

The Acceptable Types of Marks and Means of Representation

Country: AUSTRALIA

Definition of Trademark

* 1. According to the applicable legislation or to the practices of the Office, marks are defined as

- a) Visually perceptible signs Yes **No**
- b) Signs capable of being represented graphically Yes **No**
- c) Any sign capable of distinguishing the goods and services of one undertaking from those of another **Yes** No

* 2. Signs excluded from registration

Are any signs excluded from registration as a mark? Yes **No**

Section 18 of the *Trade Marks Act 1995* states that regulations may provide that a sign specified in the regulations is not to be used as a trade mark or part of a trade mark. Regulation 4.15 and Schedule 2 of the *Trade Marks Regulations 1995* list signs that cannot be registered.

Acceptable Types of Marks and Means of Representation

* Types of marks

3. Is the applicant required to specify in the application the type of mark for which registration is requested? Yes **No**

* 4. Is a description of the mark [one option only]

- a) Mandatory?
- b) Optional?
- c) Not allowed?

None of the options provided reflect the situation in Australia. For some types of non-traditional marks, a description is mandatory but for other types marks a description is not required. Therefore a description is neither mandatory, optional or not allowed.

* 5. When an indication of the type of mark is neither specified nor included in the description,

would the Office accept and process the application? **Yes** No

One option only:

- a) Without an indication of the type of mark?
- b) With an ex-officio indication of the type of mark?
- c) Other

* 6. Please, indicate below the types of marks accepted by the Office and, where applicable, the way in which they must be represented:

- a) Word marks Yes No
 - i. Does the Office require the use of a standard character for the representation of word marks? Yes No
 - ii. Where applicable, does the Office require that words be translated into the language used by the Office Yes No
 - iii. Where applicable, does the Office require that words be transliterated following the phonetics of the language used by the Office Yes No

For clarity, regulation 4.3(5) of the *Trade Mark Regulations 1995* provides IP Australia with the discretion to request an applicant provide a translation when deemed necessary. In contrast, regulation 4.3(6) *requires* that a transliteration and translation must be provided when a mark contains characters that are not Roman letters.

*

- b) Figurative marks (device marks) Yes No

* Please, specify how they must be represented:

Your answer

Regulation 4.2(1)(b) requires that representations for all marks, including figurative marks must include a representation that is sufficient to identify the trade mark and shows all the features of the trade mark clearly to permit proper examination.

Regulation 4.3(1) states that the size of the representation of the trade mark should, where practicable, be no larger than 8cm x 8cm.

Regulation 4.3(10) requires that representations be of a kind and quality that ensures all the features of the trade mark will be preserved over time, and be suitable for reproduction

*

c) Hologram marks **Yes** No

* Please, specify how they must be represented:

Your answer

As in our earlier response for figurative marks, the requirements of regulations 4.2(1)(b), 4.3(1) and 4.3(10) apply to hologram marks.

In addition, if IP Australia reasonably believes that representation provided for a hologram mark does not demonstrate the nature of the trade mark sufficiently or show or the features of the trade mark sufficiently to permit proper examination, then under Regulation 4.3(8) IP Australia can request the applicant to provide:

- A description, or further description, of the trade mark; and
- A specimen of the trade mark

Therefore hologram marks should be accompanied by a description of the mark which clearly describes each view formed by the hologram when it is moved about. It should describe what the trade mark consists of in positive terms. Representations of each view should also be provided. A copy of the actual trade mark, as a video clip for example, should be provided.

*

d) Three-dimensional marks (shape marks) **Yes** No

* Please, specify how they must be represented

Your answer

As in our earlier response for figurative marks, the requirements of regulations 4.2(1)(b), 4.3(1) and 4.3(10) apply to three-dimensional marks.

In addition regulation 4.3(3) states that if the trade mark consists of three-dimensional shape:

- (a) if practicable, the representation of the trade mark in the application must be illustrated in a perspective that shows each feature of the trade mark; and
- (b) otherwise, the representation of the trade mark in the application must include views of the trade mark that are necessary to show each feature of the trade mark.

