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29 July 2020

Your Ref: 1369000001
International Registration Number: 1515221
For the mark: CBM GINSENG
In the Name of: JILIN GINSENG ASSOCIATION
Office Reference: 2070273

Dear Sandia Stephen,

RE: NOTICE CONCERNING A NOTIFICATION OF PROVISIONAL REFUSAL

In regards to the above mentioned notice (your reference: 1369000001), please find attached a rectified notification of provisional refusal.

Please replace the earlier provisional refusal with the rectified refusal attached.

I apologise for our error.

Yours sincerely,

IP Australia



29 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: 1515221

Australian Trade mark Number: 2070273

Holder's name: JILIN GINSENG ASSOCIATION

**RECTIFIED NOTIFICATION OF PROVISIONAL REFUSAL OF AN INTERNATIONAL
REGISTRATION DESIGNATING AUSTRALIA (IRDA) RULE 18(1)(c) THE PROVISIONAL
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 **13 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 13 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 **Peter Jarvis** whose direct line is **+61262832996** and team contact point is +61262832211.

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.

- o Valid certification rules have not been supplied or approved by the ACCC.

Valid certification rules have not been supplied or approved by the ACCC.

This International Registration Designating Australia (IRDA) does not meet the requirements of Regulation 17A.50 of the Trade Marks Act 1995.

The WIPO ROMARIN database indicates that this trade mark is a collective, certification or guarantee mark. Please confirm whether or not the trade mark is a certification mark. Please note, guarantee marks are not available in Australia.

The refusal applies to the following goods:

Ginseng in class 5

What you can do now

If the trade mark is a certification trade mark, then under Regulation 17A.50 of the Trade Mark Regulations, the rules governing the use of the certification trade mark must be filed. These rules are required when the IRDA is ready for acceptance, and will be sent by the Registrar of Trade Marks to the Australian Competition and Consumer Commission (ACCC). It is in your interest, therefore, to send a copy of these rules to the Trade Marks office as soon as possible.

For more information please refer to the information sheet titled Certification trade marks on our website at <https://www.ipaustralia.gov.au/trade-marks/understanding-trade-marks/types-of-trade-marks/certification-trade-mark>.

You may respond to this refusal by:

- Making written submissions and/or
- Requesting a hearing in this matter.

If you wish to respond in any of the above 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.

INFORMATION ABOUT CERTIFICATION TRADE MARKS

The Trade Marks Act 1995 provides for the registration/protection of several different kinds of trade marks. Most trade marks are standard trade marks which are used by their owners to distinguish their goods or services in the marketplace. Registration/Protection provides a relatively simple means of protecting such trade marks from misuse by other traders and so protects a valuable business asset. Certification trade marks serve a quite different purpose.

What is a certification trade mark?

A certification trade mark may be registered/protected in respect of goods or services.

- a) When applied to goods in the course of trade, a registered/protected certification trade mark (CTM) indicates that those goods have been “certified” as meeting a particular standard of quality or accuracy, or as having a particular composition, mode of manufacture, geographical origin or some other characteristic.
- b) A CTM may also be registered/protected for use in connection with services to certify that the services provided have particular characteristics or meet specified standards of quality and accuracy.

Below are just a few of the many CTMs which are registered/protected. These marks have been registered/protected for various classes of goods, including the class which covers clothing (class 25). However, their use on articles of clothing does not tell the purchaser who made or marketed the clothing. Instead, each of these marks certifies that the articles of clothing on which it appears have particular characteristics by certifying something about the fabric from which they are made.



The first four marks, taken in order, certify the composition of the fabric is pure new wool, a wool blend, pure cotton, or a cotton blend. The next three marks show that the fabric has been certified for its ability to absorb ultra-violet radiation. The last one certifies that the fabric is Harris Tweed manufactured in the Outer Hebrides

Note: Full details of the characteristics certified by these CTMs can be found in the Rules held in the Trade Marks Office. All rules governing use of CTMs filed after 27 March 2007 will be made available on the IP Australia website.

