

6 January 2019

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ABN: 38 113 072 755

International Bureau, WIPO  
34, chemin des Colombettes  
P.O. Box 18  
1211 Geneva 20,  
SWITZERLAND

**International registration number:** 1413737  
**Australian Trade mark Number:** 1942077  
**Trade mark:** IDEAL PLANTS  
**Holder's name:** Salk Institute for Biological Studies

**NOTIFICATION OF PROVISIONAL REFUSAL OF AN INTERNATIONAL REGISTRATION  
DESIGNATING AUSTRALIA (IRDA) THIS REFUSAL IS ISSUED IN ACCORDANCE WITH RULE  
17(1) TO 17(3)**

The application does not meet the requirements of *Trade Marks Act 1995*. The issues currently preventing acceptance of the International Registration are explained in the attached Adverse Examination Report number 1 and where possible, the ways in which the holder may be able to resolve the issues.

The holder has until **6 April 2020** to overcome all the issues otherwise this refusal will take effect.

The holder may respond in writing to this refusal. Any response needs to be sent through an address for service in Australia or New Zealand. Please allow time for me to consider any responses by ensuring they are received by this office no later than 20 business days prior to 6 April 2020.

This provisional refusal will be reviewed if the holder:

- makes written submissions in support of the claim to protection of the trade mark in Australia; and/or
- submits evidence in support of the claim to protection of the trade mark in Australia; and/or
- applies for a hearing

The trade mark examiner who produced this report is Patrick Johnson who can be contacted on +61262832796.

Details of the trade mark can be viewed using our [Australian trade mark search](#) on our website.

Sincerely,

IP Australia

## Adverse Examination Report

The following issues have been raised under the Trade Marks Act 1995 and will need to be addressed before your IRDA can be accepted.

- Issues raised under Section 41 of the Trade Marks Act 1995.

### Issues raised under Section 41 of the Trade Marks Act 1995.

To be protected in Australia, your trade mark must be capable of distinguishing your services from the similar goods/services of other traders in the market place. (For more details, see Section 41 of the Trade Marks Act 1995.)

Your IRDA is refused because your trade mark is not capable of distinguishing the specified goods/services. This is because your trade mark is IDEAL PLANTS.

The *Macquarie Dictionary* defines IDEAL to include 'regarded as perfect of its kind; best'.

Therefore, your trade mark indicates that your services are research into and development of plants which are perfect of their kind or the best; that is, that your research services relate to IDEAL PLANTS, and that the development of IDEAL PLANTS is the intended outcome of your services.

Other traders should be able to use IDEAL PLANTS, or something nearly resembling it, in connection with goods or services similar to yours.

### The refusal applies to the following goods/services:

**Class 42:** all services in this class.

### What you can do now

Grounds for rejecting this International Registration Designating Australia (IRDA) exist under subsection 41(4) of the Trade Marks Act 1995.

### You may respond to this refusal by:

- Making submissions and/or
- Providing evidence of use showing that the trade mark is capable of distinguishing the goods/services in Australia and/or
- Requesting a hearing.

Before deciding whether to provide evidence you should consider the following:

- Evidence must be supplied as a declaration and should be accompanied by supporting evidence and information regarding the extent of the use of your trade mark in Australia.
- Gathering and compiling this evidence may be time-consuming and expensive
- The evidence you provide may be insufficient to overcome the refusal

If you wish to respond in any of these ways, you must do so in writing and supply an address for service in Australia or New Zealand. If you do not respond by the date mentioned on the first page of

this report, this IRDA will be refused for the above goods/services.

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## REQUIREMENTS FOR EVIDENCE OF USE

### Subsection 41(4) *Trade Marks Act 1995*

Evidence of use must be in declaratory form. This may be made by the holder, a principal officer of the holder company or by a person authorised to make it on behalf of the holder. **If the declaration is not in English, it must be accompanied by a certified translation into English.** The evidence must incorporate any exhibits or appendices. If they are not incorporated, they do not form part of the declaration.

Where possible evidence should be submitted in electronic form, through IP Australia's online services. In particular, providing clear digital images of objects bearing the trade mark will be as effective as providing the objects themselves.

Under subsection 41(4) use **may be before or after the date on which Australia was designated in the international application or registration.** The evidence may include use by a predecessor in title of the holder, use by an authorised user, and use on goods and/or services for export. Evidence of use of the trade mark in similar markets in countries other than Australia can be taken into account.

### EVIDENCE REQUIRED

For evidence of **actual** use the declaration should include:

- the international registration number;
- our reference;
- a representation of the trade mark;
- the holder's name;
- the name and address of the person making the declaration;
- the position and length of service in that position of the person making the declaration (if the holder is a company);
- a brief history of the trade mark, including:
  - the goods and/or services for which the trade mark has been used;
  - when the trade mark was first used in Australia in connection with the goods and/or services claimed in your IRDA (please give the year and, if possible, the month), and whether this use has been continuous since then;
  - where the trade mark has been used in Australia and/or countries overseas (please give States or regions);
  - examples of how the trade mark has been used in Australia in connection with the goods and/or services claimed in your IRDA (please attach copies of advertising, promotional material and/or packaging and outline how each of these have been used);
  - annual expenditure (in Australian Dollars) on advertising and promoting the trade mark in Australia in connection with the goods and/or services claimed in your IRDA;
  - annual turnover figures (in Australian Dollars) for the specific goods and/or services claimed in your IRDA sold or provided in Australia using the trade mark; and
  - any other information or materials which will help show how the trade mark has been used (please attach copies of these materials).

