



TRADEMARK APPLICATION

Bang for your buck: trade marks and domain names

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Have you thought about whether you need to register your business' domain name as a trade mark? Depending on your circumstances, this may or may not be a necessary step to protect your intellectual property ("IP").

Getting your trade marks in a row

Your online business at killinit.com.au is starting to take off, and your name is becoming recognised.... congratulations! To protect your brand from imposters leeching off your customer goodwill you have decided to register:

Your brand as a word trade mark:

"Killin' It!"

Your logo as a combination trade mark:



And the good news is that your trusty trade mark lawyer has told you those marks are likely to be registered. Your customers are starting to refer to your business as its domain name "killinit.com.au", like "comparethemarket.com.au".

But what about the domain name?

Should you trade mark the domain, too? In most circumstances, it won't be necessary. Trade marks [cost](#) between \$250 and \$330 per class per application, plus legal fees. Depending on how many classes you register under, the cost of a single trade mark application will start adding up. If you are cashed up and can spend the extra money, then great, go ahead and register the domain name, too. Become a trade mark magnate.

But if you can't, then ensure you register a *word trade mark* which is the same as your website's identifier. For example, the KILLINIT in killinit.com.au is the identifier. By doing this, you will get some **bonus IP rights** with regards to the domain name.

How do I get these mysterious bonus IP rights?

Registering a **word trade mark** gives you the right to exclusively use, licence, or sell the rights to that word or words. This includes written or spoken use, any font or colour etc, when used for goods or services of the trade mark class in which it is registered. This exclusive right **can include the use of that word within your website domain name**, provided:

- you are using it according to the class it was registered under with [IP Australia](#); and
- it constitutes "use" under the *Trade Marks Act 1995* (Cth).

However, your brand may not be distinctive. Maybe it is too descriptive, commonplace or includes a common place or surname. Or your brand may not be distinctive

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enough to sufficiently distinguish your products or services from the products or services of similar businesses. In these cases, your marks/words are unlikely to be eligible for registration. One alternative is to trade mark your logo instead, to gain some protection. You can even combine word and image, if you want to.

If you don't register any trade marks, you may find that someone else can operate with similar names or logos, and confuse your customers. This could effect your reputation or lead to a serious loss of business

What constitutes "use" of my trade mark?

Obtaining a domain name which matches your word trade mark does not necessarily constitute "use". People have to be able to identify by your domain name that from your website you conduct the business associated with that trade mark, and not just an ancillary or related business.¹

For example, you trade mark the words: VINNING COMMERCIAL LAW. Your domain name winningcommerciallaw.com.au leads people to a website which offers almost exclusively commercial law advice and services. Here, you would be *using* your trade mark according to the *Trade Marks Act*. The upshot is that you can prevent other people from using deceptively similar domain names, if *they* are *using* those words to direct people to their website which also offers exclusively or primarily commercial law advice. Using a similar domain name for that purpose is "substantially identical with, or deceptively similar to" your word trade mark.²

What are my rights if I think someone's web address is infringing my word trade mark?

If someone does infringe your IP rights in this way, you could apply to the Federal Court or [.au Domain Administration](#) (the self-regulatory body for .au domain regulation) to stop the other person from using the other domain name. You can even apply to have the licence to the infringing website transferred to you. That said, registered IP rights are specific to each country. If someone was using winningcommerciallaw.com (not .com.au), operated in the US and did not specifically offer any services to Australians, you are unlikely to succeed in stopping them from using the domain name.³

Solahart is a good example of a successful challenge to infringing use of a word trade mark. This company sells solar panels and related goods, and is the registered trade mark owner of "SOLAHART". Solahart prevented a rival company from using the words "Solar Hut". Although technically different products, goods were sufficiently similar, and the class of consumers was similar enough

that confusion between the brands was likely. It was then found that Solar Hut was deceptively similar in sound to "Solahart", in breach of the *Trade Marks Act*.⁴

The other company was prevented from using the domain name solarhut.com.au on the same basis of infringement. The infringing company is no longer operational. However, a quick google reveals solarhut.org. This is an *American* company also selling solar panels, unrelated to Australia and Australian consumers. Solahart's IP rights do not extend to preventing this American company from using the otherwise deceptively similar domain name.

What are my rights if I do trade mark my domain name?

If you do apply to register your domain name as a trade mark you will only get limited protection. If you register with a ".com.au", you may not be able prevent others from registering .com, .org, .io etc, particularly if their product or service offering is not deceptively similar to yours.

Practical Advice

If you have registered your business name as a word trade mark that matches your domain name, your IP rights should be sufficiently protected. On the other hand, if you have not been able to register your desired trade mark word, an application to trade mark your domain name is probably an important step to take, given you don't have other alternatives.

If you are trying to decide what applications you need to make and in what form your mark may be approved as a trade mark, get in touch with us to assist you through the process of getting appropriate trade mark protection. Or if you think someone might be infringing on your trade mark rights, we can assist you to enforce your rights.

For more information, please contact:



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¹ *Sports Warehouse Inc v Fry Consulting Pty Ltd* (2010) 186 FCR 519

² *Trade Marks Act 1995* (Cth), s 120.

³ *Ward Group Pty Ltd v Brodie & Stone Plc* (2005) 143 FCR 479

⁴ *Solahart Industries Pty Ltd v Solar Shop Pty Ltd* [2011] FCA 700, [34], [49], [51]; breach of *Trade Marks Act*, s 120(2)(a).