Who certifies the goods or services?

The owner of the trade mark, or a person approved by the owner (an **approved certifier**), is responsible for ensuring that the CTM is used in accordance with the set of rules which govern its use and set the standards for certification. The owner or approved certifiers must be able to show they have the necessary expertise to test whether those standards are being met.

Who uses the certification trade mark by applying it to the goods or services?

The owner may use the CTM on goods or services, which it deals with or provides, but this is not a requirement. It is more usual that the owner allows other persons to become **approved users** of the CTM. In either case the use must be in accordance with the rules governing use of the CTM.

What are the requirements for filing a certification trade mark?

The application procedure for a CTM is the same as for an ordinary trade mark except that a copy of the rules governing the use of the CTM must also be filed. These rules should be filed when the IRDA is filed or as soon as possible after filing.

What must be contained in the rules for a certification trade mark?

The rules governing the use of a CTM must specify:

- the **certification requirements** that goods or services must meet for the CTM to be applied to them; and
- the process for determining whether goods or services meet the certification requirements; and

- the attributes that a person must have to become an **approved certifier** to assess whether goods or services meet the certification requirements; and
- the requirements that the owner of the CTM, or an approved user, must meet to use the CTM in relation to goods or services; and
- other requirements about the use of the CTM by the owner or an approved user; and
- the procedure for resolving a dispute about whether goods or services meet the certification requirements; and
- the procedure for resolving a dispute about any other issue relating to the CTM.

The rules must include any other matter the Australian Competition & Consumer Commission (ACCC) requires to be included, and may also include any other matter the ACCC permits to be included.

Once a CTM is registered/protected the rules are kept on file at the Trade Marks Office in Canberra. They are available for inspection and photocopies of the rules will be sent to people who request them.

What happens after filing a certification trade mark?

The steps following filing of a CTM are shown in the attached diagram. A CTM is examined in much the same way as an ordinary trade mark. The holder is advised if there are any grounds for rejecting the application or if there are formality matters which need attention.

However, before accepting an application for a CTM, the Registrar must first send a copy of the application and the rules, and any other relevant documents, to the Australian Competition & Consumer Commission (ACCC). Under the *Trade Marks Act 1995*, the ACCC is required to consider CTM applications before acceptance to assess whether

- the attributes of the approved certifier (determined by the owner of the CTM) are sufficient to enable competent assessment of the goods or services, and

- the rules governing use of the CTM would not be detrimental to the public, and are satisfactory in the light of certain principles in the *Trade Practices Act 1974*.

In making its assessment, the ACCC considers the rules themselves, and how effective they are in ensuring the specified standards are met, and it also considers broadly the effect the certification scheme is likely to have on the community. For example, the ACCC will consider whether use of the CTM is likely to lessen competitiveness and lead to restrictive trade practices or price fixing. The ACCC may also require additional provisions to be included in the rules.

After considering the application, the ACCC makes an initial assessment proposing to either approve or disapprove the CTM. The Registrar advertises this initial assessment in the *Official Journal of Trade Marks* and for one month after the advertisement, any person or organisation having an interest in the use of the CTM can make submissions, or seek a conference with the ACCC, before the ACCC considers its final assessment.

