



14 January 2020

International Bureau, WIPO
34, chemin des Colombettes
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SWITZERLAND



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sama
GLAS

Australian Trade mark number: 2001113
International registration number: 1459845
Your reference: -
Holder name: GUANGDONG SHANGMING INDUSTRIAL CO., LTD.
Opponent name: SAHM GMBH & Co KG
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 9 October 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,

IP Australia

Trade mark details:

International registration number:	545507
Trade mark:	SAHM
Class(es):	21, 34, 40, 42
Status:	Protected
Filed on:	17 March 2012
Property type:	Word
Entered on register:	8 January 2013
Registered from:	17 March 2012

Owner Details

Owner name:	SAHM GMBH & Co KG
Owner address:	Westerwaldstrasse 13 56203 HOHR-GRENZHAUSEN Germany

Representative details:

Representative name:	Herbert Smith Freehills
Representative address:	Level 43 101 Collins St VIC 3000 Australia

Goods and services:

Class: 21	Utility and decorative objects made of earthenware, ceramic, porcelain, glass and tin for household and industrial use (for gastronomy), especially drinking vessels such as glasses, jugs, beer mugs, tankards, tumblers, beakers, goblets, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses
Class: 34	Ashtrays
Class: 40	Services for perfecting glassware, porcelain and earthenware, especially engraving, cutting, etching, printing, inscribing, painting
Class: 42	Silkscreen printing

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
- (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 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.

(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 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
- (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) The holder of an IRDA 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 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.

IP AUSTRALIA
Trade Marks Act 1995

NOTICE OF INTENTION TO OPPOSE

Trade Mark No. **2001113**
International Reg No. **1459845**
Mark: **SAMA GLAS**
In the name of **Guangdong Shangming Industrial Co., Ltd**

Details of person opposing:

Name: **Sahm GmbH & Co KG**
Address: **Westerwaldstrasse 13**
56203 Höhr-Grenzhausen
Germany

Our address for service in Australia: Watermark Intellectual Property Pty Ltd, Level 28, 100 Miller Street, North Sydney NSW 2060, Australia, tel (02) 8874 0400, fax (02) 9888 7600.
Our Ref: OT2948AU00.

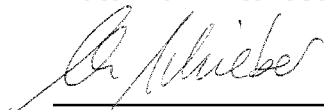
Email address for sharing of evidence and documents: IPAU.Trademarks@watermark.com.au

Part 2: Type of Opposition Proceeding

Opposition to:

- ☒ Registration of the above trade mark/Protection of the above International Registration Designating Australia (IRDA)
- ☐ Removal of the above trade mark / Cessation of protection of the above international trade mark for non-use

Sahm GmbH & Co KG
By our Patent and Trade Marks Attorneys
Watermark Intellectual Property Pty Ltd



Christian Schieber
Registered Trade Marks Attorney

Date: 9 October 2019

IP AUSTRALIA
Trade Marks Act 1995

STATEMENT OF GROUNDS AND PARTICULARS

Trade Mark No. 2001113
 International Reg No. 1459845
 Mark: sama GLAS (stylised)
 ('opposed trade mark')
 In the name of Guangdong Shangming Industrial Co., Ltd
 Unit 401, 402, Floor 4, Building 3
 Phase 2, Standard Industrial Unit
 No. 7 Spiral 4th Road, International Biological Island
 Guangzhou
 China

Details of person opposing:

Name: **Sahm GmbH & Co KG**
 Address: **Westerwaldstrasse 13**
 56203 Höhr-Grenzhausen
 Germany

Our address for service in Australia: Watermark Intellectual Property Pty Ltd, Lvl 1, 109
 Burwood Road, Hawthorn VIC 3122, Australia, tel (03) 9819 1664, fax (03) 9819 6010
 Email: IPAU.Trademarks@watermark.com.au. Our Ref: OT2948AU00.

Type of Opposition Proceeding

Opposition to:

- ☒ Registration of the above trade mark/Protection of the above International Registration
 Designating Australia (IRDA)
- ☐ Removal of the above trade mark / Cessation of protection of the above international
 trade mark for non-use (not applicable)

Grounds and Particulars (Opposition to Registration / Protection)

- ☐ 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 need to use the trade mark in the ordinary course of
 trade in respect of similar goods/services to those of the application.

Not Applicable

☒ 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.

The opposed trade mark 'sama GLAS' (Application no. 2001113) is substantially identical with and/or deceptively similar to the Opponent's trade mark SAHM (Registration no. 1492433).

The Opponent's Registration no. 1492433 has an earlier priority date than Application no. 2001113, and is registered in relation to identical, similar or related goods and/or services such as:

Class 21

Daily glassware [including cups, plates, pots, cylinders]; kitchen utensils; drinking vessels; daily porcelain [including pots, bowls, plates, pots, jars, cans]; daily pottery [including pots, bowls, plates, jars, pots, casseroles, pots, pottery utensils]; works of art of porcelain, ceramic, earthenware, terra-cotta or glass; enamelled glass, not for building; bottles; cleaning instruments, hand-operated; coffee percolators, non-electric.

Class 40

Services for perfecting glassware, porcelain and earthenware, especially engraving, cutting, etching, printing, inscribing, painting

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

Particulars should include: trade mark number of the earlier trade mark on the basis of which the opposed trade mark was accepted under subsection 44(4) or sub regulation 4.15(5), date of first use of the earlier trade mark and whether the use has been continuous.

Not Applicable

☐ Applicant is 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, date (or year) of first use.

Not Applicable

☒ 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), trade mark number if applicable, goods and/or services in respect of which the trade mark is used and date (or year) of first use.

The Opponent refers to and repeats the particulars in relation to grounds under s 44.

The Opponent has acquired a reputation in Australia in SAHM before the priority date of the opposed trade mark, which it has registered, and which it has used since at least May 2012 in connection with goods and/or services in classes 21 and 40 including:

Utility and decorative objects made of earthenware, ceramic, porcelain, glass and tin for household and industrial use (for gastronomy), especially drinking vessels such as glasses, jugs, beer mugs, tankards, tumblers, beakers, goblets, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses

The Opponent's trade mark has established a reputation and recognition amongst consumers. As a consequence, use of the opposed trade mark is likely to deceive or cause confusion amongst consumers.

☐ Trade mark is scandalous or contrary to law – **Section 42**

Particulars should include: s42(a) – why the trade mark is scandalous; s42(b) – why the trade mark is contrary to law.

Not Applicable

☐ 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 it is likely to deceive or cause confusion.

Not Applicable

☐ 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.

Not Applicable

☐ Application made in bad faith – **Section 62A**

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

Not Applicable

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

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

Not Applicable

☐ 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.

Not Applicable

☐ 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.

Not Applicable

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

Particulars should include: why the trade mark would not distinguish the goods certified by the applicant from those that are not so certified.

Not Applicable

☐ Registration of a trade mark as a defensive trade mark – **Section 187**

Particulars should include: whether you consider that a connection is unlikely between the goods/services of the defensive application and the registered owner.

Not Applicable

Application for an Award of Costs

☒ I wish to apply for an award of costs.

Sahm GmbH & Co KG
By our Patent and Trade Marks Attorneys
Watermark Intellectual Property Pty Ltd



Kim Nicholson
Registered Trade Marks Attorney

Date: 11 November 2019