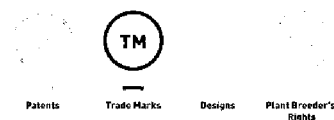




Australian Government
IP Australia

31 July 2019

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



Delivering a world leading IP system

Phone: 1300 651 010
International: +61 2 6283 2999

www.ipaustralia.gov.au

ABN: 38 113 072 755

TESLA

Australian Trade mark number: 1766128
International registration number: 1251407
Your reference: -
Holder name: Internet group d.o.o.
Opponent name: Tesla, Inc.
Dispute: Opposition to extension of protection

Madrid Agreement and Protocol

Notification of provisional refusal of protection based on an opposition Rule 17(1) to 17(3)

We advise that following receipt of a Notice of Opposition to the above Trade Mark on 12 April 2019, 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 ABOUT NOTICE OF INTENTION TO DEFEND

The holder has ONE MONTH from the date of this notification to file a notice of intention to defend with IP Australia. The holder must provide an address for service in Australia or New Zealand. IP Australia will give a copy of the notice of intention to defend to the opponent.

If a notice of intention to defend is not filed, the opposition will be taken to be successful and the international registration designating Australia (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 OR NEW ZEALAND: *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 or New Zealand.

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 or New Zealand.

Yours sincerely,

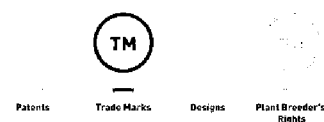
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TESLA

Australian Trade mark number: 1766128
International registration number: 1251407
Your reference: -
Holder name: Internet group d.o.o.
Opponent name: Tesla, Inc.
Dispute: Opposition to extension of protection

**Madrid Agreement and Protocol
Information in accordance with Rule 16(1)(b)**

In compliance with Rule 16(1)(b) we now advise that the opposition period to the above trade mark began on 13 February 2019 and ended on 13 July 2019.

Yours sincerely,

IP Australia

Trade mark details:

Trade mark: TESLA
Class(es): 9
Status: Registered
Filed on: 23 September 2014
Property type: Word
Entered on register: 10 August 2016
Registered from: 23 September 2014

Owner Details

Owner name: Global Electrical Supplies Pty Limited
ACN/ARBN: 165515257
Owner address: 4-8 Ferndell St
GRANVILLE NSW 2142
Australia

Representative details:

Representative name: Pizeys Patent and Trade Mark Attorneys Pty Ltd
Representative address: GPO Box 1374
QLD 4001
Australia

Goods and services:

Class: 9 Apparatus for connecting electrical circuit components; apparatus for controlling the supply of electrical current; apparatus for electrical safety protection; apparatus for protecting computers from electrical power supply faults; apparatus for the control of power supply to electrically driven motors; ballasts for electrical lighting fittings; blanking plates adapted for electrical connections; cable glands for use with electrical apparatus; cable reels (non-mechanical) incorporating electrical sockets; components for over-voltage protection for electrical apparatus; connectors being electrical terminals; ducts for electrical wiring; electrical apparatus for controlling the speed of motors; electrical apparatus for converting alternating current to direct current; electrical cable; electrical cable connectors; electrical cables for connecting computers; electrical circuit breakers; electrical circuit components; electrical circuit control devices; electrical communication apparatus for transmitting data; electrical communications cables; electrical components; electrical components for use with television aerials; electrical conduits; electrical

