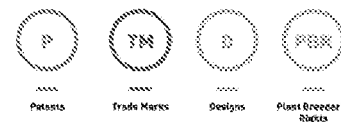




7 July 2020



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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: 1518695
Australian Trade mark Number: 2073646
Trade mark: POD
Holder's name: Hyperloop Technologies, Inc.

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 **7 October 2021** 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 7 October 2021.

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 **David White** who can be contacted on **+61262832997**.

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

Sincerely,

IP Australia

IP Australia recognises that many of our customers may be struggling with the impacts of COVID-19. We remain open for business and our staff are working from home to ensure that our services can continue. We are committed to supporting you and we are here to help you through these difficult times. We have put in place a streamlined process for extension of time requests and associated fee waivers or refunds to assist customers impacted by the COVID-19 outbreak. Please visit our website (www.ipaustralia.gov.au) for guidance and Frequently Asked Questions (FAQs) related to your IP Right. If you would like to discuss your particular circumstances, please [contact us](#) directly. We will continue to update our website and FAQs with the latest information.

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 44 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 goods/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. This is because your trade mark is for the word POD which is defined in the Macquarie Dictionary, in part, as:

"1. a more or less elongated, two-valved seed vessel, as that of the pea or bean. 2. a dehiscent fruit or pericarp with several seeds. 3. Aeronautics a streamlined structure suspended under the wing of an aircraft for housing a jet engine, cargo, missiles, or other weapons. 4. a protective housing for a nuclear reactor. 5. a detachable or self-contained compartment on an aircraft, spacecraft, etc. 6. an office designed to be shared by a small group to encourage a collaborative work practice. 7. any discrete unit, often with rounded corners, which forms part of a larger construction."

The word POD is in common use by other traders to describe a type of vehicle (including POD vehicles that use magnetic levitation or travel in an enclosed tube as have been specifically claimed in your class 12 statement of goods). Also, these vehicles often resemble the shape of a POD. The word POD indicates that your claimed goods of vehicles/aircraft/trains/cars etc. can be described as being POD vehicles or are designed for use with a POD shaped goods or POD based transportation system.

Other traders should be able to use POD in connection with goods or services similar to yours.

The refusal applies to the following goods/services:

All the claimed goods.

What you can do now

Grounds for rejecting this International Registration Designating Australia (IRDA) exist under subsection 41(3) of the Trade Marks Act 1995.

You may respond to this refusal by:

- Making submissions and/or
- Providing evidence of use showing that, because of the extent to which you have used your trade mark in Australia before the date Australia was designated, the trade mark distinguished the specified goods/services in Australia at that date 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.

Issues raised under Section 44 of the Trade Marks Act 1995.

Cited Trade Mark Number(s): 1203519, 1313304, 1383973, 1457704, 1637007, 1676053, 1793763, 1834139

What are the issues with your trade mark?

Trade Mark Number(s): 1203519, 1313304, 1383973, 1457704, 1637007, 1676053, 1793763, 1834139

Your trade mark is substantially identical with, or deceptively similar to, the following trade mark(s), and is for similar or closely related goods and/or services:

The refusal applies to the following goods/services:

All the claimed goods.

I have enclosed details of the trade marks mentioned above.

What you can do now

You may respond to this refusal by:

- Making submissions and/or

- Providing evidence of use of the trade mark 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.

Trade mark: 1203519

Trade mark details:

International registration number:	936236
Class(es):	12, 35, 37
Status:	Protected
Filed on:	3 August 2007
Property type:	Fancy
Customer description:	Trade Mark Description: Colour Claimed: RED and GREY.
Entered on register:	13 October 2008
Registered from:	3 August 2007

Owner Details

Owner name:	SAF-HOLLAND GmbH
Owner address:	Hauptstrasse 26 63856 Bessenbach Germany

Representative details:

Representative name:	Ahearn Fox
Representative address:	GPO Box 1149 QLD 4001 Australia

Goods and services:

Class: 12	Parts of vehicles in this class, namely trailer axles, trailer steering axles, lowbed trailer swing axles, lowbed trailer swing axle units, air suspension axles and air suspension units for trailers, leaf spring axles and leaf spring units for trailers, suspension systems for trailer vehicles, pusher axles and trailing axles for trailers, mechanically/manually operated devices for lifting and lowering of semitrailers and trailers; axle brake units for trailer vehicles, lowbed trailers; components and spare parts of the afore-mentioned goods, in this class
Class: 35	Presentation of goods, in particular of the afore-mentioned goods of class 12 in communication media for the retail trade; retail trade services, also via the internet with the afore-mentioned goods of class 12
Class: 37	Repair of the afore-mentioned goods of class 12

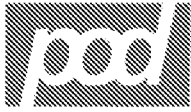
Convention details

Convention date:	9 February 2007
-------------------------	-----------------

Trade mark number: 307 09 274.7/12

Country: Germany

Trade mark image:



parts on demand

Trade mark: 1313304

Trade mark details:

