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NOTIFICATION OF PROVISIONAL REFUSAL OF PROTECTION BASED ON AN OPPOSITION

THIS REFUSAL IS ISSUED PURSUANT TO RULE 17(1) TO 17(3) OF THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT AGREEMENT

Trade Mark Number:	1889079
International Registration Number:	1376060
In the name of:	FOSHAN CITY FAENZA SANITARY WARE CO., LTD
Opposition by:	COOPERATIVA CERAMICA D'IMOLA S.C.



We advise that following receipt of a Notice of Opposition to the above Trade Mark on 5 June 2018, it is necessary to issue this formal refusal letter. This refusal covers all of the goods and/or services of the International Registration (**Rule 17(2)(vi)**). Please find attached a copy of the Notice of Intention to Oppose and the Statement of Grounds and Particulars (**Rule 17(2)(iv)**).

We also attach:

- Copies of the trade mark(s) upon which the opposition is based, (if conflicting trade mark numbers have been provided in the notice of opposition) showing all relevant details (**Rule 17(2)(v)**, **Rule 17(3)**).
- A copy of subdivision C of Division 3 of Part 17A of the *Trade Marks Regulations 1995* (**Rule 17(2)(iv)**).

Subdivision C points to other relevant sections of the *Trade Marks Act 1995* (the Act) and the *Trade Marks Regulations 1995* (the Regulations). Both the Act and the Regulations may be accessed at the following website address:

<http://www.ipaustralia.gov.au/about-us/publications-listing/ip-legislation/>

The following information can also be accessed at:

http://www.ipaustralia.gov.au/pdfs/trademarkmanual/trade_marks_examiners_manual.htm

The Trade Marks Office Manual of Practice and Procedure.

**IMPORTANT INFORMATION
NOTICE OF INTENTION TO DEFEND**



You have **ONE MONTH** from the date of this notification to file a notice of intention to defend with IP Australia. You must provide an address for service in Australia. IP Australia will give a copy of the notice of intention to defend to the opponent.

If you do not file a notice of intention to defend, the opposition will be taken to be successful and the IRDA may not be protected in Australia.

The trade marks opposition process can be lengthy. 3 months is nominally allowed for evidence in support of the opposition and 3 months for evidence in answer. 2 months is nominally allowed for evidence in reply. These periods may be extended. The due date for filing evidence in answer to the opposition (unless an extension of time is requested) will be **3 months** from the date on which the opponent files its evidence in support.

ADDRESS FOR SERVICE IN AUSTRALIA: *important information for the holder of an opposed international registration designating Australia*

If the holder wishes to make written representations or to be heard in relation to the opposition, then the holder **must** notify the Registrar, in writing, of the holder's address for service in Australia.

Please also note that the Registrar is not required to take any action in response to a notice of intention to defend unless the holder has notified the Registrar, in writing, of the holder's address for service in Australia.



Yours faithfully,
Chris Knight
Registrar of Trade Marks
IP Australia
Direct Dial: +61 2 62833195

21 June 2018

Subdivision C—Opposition to IRDA

17A.29 Definitions

In this Subdivision:

extension of protection means the extension of protection in Australia to the trade mark that is the subject of the IRDA.

notice of intention to defend means a notice filed under regulation 17A.34H.

notice of intention to oppose means a notice filed under regulation 17A.33.

notice of opposition means:

- (a) a notice of intention to oppose; and
- (b) a statement of grounds and particulars.

opponent means a person who files:

- (a) a notice of intention to oppose; and
- (b) a statement of grounds and particulars.

party means an IRDA holder or opponent.

statement of grounds and particulars means a statement by an opponent that sets out:

- (a) the grounds on which the opponent intends to rely; and
- (b) the facts and circumstances forming the basis for the grounds.

Note: The following terms are defined in section 6 of the Act:

- (a) applicant;
- (b) approved form;
- (c) employee;
- (d) file;
- (e) month;
- (f) person.