connection insulation apparatus; electrical connectors; electrical connectors for connecting laptop computers to telephone lines; electrical contact separating devices; electrical contacts; electrical control apparatus; electrical controlling apparatus for motors; electrical controls; electrical converters; electrical couplings; electrical distribution boxes; electrical ducts; electrical enclosures made from sheet steel; electrical extension leads; electrical frequency converters; electrical indicating devices; electrical junction boxes; electrical leads; electrical mains wiring apparatus for use with domestic appliances; electrical plug connectors; electrical plugs; electrical power adaptors; electrical push button panels; electrical push button switch assemblies; electrical push button switches; electrical push buttons being luminous; electrical push switches; electrical relays; electrical sensors; electrical socket outlets protected by residual current devices; electrical sockets; electrical supply units (other than generators); electrical surge arrestors; electrical switch assemblies; electrical switch boards; electrical switch boxes; electrical switch cabinets; electrical switch timers; electrical switches; electrical switchgear; electrical terminal connectors; electrical terminals; electrical tracks for lights; electrical transformers; electrical transformers for use with lighting; electrically conductive metal components for use as earthing; electricity boxes for electrical installations; extensions insulated electrical wires in cord form; female connectors for electrical cables; flexible electrical conductors; flexible electrical conduits; holders for electrical components; indicator lamps showing activation of electrical apparatus; industrial contactor starters (electrical); insulating plates for electrical components; joining units (electrical contacts); junction boxes for electrical circuits; male connectors for electrical cables; markers for electrical conductors; mounting boards for electrical components; noise suppressors (electrical components); plastic housings adapted for electrical apparatus; plug-in electrical connectors; power distribution apparatus for use in electrical systems; power distributors (electrical); power units for supplying (other than generating) electrical current; sockets (electrical); sockets for electric plugs for use on domestic electrical apparatus; speed regulators (electrical); terminal boxes (electrical); wall plates adapted for electrical components; wall plates for electrical components; wall plates for electrical connections

Other trade mark information:

Other trade mark information: Evidence and/or other circumstances provided under subsection 41(4).

Trade mark details:

Trade mark: TESLA PROFESSIONAL
Class(es): 7, 11
Status: Registered
Filed on: 7 May 2015
Property type: Word
Entered on register: 27 January 2016
Registered from: 7 May 2015

Owner Details

Owner name: Eco Laundry Room (No.1) Pty Ltd as trustee for Eco Laundry Room I.P (No.1) Unit Trust
ACN/ARBN: 605406611
Owner address: 22 Harrington Sq
ALTONA VIC 3018
Australia

Representative details:

Representative name: Eco Laundry Room (No.1) Pty Ltd (ACN/ARBN: 605 406 611) as Trustee for The Eco Laundry Room I.P. (No.1) Unit Trust
Representative address: 22 Harrington Sq
VIC 3018
Australia

Goods and services:

Class: 7 Coin-operated spin drying machines for laundry use; Dry cleaning (laundry) machines; Laundry decontamination machines for removing fibres from garments; Laundry decontamination machines for removing particles from garments; Laundry folding machines; Laundry presses; Laundry washing machines; Machines for washing laundry (coin-operated); Machines for washing laundry (electric); Washing machines (laundry); Washing machines for laundry; Wringing machines for laundry; Automatic washing machines; Cloth washing machines; Clothes agitating devices for washing machines; Clothes washing machines; Coin-operated washing machines; Colour-washing machines; Combination washing and drying machines; Combined washing and drying machines; Combined washing machines and tumble driers; Domestic washing machines; Machines for washing clothing (coin-operated); Machines for washing clothing (electric); Machines for washing fabrics; Washing machines; Clothes drying (spin) machines; Industrial dry-cleaning machines; Electric kitchen knives; Spin driers (not heated); Cloth ironing machines; Cloth