For evidence of **intended** use, the declaration should include:

- Comprehensive details of business plans and/or other documents demonstrating a definite intention to use the trade mark (please attach copies of these documents).
- Details of the goods or services this planned use relates to.
- Figures in Australian dollars for any costs already incurred in preparing to use the trade mark.

- Any other information or materials which will help show how the trade mark is intended to be used (please attach copies of these materials).

**Please note:**

- The evidence you provide must relate to your trade mark as it is shown in your IRDA, without any major changes.
- The evidence you provide must clearly demonstrate that your IRDA is used and promoted as a trade mark, and that it is recognised by consumers as a trade mark.
- If you can only show use of your trade mark on some of the goods or services in your IRDA, please agree to limit your IRDA to cover only those goods or services.

## **Grounds for rejecting IRDA**

### **Regulation 17A.28**

- 1) The grounds for rejecting an IRDA are the grounds set out in sections 39 to 44 of the Act, as affected by subregulation (2).
- 2) Sections 39 to 44 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
  - b) the reference in paragraph 41 (3) (b) to the filing date in respect of an application were a reference to the date of international registration or the date of recording, as applicable, in respect of the IRDA; and
  - c) each reference in subparagraphs 44 (1) (a) (i) and (2) (a) (i) to a trade mark registered by another person included a protected international trade mark held by another person; and
  - d) each reference in subparagraphs 44 (1) (a) (ii) and (2) (a) (ii) to a trade mark whose registration is being sought by another person included a trade mark in respect of which the extension of protection to Australia is being sought by another person.

### **Section 39 Trade mark containing etc. certain signs**

- 1) An application for the registration of a trade mark must be rejected if the trade mark contains or consists of a sign that, under regulations made for the purposes of section 18, is not to be used as a trade mark.
- 2) An application for the registration of a trade mark may be rejected if the trade mark contains or consists of:
  - a) a sign that is prescribed for the purposes of this subsection; or
  - b) a sign so nearly resembling:
    - i) a sign referred to in paragraph (a); or
    - ii) a sign referred to in subsection (1);as to be likely to be taken for it.

### **Section 40 Trade mark that cannot be represented graphically**

- 1) An application for the registration of a trade mark must be rejected if the trade mark cannot be represented graphically.

### **Section 41 Trade mark not distinguishing applicant's goods or services**

- 1) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered (the designated goods or services) from the goods or services of other persons.

*Note:* For goods of a person and services of a person see section 6.

- 2) A trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons only if either subsection (3) or (4) applies to the trade mark.
- 3) This subsection applies to a trade mark if:
- a) the trade mark is not to any extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons; and
  - b) the applicant has not used the trade mark before the filing date in respect of the application to such an extent that the trade mark does in fact distinguish the designated goods or services as being those of the applicant.
- 4) This subsection applies to a trade mark if:
- a) the trade mark is, to some extent, but not sufficiently, inherently adapted to distinguish the designated goods or services from the goods or services of other persons; and
  - b) the trade mark does not and will not distinguish the designated goods or services as being those of the applicant having regard to the combined effect of the following:
    - i) the extent to which the trade mark is inherently adapted to distinguish the goods or services from the goods or services of other persons;
    - ii) the use, or intended use, of the trade mark by the applicant;
    - iii) any other circumstances.

*Note 1:* Trade Marks that are not inherently adapted to distinguish goods or services are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate:

- a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or
- b) the time of production of goods or of the rendering of services.

*Note 2:* For goods of a person and services of a person see section 6.

*Note 3:* Use of a trade mark by a predecessor in title of an applicant and an authorised use of a trade mark by another person are each taken to be use of the trade mark by the applicant (see subsections (5) and 7(3) and section 8).

- 5) For the purposes of this section, the use of a trade mark by a predecessor in title of an applicant for the registration of the trade mark is taken to be use of the trade mark by the applicant.

*Note 1:* For applicant and predecessor in title see section 6.

*Note 2:* If a predecessor in title had authorised another person to use the trade mark, any authorised use of the trade mark by the other person is taken to be use of the trade mark by the predecessor in title (see subsection 7(3) and section 8).

## **Section 42 Trade mark scandalous or its use contrary to law**

An application for the registration of a trade mark must be rejected if:

- a) the trade mark contains or consists of scandalous matter; or
- b) its use would be contrary to law.