Office practice is to prefer isometric drawings. The parts of the configuration claimed to constitute the trade mark should be shown in solid lines, while the unclaimed parts, if any, should be shown in broken lines.

Regulation 4.3(7) requires a concise and accurate description of the trade mark when it contains or consists of a shape. Therefore the drawings, views and/or photographs of a shape trade mark must also be accompanied by a written description of the trade mark.

The description and pictorial representation of a shape trade mark should together clearly define all the details which constitute the trade mark. If they do not, regulation 4.3(8), as discussed in our answer for hologram marks allows IP Australia to seek a further description of the mark and a specimen of the mark.

i. Product packaging **Yes** No

Please, specify how it must be represented:

Your answer

As in our earlier response for figurative marks, the requirements of regulations 4.2(1)(b), 4.3(1) and 4.3(10) apply to product packaging.

Additionally regulation 4.3(7) requires a concise and accurate description of the trade mark when it contains or consists of a product packaging/aspect of packaging.

Depending on the nature of the packaging, the requirements of regulation 4.3(3), discussed in our response for three dimensional marks may also apply. The requirements for colour marks discussed below may also apply.

The representations should clearly show all features of the mark and in combination with a written description clearly define all the details which constitute the trade mark. If they do not, regulation 4.3(8), as discussed in our answer for hologram marks allows IP Australia to seek a further description of the mark and a specimen of the mark.

ii. Product shape **Yes** No

Please, specify how it must be represented:

Your answer

As in our earlier response for figurative marks, the requirements of regulations 4.2(1)(b), 4.3(1) and 4.3(10) apply to product shapes.

Additionally the requirements for three-dimensional (shape) marks discussed above apply to product shapes.

*

e) Color marks **Yes** No

* Please, specify how they must be represented

Your answer

As in our earlier response for figurative marks, the requirements of regulations 4.2(1)(b), 4.3(1) and 4.3(10) apply to colour marks.

In addition regulation 4.3(7) requires a concise and accurate description of the trade mark when it contains or consists of a sign that is a colour.

A pictorial representation showing the colour claimed and the manner in which it is to be applied to the goods or packaging should also be supplied. The description and the pictorial representation of the colour trade mark should together clearly define all the details which constitute the trade mark. If they do not, regulation 4.3(8), as discussed in our answer for hologram marks allows IP Australia to seek a further description of the mark and a specimen of the mark.

Ideally an example of the actual colour or colour combination claimed should be supplied. Applicants can choose to define the colour/s more precisely by the use of a recognised colour matching system, this reference may be included in the descriptive endorsement. Increasingly IP Australia prefers colour identification systems as these can provide more long lasting clarity as to the colours claimed for protection.

i. A single color **Yes** No

Please, specify how it must be represented:

Your answer

As in our earlier response for figurative marks, the requirements of regulations 4.2(1)(b), 4.3(1) and 4.3(10) apply to single colour marks.

Additionally, the requirements for colour marks which are discussed in the previous answer, apply to single colour marks.

ii. A combination of colors **Yes** No

Please, specify how it must be represented:

Your answer

As in our earlier response for figurative marks, the requirements of regulations 4.2(1)(b), 4.3(1) and 4.3(10) apply to marks with a combination of colours.

The requirements for colour marks which are discussed above apply to a combination of colours.

*

f) Sound marks **Yes** No

* Please, specify how they must be represented

Your answer

As in our earlier response for figurative marks, the requirements of regulations 4.2(1)(b), 4.3(1) and 4.3(10) apply to sound marks.

In addition, regulation 4.3(7) requires a concise and accurate description of the trade mark when it contains or consists of a sound. This description will be entered as an endorsement to the application and in some cases may serve as the graphical representation.

The description may be a simple verbal description of the sounds such as "CLIP CLOP MOO". Musical notation is acceptable as a graphical representation of a sound mark consisting of a musical piece

In most cases the applicant should file a copy of the actual sound being claimed as the trade mark. This copy should be provided on a medium which allows for easy copying, storage and replaying of the sound.