(electric); Electric food mixers; Industrial food mixers (machines); Portable electric food mixers; Food processors (electric); Slicers (machines, electric); Electric coffee grinders; Grinders (machines); Vacuum cleaners; Wet and dry vacuum cleaners; Machines for drying clothes; Steam cleaners (machines); Carpet cleaning machines (electric); Industrial carpet cleaning machines; Machines for cleaning (vacuuming) carpets; Mechanical wringing apparatus for mops; Electric hand tools; Electric kitchen tools; Electric power tools; Automatic dispensing (vending) machines; Automatic dispensing (vending) machines for visiting cards; Automatic vending machines; Beverage dispensing (vending) apparatus; Coin-operated vending machines; Electronic machines for dispensing (vending) beverages; Electronic machines for dispensing (vending) snacks; Liquid dispensing (vending) apparatus; Machines for dispensing (vending) liquids; Vending machines; Hand held cordless power tools; Power tools; Compressors for refrigerators; Industrial washing machines; Washing machines incorporating drying facilities; Washing machines incorporating tumble driers; Cloth spin-dryers; Ironing machines for clothing; Machines for airing clothes; Tumble dryers; Mangles; Domestic blenders (electric); Domestic ironing machines; Domestic vacuum cleaners; Electric domestic machines for washing; Automatic dispensing machines; Automatic distribution (vending) machines; Automatic industrial machines; Industrial cleaning machines (vacuum cleaners); Vacuum cleaner bags; Battery operated lint removers; Battery operated spraying machines; Dispensing machines for soap

Class: 11

Appliances for cooking; Domestic cooking appliances (electric); Electrical appliances for cooking; Electrical appliances for water supply; Gas cooking appliances; Domestic ovens; Gas ovens; Industrial ovens; Microwave ovens (cooking apparatus); Microwave ovens for domestic use; Microwave ovens for industrial purposes; Sandwich makers (toasters); Toasters; Electric kettles; Electric coffee machines; Espresso coffee machines; Cookers; Domestic gas cookers; Domestic stoves; Apparatus for water heating; Heating boilers

Trade mark details:

Class(es): 7, 11
Status: Registered
Filed on: 31 January 2016
Property type: Fancy
Entered on register: 31 August 2016
Registered from: 31 January 2016

Owner Details

Owner name: Eco Laundry Room (No.1) Pty Ltd as trustee for The Eco Laundry Room I.P. (No.1) Unit Trust
ACN/ARBN: 605406611
Owner address: 22 Harrington Sq
ALTONA VIC 3018
Australia

Representative details:

Representative name: Eco Laundry Room (No.1) Pty Ltd (ACN/ARBN: 605 406 611) as Trustee for The Eco Laundry Room I.P. (No.1) Unit Trust
Representative address: 22 Harrington Sq
VIC 3018
Australia

Goods and services:

Class: 7 Coin-operated spin drying machines for laundry use; Laundry decontamination machines for removing fibres from garments; Laundry decontamination machines for removing particles from garments; Dry cleaning (laundry) machines; Laundry folding machines; Laundry presses; Laundry washing machines; Machines for washing laundry (coin-operated); Machines for washing laundry (electric); Washing machines (laundry); Washing machines for laundry; Wringing machines for laundry; Automatic washing machines; Cloth washing machines; Clothes agitating devices for washing machines; Clothes washing machines; Coin-operated washing machines; Colour-washing machines; Combination washing and drying machines; Combined washing and drying machines; Combined washing machines and tumble driers; Domestic washing machines; Machines for washing clothing (coin-operated); Machines for washing clothing (electric); Machines for washing fabrics; Washing machines; Clothes drying (spin) machines; Industrial dry-cleaning machines; Electric kitchen knives; Spin driers (not heated); Cloth ironing machines; Cloth ironing presses; Ironing machines; Dishwashers; Domestic food mixers

