.

## Malcolm Burrows

Associate

---

"The information contained in this article is general in nature and cannot be regarded as anything more than general comment. Readers of this article should not act on the basis of this comment without consulting one of Rostron Carlyle's legal practitioners who will consider their particular circumstances."

---

### Other legal services

Established in 2001, Rostron Carlyle is a full service Commercial law firm with the following specialist Practice Groups:

- Criminal law
- Family law
- Personal injuries
- Commercial law
- Litigation & dispute resolution
- Property law



**Rostron Carlyle**  
SOLICITORS

Telephone (07) 3009 8444 Fax (07) 3009 8499

e: [mail@rostroncarlyle.com](mailto:mail@rostroncarlyle.com) website : <http://www.rostroncarlyle.com>