

## TRADE MARKS: DIY FILING

### *What risks are you taking by self-filing?*

It is sometimes assumed that trade mark registration simply involves filling out a form, followed by the issuance of a Certificate of Registration. Unfortunately, it is not quite so simple and if not filed correctly at the outset, a trade mark registration may be very difficult or impossible to enforce.

Examples of self-filing risks are:

- If the registration does not cover the owner's goods and services appropriately, it will be difficult to enforce against competitors or copycats.

A trade mark must be filed in the correct classes of goods and services to provide adequate protection;

- If the trade mark applicant is not the true legal owner of the mark, it will not be enforceable. There are implications around what entity is the true owner of the mark;
- Objections may arise through the trade mark prosecution process, and a Trade Marks Attorney is able to guide owners through the possibilities of overcoming the objections. Many applicants who file themselves will abandon the process when objections arise, which is not always necessary.
- Without the advice of a Trade Marks Attorney, a trade mark owner may register a mark which is quite descriptive or generic, in the relevant industry and will be difficult to enforce, and thus holds little value.
- There are also many complexities around the issues of "use" – for example, what is deemed to be use of a trade mark? How much use do you need to overcome distinctiveness objections? In what form should evidence of use be presented to the Examiner, if required?



Trade Marks Attorneys offer experience and skills in the areas of trade mark registration, enforcement and strategy. It is important to remember that a trade mark is a valuable business asset and the attempt to save money by self-filing could potentially lead to much greater expense in dealing with the ramifications of an incorrectly filed registration.

## FIND OUT MORE

**We recommend that you speak with one of our Attorneys regarding your IP protection needs. There is no obligation and no fee for an initial meeting. We will advise the required steps and costs involved. Please contact us for more information.**

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