food mixers (machines); Food processors (electric); Slicers (machines, electric); Electric coffee grinders; Grinders (machines); Vacuum cleaners; Wet and dry vacuum cleaners; Machines for drying clothes; Steam cleaners (machines); Carpet cleaning machines (electric); Industrial carpet cleaning machines; Machines for cleaning (vacuuming) carpets; Mechanical wringing apparatus for mops; Electric hand tools; Electric kitchen tools; Electric power tools; Automatic dispensing (vending) machines; Automatic dispensing (vending) machines for visiting cards; Automatic vending machines; Beverage dispensing (vending) apparatus; Coin-operated vending machines; Electronic machines for dispensing (vending) beverages; Electronic machines for dispensing (vending) snacks; Liquid dispensing (vending) apparatus; Machines for dispensing (vending) liquids; Vending machines; Hand held cordless power tools; Power tools; Compressors for refrigerators; Industrial washing machines; Washing machines incorporating drying facilities; Washing machines incorporating tumble driers; Cloth spin-dryers; Ironing machines for clothing; Machines for airing clothes; Tumble dryers; Mangles; Domestic blenders (electric); Domestic ironing machines; Domestic vacuum cleaners; Electric domestic machines for washing; Automatic dispensing machines; Automatic distribution (vending) machines; Automatic industrial machines; Industrial cleaning machines (vacuum cleaners); Vacuum cleaner bags; Battery operated lint removers; Battery operated spraying machines; Dispensing machines for soap; Electric carpet vacuum cleaners; Electric vacuum cleaners; Wet vacuum cleaners; Electric pressing irons for industrial purposes

Class: 11

Appliances for cooking; Cooking ovens; Domestic cooking appliances (electric); Electrical appliances for cooking; Gas cooking appliances; Microwave ovens (cooking apparatus); Electrical appliances for water supply; Domestic ovens; Gas ovens; Industrial ovens; Microwave ovens for domestic use; Microwave ovens for industrial purposes; Sandwich makers (toasters); Toasters; Electric kettles; Espresso coffee machines; Cookers; Domestic gas cookers; Domestic stoves; Apparatus for water heating; Heating boilers; Appliances for heating; Appliances for water filtration (other than machines); Domestic appliances for refrigerating; Hair drying appliances; Refrigerating appliances; Steam cleaners being electrical appliances; Sterilising appliances; Water mixing appliances; Combinations of refrigerators and freezers; Fridge-freezers; Machines for making ice cream (refrigerators or freezers); Baking ovens; Commercial ovens for baking food; Convection ovens; Kitchen ranges (ovens); Microwave ovens, not for experimental purposes; Table top ovens

Trade mark image:

Trade mark details:

Trade mark: TESLA
Class(es): 9, 36, 37, 42
Status: Published
Filed on: 11 August 2015
Property type: Word

Applicant Details

Applicant name: Tesla, Inc. a Delaware corporation
Applicant address: 3500 Deer Creek Road
Palo Alto, CA 94304
United States of America

Representative details:

Representative name: Davies Collison Cave Pty Ltd
Representative address: Level 14
255 Elizabeth Street
NSW 2000
Australia

Goods and services:

Class: 9 Electric battery system and equipment for storage and supply of electricity to entire dwellings, buildings, and man-made fixtures; electric battery system and equipment for use in the storage, supply, transmission and stabilization of electricity supplied by or to an electric power grid or other source of electric power generation; computer software for monitoring, optimizing and regulating the storage, transmission and discharge of energy to and from such electric battery systems

Class: 36 Leasing services relating to electric battery systems for the storage, discharge, supply, transmission and stabilization of electricity; financing services relating to electric battery systems for the storage, discharge, supply, transmission and stabilization of electricity

Class: 37 Installation, integration, maintenance and repair and upgrading of electric battery systems, and consulting related thereto, for the storage, discharge, supply, transmission and stabilization of electricity

Class: 42 Monitoring of electric battery systems for storing and supplying electricity; operating, maintaining, optimizing and regulating electric battery systems for storage, discharge, supply, transmission and stabilization of electricity, and consulting services related thereto

Convention details

Convention date:	11 February 2015
Trade mark number:	86/532390
Country:	United States Of America
Class: 36	{NULL}
Class: 37	{NULL}
Class: 9	{NULL}
Class: 42	{NULL}

Trade mark details:

Class(es): 9, 36, 37, 42
Status: Published
Filed on: 11 August 2015
Property type: Fancy