17A.30 Registrar may give direction about filing document or evidence

- (1) If a document or evidence may or must be filed under this Subdivision, the Registrar may give a direction specifying:
 - (a) how many copies of the document or evidence must be filed; and
 - (b) the form in which the document or evidence is to be filed; and
 - (c) the means by which the document or evidence is to be filed.
- (2) If a party does not comply with the direction, the Registrar may:
 - (a) treat the document or evidence as not having been filed; or
 - (b) tell the party to comply with the direction.
- (3) The Registrar may make or revoke the direction as the Registrar sees fit.
- (4) Regulation 17A.31 does not apply to this regulation.

17A.31 Notification and opportunity to make representations

- (1) This regulation applies if:
 - (a) a party makes a request to the Registrar under this Subdivision; or
 - (b) the Registrar proposes to make a decision on the Registrar's own initiative under this Subdivision.
- (2) The Registrar must:
 - (a) for paragraph (1)(a)—notify the other party of the request, including by giving the other party a copy of the request; or
 - (b) for paragraph (1)(b)—notify the parties of the proposed decision.
- (3) If the Registrar proposes to grant the request, the Registrar must give the parties an opportunity to make representations:

- (a) in writing; or
 - (b) at a hearing; or
 - (c) by other means that the Registrar states in the notification.
- (4) The Registrar must notify the parties of the Registrar's decision.

17A.32 Filing of notice of opposition

- (1) A notice of opposition is taken to be filed when the notice of intention to oppose and the statement of grounds and particulars have been filed under regulations 17A.33 and 17A.34A.
- (2) The Registrar must notify the International Bureau of the filing of the notice of opposition in accordance with rule 17, as applicable, of the Common Regulations.

17A.33 Filing of notice of intention to oppose

- (1) If the Registrar advertises the acceptance of an IRDA in the *Official Journal*, a person may oppose the extension of protection by filing a notice of intention to oppose within 2 months from the advertisement of the acceptance.
- (2) The notice must be in an approved form.
- (3) The Registrar must give a copy of the notice to the applicant.

17A.34 Grounds for opposing IRDA

- (1) The extension of protection may be opposed on any of the grounds on which an IRDA may be rejected under Subdivision 2, except the ground that the trade mark cannot be represented graphically.
- (2) The extension of protection may also be opposed on any of the grounds set out in sections 58 to 61 and 62A of the Act, as affected by subregulation (3).
- (3) Sections 58 to 61 and 62A of the Act apply in relation to an IRDA as if:
 - (a) a reference in those sections:
 - (i) to an application for the registration of a trade mark were a reference to the IRDA; and
 - (ii) to an applicant were a reference to the holder of the IRDA; and
 - (iii) to the registration of a trade mark were a reference to the extension of protection in Australia to the trade mark that is the subject of the IRDA; and
 - (b) the reference in paragraph 60(a) of the Act to the priority date for the registration of the trade mark were a reference to the priority date for the trade mark that is the subject of the IRDA.
- (4) The extension of protection may also be opposed on the grounds that:
 - (a) a document filed in support of the IRDA was amended contrary to the Act; or
 - (b) the Registrar accepted the IRDA on the basis of evidence provided, or a representation made, by the holder that was false in a material particular.

Note: Section 66 of the Act provides for the amendment of documents filed with the Registrar.

17A.34A Filing of statement of grounds and particulars

- (1) A statement of grounds and particulars must be filed within one month from the day the notice of intention to oppose is filed.
- (2) The statement must be in an approved form.