Trade mark: HOVERPOD
Class(es): 12
Status: Registered
Filed on: 4 August 2009
Property type: Word
Entered on register: 11 March 2010
Registered from: 4 August 2009

Owner Details

Owner name: F1 Hoverpod Ltd
Owner address: PO Box 1040
Sheffield
England
United Kingdom

Representative details:

Representative name: John Macdonald F1 Hoverpod Racing Ltd
Representative address: PO Box 971
NSW 2042
Australia

Goods and services:

Class: 12 Motor vehicles

Trade mark: 1383973

Trade mark details:

Trade mark: LEISURE POD
Class(es): 12, 22
Status: Registered
Filed on: 16 September 2010
Property type: Word
Entered on register: 16 June 2011
Registered from: 16 September 2010

Owner Details

Owner name: ENTERPRISE 2 (2005) LIMITED
Owner address: 59 Stanmore Bay Road
Stanmore Bay
Whangaparaoa

New Zealand

Representative details:

Representative name: AJ Pietras IP Limited
Representative address: PO Box 30173
Wellington 5040
New Zealand

Goods and services:

Class: 12 Caravans, camping trailers
Class: 22 Camping shelters, tents

Trade mark: 1457704

Trade mark details:

Trade mark: snooze pod
Class(es): 12
Status: Registered
Filed on: 6 November 2011
Property type: Word
Entered on register: 05 September 2012
Registered from: 6 November 2011

Owner Details

Owner name: Eileeh Hoey Slocombe
Owner address: 1 Braemer Cournt
BENOWA QLD 4217
Australia

Representative details:

Representative name: Eileeh Hoey Slocombe
Representative address: 1 Braemer Cournt
BENOWA QLD 4217
Australia

Goods and services:

Class: 12 Apparatus for locomotion by land

Trade mark: 1637007

Trade mark details:

Trade mark: TRUCKPOD
Class(es): 12
Status: Registered
Filed on: 25 July 2014
Property type: Word
Entered on register: 17 June 2015
Registered from: 25 July 2014

Owner Details

Owner name: HIDRIVE INVESTMENTS Pty Ltd atf ACTION TRUST NO 1 AND ACTION TRUST NO 2
ACN/ARBN: 627150421
Owner address: HiDrive Investments Pty Ltd
PO BOX 158
GOULBURN NSW 2580
Australia

Representative details:

Representative name: Bison Group Pty Ltd
Representative address: PO BOX 158
NSW 2580
Australia

Goods and services:

Class: 12 Bodies for land vehicles; Storage systems adapted for use in motor vehicles

Trade mark: 1676053

Trade mark details:

Trade mark: TACKLE POD
Class(es): 12
Status: Registered
Filed on: 20 February 2015
Property type: Word
Entered on register: 22 July 2015
Registered from: 20 February 2015

Owner Details

Owner name: Aquatic Holdings Limited
Owner address: 71 Firth Street,
Matamata 3400

New Zealand

Representative details:

Representative name: James & Wells Intellectual Property
Representative address: GPO Box 1301
ACT 2601
Australia

Goods and services:

Class: 12 Kayaks; kayak-like boats; canoes; kayak paddles; deck bags for use on kayaks; stowage units for kayaks including storage containers; stowage units for kayaks including insulated storage containers; kayak equipment namely kayak hatches, bungs, rudders, handles, rigging, well covers, insulated well covers

Convention details

Convention date: 25 September 2014
Trade mark number: 1005830
Country: New Zealand
Class: 12 KAYAKS; KAYAK-LIKE BOATS; CANOES; KAYAK PADDLES; DECK BAGS FOR USE ON KAYAKS; STOWAGE UNITS FOR KAYAKS INCLUDING STORAGE CONTAINERS; STOWAGE UNITS FOR KAYAKS INCLUDING INSULATED STORAGE CONTAINERS; KAYAK EQUIPMENT NAMELY KAYAK HATCHES, BUNGS, RUDDERS, HANDLES, RIGGING, WELL COVERS, INSULATED WELL COVERS .

Trade mark: 1793763

Trade mark details:

International registration number: 1257984
Trade mark: Podbike
Class(es): 12
Status: Protected
Filed on: 20 April 2016
Property type: Word
Entered on register: 14 December 2016
Registered from: 20 April 2016

Owner Details

Owner name: ELPEDAL AS
Owner address: Forsandveien 13
N-4307 SANDNES
Norway

Representative details:

Representative name: Tom Jorgen Hansen KRANSELL & WENNBORG KB
Representative address:

Goods and services:

Class: 12 Cycles; cycle stands; motors and engines for cycles

Trade mark: 1834139

Trade mark details:

Class(es): 12
Status: Registered
Filed on: 25 March 2017
Property type: Figurative
Entered on register: 25 October 2017
Registered from: 25 March 2017

Owner Details

Owner name: Martin Krygsman
Owner address: c/o BAE Systems
Corner Anne St and Nelson Pl
WILLIAMSTOWN VIC 3016
Australia