Applicant Details

Applicant name: Tesla, Inc. a Delaware corporation
Applicant address: 3500 Deer Creek Road
Palo Alto, CA 94304

United States of America

Representative details:

Representative name: Davies Collison Cave Pty Ltd
Representative address: Level 14
255 Elizabeth Street
NSW 2000
Australia

Goods and services:

Class: 9 Electric battery system and equipment for storage and supply of electricity to entire dwellings, buildings, and man-made fixtures; electric battery system and equipment for use in the storage, supply, transmission and stabilization of electricity supplied by or to an electric power grid or other source of electric power generation; computer software for monitoring, optimizing and regulating the storage, transmission and discharge of energy to and from such electric battery systems

Class: 36 Leasing services relating to electric battery systems for the storage, discharge, supply, transmission and stabilization of electricity; financing services relating to electric battery systems for the storage, discharge, supply, transmission and stabilization of electricity

Class: 37 Installation, integration, maintenance and repair and upgrading of electric battery systems, and consulting related thereto, for the storage, discharge, supply, transmission and stabilization of electricity

Class: 42 Monitoring of electric battery systems for storing and supplying electricity; operating, maintaining, optimizing and regulating electric battery systems for storage, discharge, supply, transmission and stabilization of electricity, and consulting services related thereto

Convention date:	11 February 2015
Trade mark number:	86/532393
Country:	United States Of America
Class: 36	{NULL}
Class: 37	{NULL}
Class: 9	{NULL}
Class: 42	{NULL}

Trade mark image:

The Tesla logo, consisting of the word "TESLA" in a stylized, bold, sans-serif font. The letters are black and have a distinctive design where the 'E' and 'S' have horizontal bars that extend to the right, and the 'L' and 'A' have horizontal bars that extend to the left.

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.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

- (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 holder of the IRDA.

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 holder of the IRDA.

- (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 holder of the IRDA.
- (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 or New Zealand 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 holder has notified the Registrar, in writing, of the holder's address for service in Australia or New Zealand.

(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.34HA Extension of time for filing—application

(1) A person may apply to the Registrar to extend the period for filing a notice of intention to defend.

(2) The application must be made before the end of the period of 2 months beginning on the day after the end of the period mentioned in subregulation 17A.34H(1).

(3) The application must:

- (a) be in the approved form; and
- (b) be accompanied by a declaration stating the facts and circumstances forming the basis for the grounds for making the application.

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

(4) The application may 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.

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

(1) The Registrar may grant an application under subregulation 17A.34HA(1) for an extension of time only if the Registrar is satisfied that the grounds set out in the application justify the extension.

(2) However, if the application is made after the period mentioned in subregulation 17A.34H(1) 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 application.

(3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

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

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) The holder of an IRDA may request the Registrar to hold a hearing if:

(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 holder of the IRDA 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 NO. 1766128

DETAILS OF PERSON INTENDING TO OPPOSE

Opponent: Tesla, Inc., of 9201 Arboretum Parkway, Richmond Virginia 23236, United States of America

gives Notice of Intention to Oppose registration/protection of the following trade mark:

Application No.: 1766128

Trade Mark:

TESLA

Applicant: Internet group d.o.o., of Savski nasip 7, 11070 Beograd, Republic of Serbia

Opponent's Address for Service is:

SHELSTON IP PTY LTD
60 Margaret Street
SYDNEY NSW 2000
Attorney Code: SW

Telephone No: (02) 9777 1111
Email: email@ShelstonIP.com

DATED this 12th day of April 2019

Tesla, Inc.