17A.34B Statement of grounds and particulars must be adequate

- (1) The Registrar must assess the adequacy of a statement of grounds and particulars.
- (2) If the Registrar decides that the statement is adequate, the Registrar must give a copy of the statement to the applicant.
- (3) If the Registrar decides that the statement is inadequate:
 - (a) the Registrar may direct the opponent to rectify the inadequacy by filing more information on the basis for one or more of the grounds; or
 - (b) if all the grounds are inadequately particularised, the Registrar may dismiss the opposition: or

- (c) if only some of the grounds are inadequately particularised, the Registrar may:
 - (i) delete from the statement some or all of the material that is inadequate; and
 - (ii) treat the result as the statement for the purposes of these Regulations; and
 - (iii) give a copy of the amended statement to the opponent.
- (4) If the Registrar decides that the statement is still inadequate after the information is filed under paragraph (3)(a):
 - (a) the Registrar may dismiss the opposition; or
 - (b) the Registrar may:
 - (i) delete from the statement some or all of the material that is inadequate; and
 - (ii) treat the result as the statement for the purposes of these Regulations; and
 - (iii) give a copy of the amended statement to the opponent.
- (5) If the Registrar decides that the information filed under paragraph (3)(a) rectifies the inadequacy of the statement, the Registrar must give a copy of the statement and the information filed in relation to paragraph (3)(a) to the applicant.
- (6) The opponent may apply to the Administrative Appeals Tribunal for review of a decision under this regulation to dismiss the opposition or delete material from the statement of grounds and particulars.
- (7) Regulation 17A.31 does not apply to this regulation.

17A.34C Extension of time for filing—application

- (1) A person who intends to oppose the extension of protection may request the Registrar to extend:
 - (a) the period for filing a notice of intention to oppose under subregulation 17A.33(1); or
 - (b) the period for filing a statement of grounds and particulars under subregulation 17A.34A(1).
- (2) A request under paragraph (1)(a) or (b) may be made:
 - (a) within the period for filing the document in question; or
 - (b) before the extension of protection of the IRDA is entered on the Record of International Registrations under paragraph 17A.37(1)(b).

Note: See subparagraph (3)(b)(ii) and subregulation 17A.34D(2) in relation to the consequences of making the request after the filing period has ended.

- (3) The request must:
 - (a) be in an approved form; and
 - (b) be accompanied by a declaration stating:
 - (i) the facts and circumstances forming the basis for the grounds; and
 - (ii) if the period for filing the notice or the statement of grounds and particulars has ended—the reason why the request was not made within the period.

Note: Regulations 21.6 and 21.7 deal with making and filing declarations.

- (4) The request must be made only on either or both of the following grounds:
 - (a) an error or omission by the person, the person's agent, the Registrar or an employee;
 - (b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.
- (5) Subsection 52(5) of the Act applies to the request.
- (6) Regulation 17A.31 does not apply to this regulation.

17A.34D Extension of time for filing—grant

- (1) The Registrar may grant a request under subregulation 17A.34C(1) for an extension of time if the Registrar is satisfied that the grounds set out in the request justify the extension.
- (2) However, if the request is made after the period for filing the notice or statement of grounds and particulars has ended, the Registrar must not grant the extension unless the Registrar is satisfied that there is sufficient reason for the delay in making the request.
- (3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

17A.34E Opposition may proceed in name of other person

Section 53 of the Act applies to a notice of intention to oppose filed under this Subdivision.

17A.34F Amendment of notice of intention to oppose

- (1) An opponent may request the Registrar to amend a notice of intention to oppose to correct a clerical error or obvious mistake.
- (2) If an opposition proceeds in the name of another person under section 53 of the Act, the person may request the Registrar to amend the notice of intention to oppose to record the person's name.
- (3) The Registrar may grant a request under subregulation (1) or (2) on terms that the Registrar considers appropriate.
- (4) If the Registrar grants the request, the Registrar must give a copy of the notice of the amended intention to oppose to the IRDA holder.
- (5) Regulation 17A.31 does not apply to this regulation.

17A.34G Amendment of statement of grounds and particulars

- (1) An opponent may request the Registrar to amend the statement of grounds and particulars to:
 - (a) correct an error or omission in the grounds of opposition or the facts and circumstances forming the basis for the grounds; or
 - (b) amend a ground of opposition; or
 - (c) add a new ground of opposition; or
 - (d) to amend the facts and circumstances forming the basis for the grounds.
- (2) The Registrar may grant the request on terms that the Registrar considers appropriate.
- (3) However, the Registrar may grant a request to:
 - (a) amend a ground of opposition; or
 - (b) add a new ground of opposition;only if the Registrar is satisfied that the amendment or addition relates to information of which the opponent could not reasonably have been aware at the time of filing the statement.
- (4) If the Registrar grants the request, the Registrar must give a copy of the amended statement to the IRDA holder.