The description and the recorded representation of the trade mark should together clearly define all the details which constitute the trade mark. If they do not, regulation 4.3(8), as discussed in our answer for hologram marks allows IP Australia to seek a further description of the mark and a specimen of the mark.

i. A musical sound ☒ Yes ☐ No

Please, specify how it must be represented:

Your answer

The requirements for a musical sound mark are the same as for a sound mark, detailed in the previous answer.

ii. Any sound ☒ Yes ☐ No

Please, specify how it must be represented:

Your answer

The requirements for sound marks discussed in the previous answers apply.

*

g) Motion marks ☒ Yes ☐ No

* Please, specify how they must be represented:

Your answer

As in our earlier response for figurative marks, the requirements of regulations 4.2(1)(b), 4.3(1) and 4.3(10) apply to motion marks.

In addition, if IP Australia reasonably believes that representation provided for a motion mark does not demonstrate the nature of the trade mark sufficiently or show or the features of the trade mark sufficiently to permit proper examination, then under Regulation 4.3(8) IP Australia can request the applicant to provide:

- A description, or further description, of the trade mark; and
- A specimen of the trade mark

Therefore, applications for motion marks should provide clear representations which show all the features of the trade mark. The application should also be accompanied by a description of the trade mark which likewise clearly describes all the features of the trade mark. A copy of the actual trade mark, as a video clip for example, should also be provided.

The description for a motion trade mark should be precise It should describe exactly what the trade mark consists of in positive terms. The wording of the description should refer precisely to the trade mark which is being claimed – there should be no ambiguity.

*

h) Multimedia marks (motion and sound) **Yes** No

* Please, specify how they must be represented:

Your answer

As in our earlier response for figurative marks, the requirements of regulations 4.2(1)(b), 4.3(1) and 4.3(10) apply to multimedia marks.

Additionally, if a multimedia mark contains sound, then regulation 4.3(7) applies and it must be accompanied by a concise and accurate description of the trade mark.

Similar to motion marks, if IP Australia reasonably believes that representation provided for a multimedia mark does not demonstrate the nature of the trade mark sufficiently or show or the features of the trade mark sufficiently to permit proper examination, then under Regulation 4.3(8) IP Australia can request the applicant to provide:

- A description, or further description, of the trade mark; and
- A specimen of the trade mark

Therefore, a copy of the actual trade mark, as a video clip for example, should be provided. The description for a multimedia trade mark should be precise It should describe exactly what the trade mark consists of in positive terms. The wording of the

description should refer precisely to the trade mark which is being claimed – there should be no ambiguity.

*

i) Other(s) (e.g., gesture marks, olfactory marks, pattern marks, position marks, taste marks, texture marks, trade-dress) **Yes** No

* Please, indicate what other types of marks are accepted:

Your answer

The definition of a trade mark in Australia is non-exhaustive. Any sign that is perceptible by the senses is potentially registrable provided it meets conditions and is capable of distinguishing.

* Please, specify how each of the other types of marks indicated above must be represented:

Your answer

The representation must be in a form that conveys information to the ordinary person allowing to them to identify the trade mark. Highly technical data will not be acceptable as a graphical representation. For example, the results of analytical techniques such as infrared spectroscopy; vacuum, fractional and molecular distillation; nuclear magnetic resonance; vacuum fractionation; "electronic nose" analysis and chromatographic techniques would not be acceptable.

These marks must be accompanied by a precise and accurate description of the mark services.

Format and Means to File an Application with the Office

* 7. Which of the following are acceptable formats to file an application with the Office?

- | | | |
|--|------------|-----------|
| a) A paper form | Yes | No |
| b) The image of a paper form (e.g., PDF, JPG) | Yes | No |
| c) Structured data (e.g., e-filing, XML files) | Yes | No |

In exceptional circumstances paper filings might be accepted, over 99% of applications are received electronically via e-filing which is the strong preference of the office.