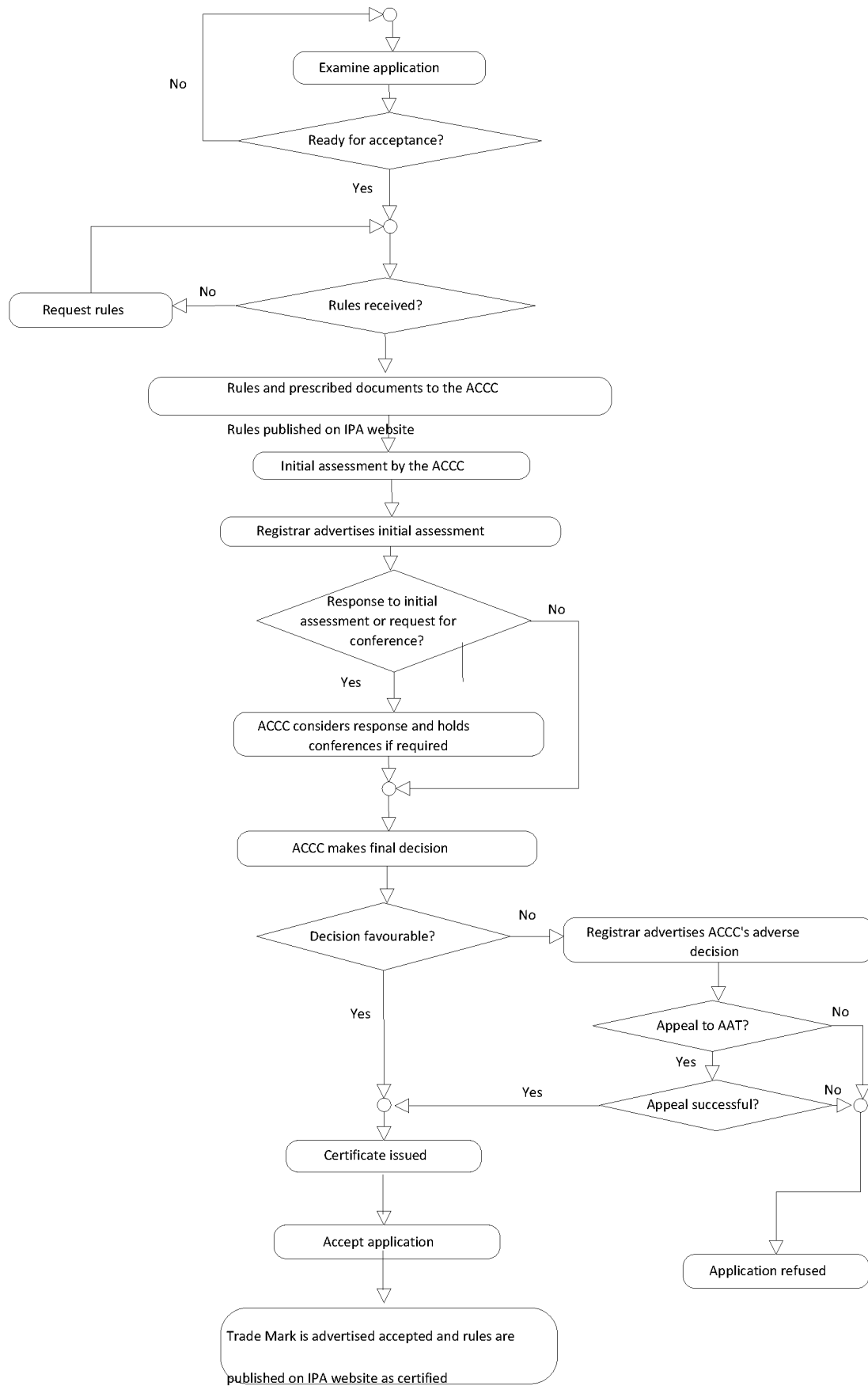
The ACCC then proceeds to make a final assessment. If the final assessment is favourable, the ACCC will issue a certificate to the holder and to the Registrar of Trade Marks who will then accept the application. The acceptance will be advertised in the usual way and, if there is no opposition, the CTM will be protected. (Should the final assessment of the ACCC be adverse, the holder may apply to the Administrative Appeals Tribunal (AAT) for a review of that decision.)

The role of the ACCC is described in more detail in a brochure "*Certification Trade Marks - role of the ACCC*" which is available from the ACCC. The brochure also outlines the steps to be taken if the owner wishes to change the rules after protection or to assign the CTM.

Who to call for more information

- IP Australia's Customer Service Network on +61 2 6283 2999
- The Australian Competition and Consumer Commission (ACCC) on 1300 302 502

What happens after filing a Certification Trade Mark?



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.