17A.34H Filing of notice of intention to defend

- (1) The IRDA holder must file a notice of intention to defend within one month from the day the Registrar notifies the International Bureau under subregulation 17A.32(2).
- (2) The holder must file an Australian address for service with the notice.
- (3) The Registrar must give a copy of the notice to the opponent.
- (4) If the holder does not file the notice within the period mentioned in subregulation (1), the Registrar may decide to:
 - (a) take the opposition to have succeeded; and
 - (b) refuse protection to the holder.
- (5) The Registrar is not required to take any action in response to a notice of intention to defend filed under subregulation (1) unless the opponent has notified the Registrar, in writing, of the opponent's address for service in Australia.
- (6) A requirement to:
 - (a) give a document to a person; or
 - (b) give a person an opportunity to make written representations or to be heard;does not apply if no address for service of the person is recorded in the Record of International Registrations.
- (7) The Registrar must notify the parties of the Registrar's decision.

17A.34J Filing of evidence

- (1) The Registrar must notify the parties that:
 - (a) all the evidence for an evidentiary period mentioned in this regulation has been filed; or
 - (b) no evidence was filed for the period.
- (2) The Registrar must give a copy of any evidence filed by a party under this regulation to the other party:
 - (a) before the end of the relevant evidentiary period, if the Registrar considers it appropriate to do so; or
 - (b) after the evidentiary period ends.

Evidence in support

- (3) An opponent must file any evidence in support of the opposition within 3 months from the day the opponent is given a copy of the notice of intention to defend.

Evidence in answer

- (4) If the opponent files evidence in support of the opposition, the IRDA holder must file any evidence in answer to the evidence in support within 3 months from the day the Registrar:
 - (a) gives the IRDA holder:
 - (i) all the evidence in support; or
 - (ii) if the opponent files the evidence in support in instalments—the final instalment of the evidence in support; and
 - (b) notifies the IRDA holder that all the evidence in support has been filed.
- (5) If the opponent does not file any evidence in support of the opposition, the IRDA holder must file any evidence in answer to the statement of grounds and particulars within 3 months from the day the Registrar notifies the IRDA holder that no evidence in support was filed.

Evidence in reply

- (6) If the IRDA holder files evidence in answer under subregulation (4) or (5), the opponent must file any evidence in reply to the evidence in answer within 2 months from the day the Registrar:
 - (a) gives the opponent:
 - (i) all the evidence in answer; or
 - (ii) if the IRDA holder files the evidence in answer in instalments—the final instalment of the evidence in answer; and
 - (b) notifies the opponent that all the evidence in answer has been filed.

17A.34K Extension of time for filing

- (1) A party may request the Registrar to extend a period for filing evidence mentioned in regulation 17A.34J.
- (2) The Registrar may extend the period only if the Registrar is satisfied that:
 - (a) the party:
 - (i) has made all reasonable efforts to comply with all relevant filing requirements of this Subdivision; and
 - (ii) despite acting promptly and diligently at all times to ensure the filing of the evidence within the period, is unable to do so; or
 - (b) there are exceptional circumstances that justify the extension.
- (3) The Registrar:
 - (a) must decide the length of the extended period having regard to what is reasonable in the circumstances; and
 - (b) may do so on terms that the Registrar considers appropriate.
- (4) In this regulation:

exceptional circumstances includes the following:

 - (a) a circumstance beyond the control of a party that prevents the party from complying with a filing requirement under this Subdivision;

- (b) an error or omission by the Registrar or an employee that prevents a party from complying with a filing requirement under this Subdivision;
- (c) an order of a court or a direction by the Registrar that the opposition be stayed.