To: The Registrar of Trade Marks
WODEN ACT 2606



Sean McManis
Legal Practitioner

Fee: \$250

File: 102289AUQ00

Trade Marks Act 1995
STATEMENT OF GROUNDS AND PARTICULARS
OPPOSITION TO TRADE MARK APPLICATION NO. 1766128

Rectified under
Reg. 17A.34B

DETAILS OF PERSON OPPOSING

Opponent : Tesla, Inc., of 9201 Arboretum Parkway, Richmond Virginia 23236, United States of America

Opposition to Registration/Protection of Trade Mark:

Application No.: 1766128 (IR 1251407)

Trade Mark:

TESLA

Applicant : Internet group d.o.o., of Savski nasip 7, 11070 Beograd, Republic of Serbia

THE GROUNDS OF OPPOSITION AND PARTICULARS ARE ATTACHED

Opponent's Address for Service is:

SHELSTON IP PTY LTD
60 Margaret Street
SYDNEY NSW 2000

Attorney Code: SW

Telephone No: (02) 9777 1111
Email: email@ShelstonIP.com

DATED this 13th day of May 2019

Tesla, Inc.

To: The Registrar of Trade Marks
WODEN ACT 2606



Sean McManis
Legal Practitioner

File: 102289AUQ00

GROUND OFS OF OPPOSITION AND PARTICULARS
OPPOSITION TO AUSTRALIAN TRADE MARK APPLICATION NO.1766128

1. **(Section 44/Regulation 4.15A) Substantially identical/deceptively similar trade marks**

Particulars

- Trade Mark Registration No. 1648569 TESLA in class 9
- Trade Mark Registration No. 1692414 TESLA PROFESSIONAL in classes 7 and 11
- Trade Mark Registration No. 1749293 TESLA PROFESSIONAL (stylised) in classes 7 and 11
- Trade Mark Application No. 1713420 TESLA in classes 9, 36, 37 and 42
- Trade Mark Application No. 1713421 TESLA (stylised) in classes 9, 36, 37 and 42

2. **(Section 58) Applicant not the owner of the trade mark**

Particulars

The opponent has used the TESLA trade mark in Australia since at least as early as October 2014, in relation to computer software concerning the modelling and forecasting of market, business and consumer energy requirements, related risk analysis and the optimisation of energy usage. The opposed trade mark is substantially identical to the trade mark TESLA and the application covers software of the same kind as software in respect of which the opponent used the TESLA trade mark in Australia before use or application for registration of the opposed mark by the applicant. As a consequence, in respect of certain goods covered by the opposed application, the opponent is entitled to ownership of the trade mark applied for.

3. **(Section 60) Trade mark is similar to a trade mark which has acquired a reputation in Australia**

Particulars

Use of the TESLA trade mark by the opponent and related entities commenced in Europe around 1992.

Since that time, the opponent and related entities have used the TESLA trade mark in relation to a range of goods and services, including computer software concerning, and services associated with, the modelling and forecasting of market, business and consumer energy requirements, related risk analysis, and the optimisation of energy usage.

The opponent and related entities have extensively used the TESLA trade mark since 1992 for their goods and services, including via the internet, in various countries including the USA, England, Europe, Australia and New Zealand.

The opponent and related entities have been working on and developing goods and services for the Australian market since at least as early as January 2007.

In 2010, TESLA Asia-Pacific Ltd was incorporated and the activities of the opponent and its related businesses extended to the Asia-Pacific region.

Since at least as early as October 2014, the opponent and its related entities have made continuous use of the TESLA trade mark in Australia in relation to the computer software and services described above.

The opponent has maintained and continues to maintain a business presence with New Zealand offices that have continuously served Australian and New Zealand customers.

As a consequence of use of the TESLA trade mark internationally since around 1992 and in Australia since at least October 2014, the opponent had a significant reputation in the TESLA trade mark in Australia as at the filing date of the opposed application, namely 25 December 2015. As a consequence of this reputation in the TESLA trade mark in Australia, use of the opposed trade mark in relation to the range of goods covered by the opposed application, including the range of software covered by the opposed application, would be likely to deceive or cause confusion.