* 8. How does the applicant submit the application?

- | | | |
|--|-----|-----------|
| a) On a physical support (e.g., paper, CD-ROM or USB device) | Yes | No |
| b) By fax | Yes | No |

c) Electronically, other than fax (e.g., by e-mail, by e-filing) ☒ Yes ☐ No

Like question 7, in exceptional circumstances paper filings might be accepted, over 99% of applications are received electronically via e-filing which is the strong preference of the office.

* 9. Is the applicant either required or allowed to

submit an electronic representation of the mark along with the application? ☒ Yes ☐ No

Applicants can submit electronic representation of the mark along with application but are not required to.

Format(s) in which the Office accepts the electronic representation of the mark

* 10. Depending on the type of mark, may the electronic representation consist of one or more digital still images? ☒ Yes ☐ No

* Please select below the format accepted by the Office

a) GIF	<input checked="" type="checkbox"/> Yes	<input type="checkbox"/> No
b) JPEG	<input checked="" type="checkbox"/> Yes	<input type="checkbox"/> No
c) PNG	<input checked="" type="checkbox"/> Yes	<input type="checkbox"/> No
d) TIFF	<input checked="" type="checkbox"/> Yes	<input type="checkbox"/> No
e) Other(s)	<input checked="" type="checkbox"/> Yes	<input type="checkbox"/> No

* Please, specify in which other format(s):

Your answer

PDF, TXT, DOC, XML

* When the representation consists of more than one digital still image:

a) all images must be included in one file	<input checked="" type="checkbox"/> Yes	<input type="checkbox"/> No
b) each image may be in a separate file	<input checked="" type="checkbox"/> Yes	<input type="checkbox"/> No

* 11. Depending on the type of mark, may the electronic representation consist of a digital recording of sound only (i.e., without moving images)? ☒ Yes ☐ No

* Please, select below the format accepted by the Office

a) MID	<input checked="" type="checkbox"/> Yes	<input type="checkbox"/> No
b) MP3	<input checked="" type="checkbox"/> Yes	<input type="checkbox"/> No
c) WAV	<input checked="" type="checkbox"/> Yes	<input type="checkbox"/> No
d) Other(s)	<input checked="" type="checkbox"/> Yes	<input type="checkbox"/> No

* 12. Depending on the type of mark, may the representation consist of a digital recording of moving images without sound? ☒ Yes ☐ No

* Please, select below the format(s) accepted by the Office

- | | | |
|-------------|-----|----|
| a) AVI | Yes | No |
| b) GIF | Yes | No |
| c) MOV | Yes | No |
| d) MP4 | Yes | No |
| e) MPEG | Yes | No |
| f) WMV | Yes | No |
| g) Other(s) | Yes | No |

* 13. Depending on the type of mark, may the representation consist of a digital recording of moving images and sound? **Yes** No

* Please, select below the format(s) used by the Office

- | | | |
|-------------|-----|----|
| a) AVI | Yes | No |
| b) MP4 | Yes | No |
| c) MPEG | Yes | No |
| d) WMV | Yes | No |
| e) Other(s) | Yes | No |

Formats and standards used by the Office to store, manage and publish electronic representation of marks

*14. Does the Office store and manage an electronic representation of the mark (whether provided by the applicant or produced by the Office) in a database? **Yes** No

15. Is the electronic representation of the mark available to the public? **Yes** No

* How can the public access the electronic representation of the mark?

- | | | |
|---|-----|----|
| a) At the Office only (e.g., a dedicated computer terminal) | Yes | No |
| b) Online (e.g., online database) | Yes | No |

16. In which format does the Office store, manage and publish the electronic representation of the mark when this consists of:

Please indicate the relevant format, such as, for example, JPEG, MP3 or MOV or type N/A if not applicable

* a) one or more digital still images

Your answer
JPEG, TIFF and PNG

* b) a digital recording of sound only

Your answer
MP3

* c) a digital recording of moving images without sound

Your answer
MP4

* d) a digital recording of moving images and sound

Your answer
MP4