17A.34L Registrar may allow cooling-off period

- (1) This regulation applies to an opposition if:
 - (a) the notice of opposition has been filed; and
 - (b) the Registrar has not made a decision on the opposition under regulation 17A.34N; and
 - (c) the opposition has not been dismissed under regulation 17A.34B.
- (2) If the Registrar is satisfied that the parties agree to a cooling-off period, the Registrar must allow a cooling-off period of 6 months.
- (3) The Registrar must extend the cooling-off period for 6 months if, before the end of the period, the Registrar is satisfied that the parties agree to the extension.
- (4) The Registrar must not:
 - (a) further extend the cooling-off period; or
 - (b) allow more than one cooling-off period for an opposition.
- (5) If a party files a notice in an approved form requesting the Registrar to discontinue the cooling-off period, the Registrar must do so.
- (6) The Registrar may direct the parties on steps they must take:
 - (a) if the cooling-off period is discontinued; or
 - (b) otherwise—when the cooling-off period ends.
- (7) The opposition resumes:
 - (a) if the cooling-off period is discontinued; or
 - (b) otherwise—when the cooling-off period ends.
- (8) If:
 - (a) the cooling-off period begins during the period mentioned in regulation 17A.34H or an evidentiary period mentioned in regulation 17A.34J; and
 - (b) the opposition resumes;the period mentioned in regulation 17A.34H or 17A.34J restarts when the opposition resumes.

17A.34M Hearing

- (1) This regulation applies to an opposition if:
 - (a) the opposition has not been dismissed under regulation 17A.34B; or
 - (b) the opposition has not been decided under regulation 17A.34N; or
 - (c) the opposition is not taken to have succeeded under regulation 17A.34H.
- (2) An applicant may request the Registrar to hold a hearing if:
 - (a) the evidentiary period mentioned in subregulation 17A.34J(3) has ended; and
 - (b) either:
 - (i) all evidence for the opposition proceeding has been filed; or
 - (ii) no evidence has been filed in that period.
- (3) A party may request the Registrar to hold a hearing if:
 - (a) an evidentiary period mentioned in any of subregulations 17A.34J(4) to (6) has ended; and
 - (b) either:
 - (i) all evidence for the opposition proceeding has been filed; or
 - (ii) no evidence has been filed in that period.
- (4) The Registrar:
 - (a) must hold a hearing of the opposition if requested by a party in writing; or
 - (b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.
- (5) The hearing may, at the Registrar's discretion, be:
 - (a) an oral hearing; or
 - (b) by written submissions.

- (6) If the Registrar decides on an oral hearing:
 - (a) the Registrar must notify the parties of the date, time and place of the hearing; and
 - (b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
 - (c) the applicant must file a summary of submissions at least 5 business days before the hearing.
 - (7) The Registrar may take into account a party's failure to file a summary of submissions under subregulation (6) in making an award of costs.
- Note: Regulations 21.15 and 21.16 deal with hearings.

17A.34N Decision on opposition

- (1) Unless the opposition proceedings are discontinued or dismissed, the Registrar must decide:
 - (a) to refuse protection in respect of all of the goods or services listed in the IRDA; or
 - (b) to extend protection in respect of some or all of the goods or services listed in the IRDA (with or without conditions or limitations);having regard to the extent (if any) to which the grounds on which the IRDA was opposed have been established.
- (2) The Registrar must notify the International Bureau of the Registrar's decision.

17A.34P Appeal

- (1) Section 56 of the Act applies in relation to the Registrar's decision on the opposition as if a reference in that section:
 - (a) to an applicant were a reference to the holder of an IRDA; and
 - (b) to a decision under section 55 of the Act were a reference to a decision under regulation 17A.34N.
- (2) If an appeal is made, the Registrar must tell the International Bureau of the decision on the appeal.