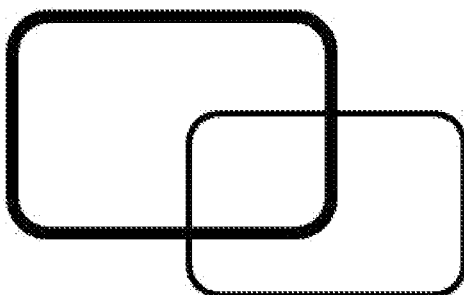
Representative details:

Representative name: Martin Krygsman
Representative address: c/o BAE Systems
Corner Anne St and Nelson Pl
WILLIAMSTOWN VIC 3016
Australia

Goods and services:

Class: 12 Vehicles in the nature of caravans; Storage systems adapted for use in motor vehicles; Camping vehicles

Trade mark image:



VAN POD

REQUIREMENTS FOR EVIDENCE OF USE

Subsection 41(3) *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(3) use **must be in Australia and must be before 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 REQUIRED

The declaration must contain:

- 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);

The declaration must also contain the following information relating to the *specific goods or services in the IRDA*:

- a history of the trade mark, including:
- the specific goods and/or services for which the trade mark has been used in Australia;
- when the trade mark was first used in Australia in connection with the specific 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 (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).

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 in Australia, and that it is recognised by consumers in Australia as a trade mark.

If you can only show use of your trade mark in Australia on some of the goods or services in your IRDA, you must agree to limit your IRDA to cover only those goods or services.

EVIDENCE OF HONEST CONCURRENT USE, PRIOR USE or OTHER CIRCUMSTANCES

Subsections 44(3) and 44(4) *Trade Marks Act 1995*

Introduction

Your International Registration Designating Australia (IRDA) cannot be accepted for protection because it conflicts with another trade mark, or trade marks.

The refusal of your IRDA under section 44 may be overcome if you can show **one** of the following:

- **honest concurrent use**; or
- **prior use**; or
- **other circumstances**

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.

The **declaration** provides the information I need to determine whether the use of your trade mark in Australia is sufficient to accept your trade mark for protection. The declaration should clearly set out the following:

- the number of your IRDA;
- the name of the holder;
- any submissions and evidence in support of your IRDA

The **declaration** should be made out by:

- you; or
- if the holder is a company, a principal officer or other authorised employee of the company (for example a director); or
- someone else who is authorised by you to make the declaration (for example, a lawyer)

Honest Concurrent Use

Evidence required – The following information should be included in the **declaration**:

- 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);
- when the trade mark was chosen (this must be **before your filing date**);

- why the trade mark was chosen;
- who has used the trade mark:
 - you or your company;
 - someone you or your company has authorised or allowed to use the trade mark; or
 - a predecessor in title (the person from whom you acquired the trade mark);
- whether you knew of the earlier filed trade mark;
- the goods and/or services for which the trade mark has been used in Australia;
- 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);
- whether this use has been continuous since then (or, if it has not been used continuously, when and for how long it has been used);
- where the trade mark has been used in Australia (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 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).

Prior Use

Evidence required – The following information should be included in the **declaration**:

- 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);
- 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;
- how the trade mark was first used. You should provide examples of how the trade mark was applied and advertised or, where these are no longer available, explain exactly what actions you claim amount to “use”. An unsupported statement such as “I first used this trade mark in 1990” is not sufficient, and you should go on to explain just what actions you rely on as being use.
- whether the trade mark has been used continuously in Australia since its first use. The declaration should provide factual information, e.g. sales value by year, that will allow an examiner to be satisfied that use has been continuous;
- whether the trade mark was still being used when you lodged your IRDA;
- the goods and/or services for which the trade mark has been used in Australia.

Other Circumstances

There may be other circumstances that are relevant. A common example would be if you were using your trade mark with the permission of the owner of the earlier filed trade mark and/or that owner is prepared to consent to the protection of your trade mark.

You should be aware

If your own IRDA is accepted under one of the above provisions, the trade mark owner of any earlier registration or application may oppose protection of your trade mark. You will then be required to defend the opposition. This will involve serving evidence. If you are not successful, costs may be awarded against you.

You should also be aware that if you are infringing a registered trade mark you run a serious risk of legal action being taken against you by the owner of that registration.

Confidential Information

IP Australia will accept your declaration in confidence. IP Australia will not accept an accompanying letter in confidence.

Please do not put any information which you consider to be confidential into an accompanying letter.

Release of Information

Other people may request access to information you have provided to the Trade Marks Office. Please take into account that **letters** will become available for public inspection (API). **Declarations** may be API. Copies of declarations may also be requested under the *Freedom of Information Act 1982* (FOI Act). If this occurs, IP Australia may seek your comments prior to release of declarations.

Legal Advice

A trade mark attorney may be able to assist you with advice and outline the likely costs, risks and benefits of the trade mark options available for your business.

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.