## **Section 43 Trade mark likely to deceive or cause confusion**

An application for the registration of a trade mark in respect of particular goods or services must be rejected if, because of some connotation that the trade mark or a sign contained in the trade mark has, the use of the trade mark in relation to those goods or services would be likely to deceive or cause confusion.

## **Section 44 Identical etc. trade marks**

- 1) Subject to subsections (3) and (4), an application for the registration of a trade mark (applicant's trade mark) in respect of goods (applicant's goods) must be rejected if:
  - a) the applicant's trade mark is substantially identical with, or deceptively similar to:
    - i) a trade mark registered by another person in respect of similar goods or closely related services; or
    - ii) a trade mark whose registration in respect of similar goods or closely related services is being sought by another person; and
  - b) the priority date for the registration of the applicant's trade mark in respect of the applicant's goods is not earlier than the priority date for the registration of the other trade mark in respect of the similar goods or closely related services.

*Note 1:* For deceptively similar see section 10.

*Note 2:* For similar goods see subsection 14(1).

*Note 3:* For priority date see section 12.

*Note 4:* The regulations may provide that an application must also be rejected if the trade mark is substantially identical with, or deceptively similar to, a protected international trade mark or a trade mark for which there is a request to extend international registration to Australia: see Part 17A.

- 2) Subject to subsections (3) and (4), an application for the registration of a trade mark (applicant's trade mark) in respect of services (applicant's services) must be rejected if:
  - a) it is substantially identical with, or deceptively similar to:
    - i) a trade mark registered by another person in respect of similar services or closely related goods; or
    - ii) a trade mark whose registration in respect of similar services or closely related goods is being sought by another person; and
  - b) the priority date for the registration of the applicant's trade mark in respect of the applicant's services is not earlier than the priority date for the registration of the other trade mark in respect of the similar services or closely related goods.
  - c) *Note 1:* For deceptively similar see section 10.
  - d) *Note 2:* For similar services see subsection 14(2).
  - e) *Note 3:* For priority date see section 12.
  - f) *Note 4:* The regulations may provide that an application must also be rejected if the trade mark is substantially identical with, or deceptively similar to, a protected international trade mark or a trade mark for which there is a request to extend international registration to Australia: see Part 17A.

- 3) If the Registrar in either case is satisfied:
  - a) that there has been honest concurrent use of the 2 trade marks; or
  - b) that, because of other circumstances, it is proper to do so;the Registrar may accept the application for the registration of the applicant's trade mark subject to any conditions or limitations that the Registrar thinks fit to impose. If the applicant's trade mark has been used only in a particular area, the limitations may include that the use of the trade mark is to be restricted to that particular area.

*Note:* For limitations see section 6.

- 4) If the Registrar in either case is satisfied that the applicant, or the applicant and the predecessor in title of the applicant, have continuously used the applicant's trade mark for a period:

- a) beginning before the priority date for the registration of the other trade mark in respect of:
    - i) the similar goods or closely related services; or
    - ii) the similar services or closely related goods; and
  - b) ending on the priority date for the registration of the applicant's trade mark;
- the Registrar may not reject the application because of the existence of the other trade mark.

*Note 1:* An authorised use of the trade mark by a person is taken to be a use of the trade mark by the owner of the trade mark (see subsection 7(3)).

*Note 2:* For predecessor in title see section 6.

*Note 3:* For priority date see section 12.

### **Regulation 17A.13 Use of trade mark**

- 1) The holder of an IRDA:
  - a) must be using, or must intend to use, the trade mark that is the subject of the IRDA in relation to the goods, services or goods and services listed in the IRDA; or
  - b) must have authorised, or intend to authorise, another person to use the trade mark in relation to those goods, services or goods and services; or
  - c) must intend to assign the trade mark to a body corporate that is about to be constituted with a view to the use by the body corporate of the trade mark in relation to the goods, services or goods and services.
- 2) If there is reason to suspect that the holder does not meet a requirement of subregulation (1) in relation to any of the goods or services mentioned in the IRDA, the Registrar may require the holder to make a declaration to the Registrar that those provisions apply to all of those goods and services.

### **Regulation 4.15 Trade marks containing etc certain signs**

For the purposes of paragraph 39 (2) (a) of the Act (which deals with signs), the following signs are prescribed:

- a) the words "Patent", "Patented", "By Royal Letters Patent", "Registered", "Registered Design", "Copyright", "Plant Breeder's Rights", "EL rights", or words or symbols to the same effect (including the symbols © and ®);
- b) the words "To counterfeit this is a forgery", or words to the same effect;
- c) a representation of the Arms, or of a flag or seal, of the Commonwealth or of a State or Territory;
- d) a representation of the Arms or emblem of a city or town in Australia or of a public authority or public institution in Australia;
- e) a representation of a mark notified by the International Union for the Protection of Industrial Property as not entitled to registration under international arrangements;
- f) a sign specified in Schedule 2.

*Note 1:* For the meaning of EL rights, see section 5 of the Circuit Layouts Act 1989.

*Note 2:* A list of the marks mentioned in paragraph 4.15 (e) is available at the Trade Marks Office and sub-offices.