17A.34Q Registrar may give direction

- (1) The Registrar may give a direction in relation to an opposition to which this Division applies:
 - (a) if requested by a party in writing; or
 - (b) on the Registrar's own initiative.
- (2) If the Registrar proposes to give a direction, the Registrar must give the parties an opportunity to make representations about the direction.
- (3) A direction must not be inconsistent with the Act or these Regulations.
- (4) The Registrar must notify the parties of the direction as soon as practicable.

17A.35 Registrar must notify parties of dismissal or discontinuance of opposition

If an opposition is dismissed under regulation 17A.34B or discontinued, the Registrar must notify the parties of the dismissal or discontinuance.

Trade Marks Act 1995

NOTICE OF INTENTION TO OPPOSE

Trade Mark Application Number:	1889079 (IR 1376060)
In the names of:	FOSHAN CITY FAENZA SANITARY WARE CO., LTD Sanzhou Park, East Zone, Cangjiang Ind. Zone, Gaoming District, Foshan City 528511 Guangdong province CHINA
Mark:	FAENZA
Classes:	19

DETAILS OF OPPONENT:

Name: COOPERATIVA CERAMICA D'IMOLA S.C.

Address: Via Vittorio Veneto, 13
I-40026 IMOLA (BOLOGNA)
ITALY

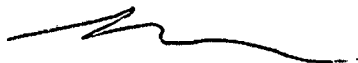
Opponent's Address for Service:

WRAYS PTY LTD
Level 20
600 Bourke Street
MELBOURNE VIC 3000

Opponent's Reference: 271129

<i>Telephone No.</i>	<i>Facsimile No.</i>	<i>Email</i>	<i>Attorney Code</i>
(03) 8538 5800	(03) 8538 5899	wrays@wrays.com.au	WZ

- The Opponent intends to oppose registration of the abovementioned trade mark.
- The Opponent intends to oppose the application to remove the abovementioned trade mark for non-use.



WRAYS PTY LTD
On behalf of the Opponent

5 June 2018



Statement of Grounds and Particulars

Personal Details of Customer

(* denotes mandatory fields)

* Name	COOPERATIVA CERAMICA D'IMOLA S.C.				ACN/ARBN/ABN	
* Address (can be a PO Box)	Via Vittorio Veneto 13, I-40026 Imola (Bologna)					
	ITALY	State			Postcode	
Telephone		Fax number		Mobile number		
Email Address						
* 2nd Name (if required)	ACN/ARBN/ABN					
* Address (can be a PO Box)						
	Country (if not Australia)			State	Postcode	
Telephone		Fax number		Mobile number		
Email Address						
<input type="checkbox"/> Additional customer details attached						

*Address for Service

Address for Service of documents in Australia or New Zealand (can be a PO Box)

Address	Wrays Pty Ltd, Level 20, 600 Bourke Street, Melbourne					
	Country	Australia	State	VICTORIA	Postcode	3000
Telephone	(03) 8538 5800	Fax number		Mobile number		
Email Address	wrays@wrays.com.au			Your reference	271129	

(IMPORTANT: This e-mail will be used for filing/receiving evidence electronically. See Part 6.10 of this form.)

By completing this form you consent to your personal information being handled in accordance with the Privacy Notice on page 1 of this form and the IP Australia Privacy Policy.

IP Australia publishes address details in our online databases and bulk data products. Please provide a post office box if you do not want your residential address to be published.



Statement of Grounds and Particulars

Part 1 Formality Details

(Enter in numeric order and use block letters)

Trade Mark No.	International Registration No.(s) (if applicable)	In the name of	ACN (if applicable)
1889079	IR 1376060	FOSHAN CITY FAENZA SANITARY WARE CO., LTD	

Part 2 Type of Opposition Proceeding (Please tick the appropriate box)

Opposition to:

- Registration of the above trade mark / Protection of the above International Registration Designating Australia (IRDA).
You must complete Part 3
- Removal of the above trade mark / Cessation of protection of the above international trade mark for non-use.
You must complete Part 4

Part 3 Grounds and Particulars (Opposition to Registration / Protection)

(Please tick the appropriate box/es and provide particulars supporting the nominated ground/s for opposition)

Full grounds of opposition are set out in the Trade Marks Act 1995 and the Trade Marks Regulations 1995. More information is available in Part 46 of the Trade Marks Office Manual of Practice and Procedure.