4. **(Section 59) Applicant not intending to use the trade mark**

**Rectified under
Reg.17A.34B see
attachment**

Particulars

Online searches have failed to disclose use of the opposed trade mark in Australia by the applicant in relation to the range of goods for which registration is sought, or other trade in relation to the full range of goods for which registration has been sought. This raises a presumption that the applicant does not intend to use the opposed trade mark in relation to all or some of the goods for which registration has been sought.



Attachment

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ABN 23 608 104 070

4 July 2019

Our Ref: 102289AUQ00

Contact:

Sean McManis

The Registrar of Trade Marks
IP Australia
PO Box 200
WODEN ACT 2606

Dear Registrar

Australian Trade Mark Application No. 1766128
Internet group d.o.o.
- and -
Opposition by: Tesla, Inc.
Mark: TESLA (stylised) in Classes 09,11

We refer to the official letter of 20 June 2019 concerning the Statement of Grounds and Particulars.

The particulars specified in the s59 ground presently read:

Online searches have failed to disclose use of the opposed trade mark in Australia by the applicant in relation to the range of goods for which registration is sought, or other trade in relation to the full range of goods for which registration has been sought. This raises a presumption that the applicant does not intend to use the opposed mark in relation to some or all of the goods for which registration has been sought.

The application seeks registration for:

Class 9: 3D spectacles; anti-glare visors; anti-glare glasses; software (recorded programs) not for use in connection with vehicles or energy storage systems; recorded computer programs not for use in vehicles and power storage systems; computer programs (downloadable software) not for use in connection with vehicles or energy storage systems; downloadable computer software applications not for use in connection with vehicles or energy storage systems; downloadable ringtones for mobile telephones; eyeglass frames

Class 11: Air dehumidifiers; cooling installations and machines; cooling apparatus and installations; cooling installations for liquids; refrigerating apparatus and installations; air deodorizing apparatus; air filtering installations; air-purifying apparatus and machines; air sterilizers; humidifiers for central heating radiators; ventilation hoods not for use in connection with vehicles or energy storage systems.

Online investigations are failed to disclose any trade in Australia by the applicant.

Further, online investigations found use of what appears to be a substantially identical mark on the tesla.info website, which contains no references to the applicant but has a copyright notice referring to Comtrade Group. Further, no trade in software was identified on that website.

As regards the importance of correct identification of the applicant, we refer to the decision of the full Federal Court in *Pham Global Pty Ltd v Insight Clinical Imaging Pty Ltd* [2017] FCAFC 83. In that decision, the court explained at paragraph 32:

*Once it is understood that the legislative scheme operates in the context of established principle that the alternative sources of ownership of a trade mark are authorship and use before filing an application for registration or the combination of authorship, filing of an application for registration and an intention to use or authorise use, the relationship between s 27 and ss 58 and 59 of the 1995 Act becomes apparent. The grounds of opposition in ss 58 and 59 reflect the requirements of s 27. Only a person claiming to be an owner may apply for registration. That claim may be justified at the time the application is made based on either alternative source of ownership. **But if the claim is not justified at that time, ss 58 and/or 59 are available grounds of opposition.** Moreover, if the applicant is not the owner of the mark at the time of the filing of the application, the assignment provisions in ss 106 – 111 do not assist because they authorise the assignment of the mark and thus pre-suppose, consistent with established principle, that the applicant owns the mark.*

As indicated by the decision of the Full Federal Court, the intended use needs to be by the applicant, since if the intended use is by another business then grounds of opposition and ss58 and 59 are enlivened. In this regard, the website found is indicative of intended use by business other than the applicant

Furthermore, particularly with respect to the fact that the application seeks registration for *all* software (other than software for use in connection with vehicles and energy storage systems), and investigations disclosed no Australian activity by the applicant and no current trade by the applicant in respect of such goods, having regard to the extreme breadth of the range of goods that may be described as software," we submit that this raises a presumption that the applicant does not intend to use the trade mark for all the goods covered by the application.

