

What the

THE CASE OF MR UNSUCCESSFUL

Imagine you owned a business. The business had been operating for about 15 years, but about 7 years ago you had some marketing advice, which caused you to take some specific strategic steps in relation to your business. You operated out of several locations in the South East Queensland area, including Brisbane City.

The main step was to abandon a previously, relatively unimaginative and descriptive trade name and to adopt a smart and catchy trade title. Many branding initiatives followed. The new trade identity was applied to coffee mugs, pens and sporting sponsorships. The business developed a wide and recognised reputation utilizing their new trade nomination.

In the course of running your business, you conducted an interview with a prospective employee. That candidate was unsuccessful (Mr Unsuccessful). You carry on trading and some months later you get a letter which absolutely flattens you.

The letter is from a solicitor, a solicitor for Mr Unsuccessful. It tells you that Mr Unsuccessful had lodged a trade mark application and that he now owned the trade mark you had so diligently built up over the last 7 or more years. The letter goes on to tell you that you should hand over all your stationery, all your rubber stamps that bear your trade mark and to notify the yellow pages and any other publications that advertised your trade name, that you no longer had the right to use that name. In the meantime Mr Unsuccessful was using the mark with his new business in competition to you and didn't want his clients confused by your advertising!

What the

You showed foresight in consolidating your business reputation into a brand, a trade mark. You had the smarts to expose the mark to the public in many different ways which gave rise to a reputation associated with the brand. You did what is usually done. You registered the name under the State business names legislation, but you didn't register the trade mark as a trade mark under the *Trade Marks Act* (Cth) 1995.

You see, having the business name registration gave no property right in the name itself. It just showed an address where you could be served with documents. At its highest it provided some evidence that you used or intended to use the name in your business. This along with phone accounts, electricity accounts and a vast array of bills and letters would have to be collected, to try to show that the mark was used in the course of conducting business and so refute a claim like the one Mr Unsuccessful tried to launch.

This actually happened to one of my clients. There was a happy ending but not without considerable stress, which could have been avoided. The anxiety that this incident caused cannot be compensated. Had you owned the registered mark, you have a balance sheet asset and can say to Mr Unsuccessful, "I own the registered trade mark which you are using or propose to use. Your mark is the same or deceptively similar to mine. Stop using it, deliver up everything bearing the mark and tell me when, where and how often you have already used it." A better situation, wouldn't you agree?