- Trade mark not capable of distinguishing the applicant's goods and/or services - **Section 41** (this is not a ground for opposing a certification or defensive trade mark - see section 177 or 187)

Particulars should include: reasons why other traders, without improper motive, would desire to use the trade mark in the ordinary course of trade in respect of similar goods/services to those of the application.

Notwithstanding the presence of Chinese characters in the opposed mark, the identity of the opposed mark is the word 'FAENZA'. 'FAENZA' is a town located in the Emilia Romagna region of Italy which is well-known for the high quality of its ceramic products, including bricks, tiles and glass mosaics. The opposed mark is therefore not capable of distinguishing the Applicant's goods from those of other traders including those from the town of FAENZA who would desire, without improper motive, to use FAENZA in the ordinary course of their brick, tile, glass mosaic or other ceramic business to identify the origin of those products.

- Substantially identical / deceptively similar trade marks - **Section 44 / Reg 4.15A**

Particulars should include: a list of the trade mark numbers on which the opposition is based.

Opponent has earlier use of the same / similar trade mark - **Section 58A**


Particulars should include: the earlier trade mark number and description of the goods and/or services in respect of which the trade mark is used, date of first use of the earlier trade mark and whether the use has been continuous.

Applicant not the owner of the trade mark - **Section 58**

Particulars should include: identify first used trade mark (trade mark does not need to be applied for or registered), goods and/or services in respect of which the trade mark is used, and whether first use was before the priority date of the opposed application. Alternatively, any other reasons the applicant does not have good title to the trade mark.


Trade mark is similar to a trade mark which has acquired a reputation in Australia - **Section 60**

Particulars should include: identify the trade mark that has acquired a reputation in Australia (the trade mark does not need to be applied for or registered), or the trade mark number if applicable, the goods and/or services in respect of which the trade mark has a reputation and whether first use was before the priority date of the opposed application.

<p>The opposed mark is similar to the Opponent's trade marks LA FAENZA, LAFENZA and  LAFENZA TILE WITH STYLE which, as a result of extensive use in relation to bricks, tiles, including non-metallic and ceramic tiles for floors and for buildings, glass mosaics, and goods which are similar to all of the foregoing, since before the priority date of the opposed application, have acquired a significant reputation in Australia.</p>
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Trade mark is scandalous or contrary to law - **Section 42**

Particulars should include: s42(a) - why the trade mark is scandalous; s42(b) - why use of the trade mark would be contrary to law.

<p>The opposed mark is substantially identical with or deceptively similar to the Opponent's trade marks LA FAENZA, LAFENZA and  LAFENZA TILE WITH STYLE which have acquired a significant prior reputation in Australia as a result of extensive use, and therefore any use of the opposed mark would be contrary to law including a breach of the provisions of Sections 18 and 29 of the Australian Consumer Law, and/or would constitute passing off. Further, 'FAENZA' is a town located in the Emilia Romagna region of Italy, and well-known for the high quality of its ceramic products. Any use of 'FAENZA' as a trade mark in relation to such goods which do not originate from the Italian town of FAENZA would be likely to mislead or deceive consumers as to the origin of those goods.</p>
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Trade mark likely to deceive or cause confusion - **Section 43**

Particulars should include: an explanation of the connotation arising from the trade mark itself* and why use of the trade mark is likely to deceive or cause confusion.

<p>'FAENZA' is a town located in the Emilia Romagna region of Italy, and is well-known for the high quality of its ceramic products. 'FAENZA' accordingly inherently connotes ceramic products which originate from the town of FAENZA. Any use of 'FAENZA' as a trade mark in relation to goods falling within the specification of the opposed mark which do not originate from the Italian town of FAENZA would therefore be likely to deceive or cause confusion as to the origin of those goods.</p>

*If you believe deception or confusion arises from the existence of another trade mark please refer to section 58, 60 and/or 44 of the Act.