In support of this view, we refer the Assistant Hearing Officer to the decision in *Kowa Company Ltd v N V Organon* [2005] FCA 1282. That was .a case concerning pharmaceutical preparations and Lander J at 113-116 commented:

113 *In its application to the Registrar, the applicant sought registration of the mark LIVALO for goods in Class 5, being pharmaceutical preparations.*

114 *As will be noticed, it accepted that that that might give rise to overlap with the LIVIAL mark. That is why it sought to narrow its application as indicated in [112]. The evidence adduced before me was that the only pharmaceutical which was to be marketed under the mark LIVALO was for treatment of hyperlipidemia. Indeed, that is why the mark was coined: [16].*

115 *In those circumstances, there is no ground for registration of the mark simply as pharmaceutical preparations or as pharmaceutical preparations available only by prescription other than pharmaceutical preparations for the treatment of menopausal symptoms or for osteoporosis. The mark is not intended to be used in such a wide class.*

116 *On the evidence adduced in the applicant's own case, the mark will only be used in the class described in the respondent's alternative submission, namely, prescription pharmaceutical preparations for the treatment of hyperlipidemia.*

We respectfully submit that this supports the proposition that if an applicant applies for registration in respect of "such a wide class" there is a likelihood that it does not intend to use the trade mark for "such a wide class" because such use is both commercially and practically highly unlikely.

Similar to an application in respect of "pharmaceutical preparations" generally, an application in respect of "software" raises doubts about whether the applicant's intention justifies the scope of the application.

We further point out that the time of filing of a Statement of Grounds and Particulars is *not* a time for determination of whether a ground being argued will or will not succeed and it is not a requirement that the opponent establish at this time that the ground of opposition will be successful. Clearly, that is a matter for determination at the time of hearing once all evidence has been considered.

In the case of a ground such as intention to use, it is open to the opponent, during the course of proceedings, to apply for a Notice to Produce which, it seems to us as a matter of practicality, may well disclose evidence that the applicant's intention, like the case quoted above, is not to use the trade mark applied for in respect of all the software covered by the application. It might disclose no intended use, or might disclose a specific use which, consistent with the cases quoted above, justifies refusal or restriction of the application.

As the Assistant Hearing Officer will appreciate, if a ground of opposition is removed, it is very unlikely that, even if strong evidence to support the ground subsequently becomes available, it can be added to the opposition. Consequently, removing the relevant ground from the current opposition would effectively be deciding that issue, which would be prejudicial to the opponent.

In the circumstances, we submit that there is more than adequate justification for allowing the ground of opposition to remain.

Should the Assistant Hearing Officer required to be amended it could be amended to read:

Online searches have failed to disclose use of the opposed trade mark in Australia or any other trade by the applicant in Australia.

Online searches have failed to disclose any use of the trade mark applied for by the applicant.

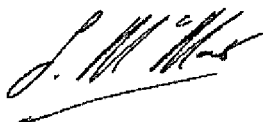
An international website was found, which displays a sign substantially identical or deceptively similar to the mark for which registration is sought, in relation to certain goods. However, that website contains no reference to the applicant but references a different entity called Comtrade Group. It also disclosed no trade or likely trade in software.

The application seeks registration for a very broad range of goods, in particular, the application seeks registration for all types of software, excluding software for use on vehicles and energy storage systems. The full range of software for which registration is sought is unlikely to be traded by any company.

The combination of factors mentioned above, namely the failure of investigations to find any trade in Australia by the applicant, the failure of investigations to find any use of the trade mark by the applicant, the finding of a website bearing a mark substantially identical or deceptively similar to the mark applied for that references a different entity and the absence of any use or any likelihood of the opposed trade mark being used in relation to all software, is sufficient to give rise to a serious question for determination as to whether the applicant has the intention to use the trade mark that is required under s59 Trade Marks Act 1995 in relation to some or all of the goods for which registration has been sought.

We request retention of s59 ground of opposition.

Yours respectfully
Shelston IP



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