Applicant not intending to use the trade mark - **Section 59** (*this is not a ground for opposing a defensive trade mark*)

Particulars should include: what leads you to believe that the applicant had no intention to use the trade mark.

Application made in bad faith - **Section 62A**

Particulars should include: what leads you to believe that the trade mark application was made in bad faith.

The Applicant and the Opponent are known to each other, and are and have been engaged in disputes in other jurisdictions concerning the opposed mark due to its similarity to the Opponent's trade marks LA FAENZA, LAFENZA and



. The Applicant was accordingly already aware, at the time it filed the opposed application, of the client's concerns with respect to the opposed mark and its similarity to the Opponent's trade marks including the Opponent's prior use of and reputation in its trade marks, but despite this elected to pursue registration of the opposed mark in Australia.

Such conduct falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced persons.

Trade mark containing / consisting of a false geographical indication - **Section 61**

Particulars should include: geographical indication; country, region or locality in which the geographical indication is recognised and goods for which it is recognised; details of origin of opposed trade mark's goods (if known).

Trade mark is / contains prohibited or prescribed signs - **Section 39**

Particulars should include: details of prescribed or other sign that is not to be used as a trade mark.

Application etc. defective etc. - **Section 62**

Particulars should include: s62(a) - details of the defective amendment; s62(b) - brief details of false material or representations.

Certification trade mark not distinguishing certified goods and/or services - **Section 177**

Particulars should include: why the trade mark is not capable of distinguishing the goods/services certified by the applicant from those that are not so certified.

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Part 6 Important Information for Filing a Statement of Grounds and Particulars

1. There are two parts to a notice of opposition:
 - a notice of intention to oppose; and
 - a statement of grounds and particulars.
2. A statement of grounds and particulars is a statement by an opponent that sets out:
 - the grounds on which the opponent intends to rely; and
 - the facts and circumstances forming the basis for the grounds.
3. A statement of grounds and particulars must be filed within **one month** from the day on which a notice of intention to oppose is filed with IP Australia.
4. If a statement of grounds and particulars is not filed, the notice of opposition is incomplete and the opposition will not proceed.
5. The Registrar must assess the adequacy of the statement of grounds and particulars. If the statement is adequate, IP Australia will give a copy to the other party.
6. If the statement of grounds and particulars is inadequate the Registrar may:
 - direct the opponent to rectify the inadequacy by filing more information on the basis for the grounds; or
 - dismiss the opposition.
7. If a notice of intention to defend is filed by the other party you will be required to support the particulars, provided in Part 3 and Part 4 of this form, with evidence in declaratory form.
8. A fee does NOT apply to filing this form.
9. The *Trade Marks Office Manual of Practice and Procedure* contains more information about a statement of grounds and particulars. The Manual can be accessed via IP Australia's website at www.ipaustralia.gov.au.
10. Information about filing / receiving evidence electronically in opposition proceedings is available on IP Australia's website. If the other party responds by filing a Notice of Intention to Defend, you will receive an email from Objective Connect inviting you to view the evidence folders for this matter.

Part 7 General Information

1. IP Australia will give relevant documents filed in an opposition to the other party.
2. IP Australia does not offer or provide any legal, financial or business advice or financial assistance in respect to the opposition and hearing process. The Trans-Tasman IP Attorney Board provides a list of registered professionals on their website - www.ttipattorney.gov.au. Alternatively you may wish to consult a telephone or business directory.
3. Opposition proceedings are legal processes and once started the unsuccessful party or parties may be liable for costs being awarded against them. The matters and amounts that may be awarded are set out in Schedule 8 (Costs, Expenses and Allowances) of the *Trade Marks Regulations 1995*. An award of costs is decided at the conclusion of the matter. To apply for an award, please refer to Part 5 of this form.
4. You can find more information about trade mark oppositions by searching 'trade mark oppositions' on the IP Australia website at www.ipaustralia.gov.au.