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13 January 2022

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

International registration number:	1634330
Australian Trade mark Number:	2238652
Trade mark:	PIONEER
Holder's name:	Bio-Rad Laboratories GmbH

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 Australian Designation of the International Registration 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 April 2023** 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 April 2023. For assistance with our online lodgement services please contact **1300 65 10 10.**

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 **Frances Deland** and their direct line is **+61 2 6283 2870**. If you have been unable to reach your examiner directly, another examiner who may be able to assist you can be reached on +61 2 6283 2211.

Details of the trade mark can be viewed using our Australian trade mark search on our website.

Sincerely,

IP Australia

Adverse Examination Report

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

- Issues raised under Section 41 of the Trade Marks Act 1995.
- Issues raised under Section 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/services. This is because your trade mark is, or has as its main feature, PIONEER.

The Macquarie Dictionary defines PIONEER as 2. one of those who are first or earliest in any field of inquiry, enterprise, or progress:

PIONEER is used in relation to the specified services to indicate the first to develop, use or apply a new approach or discovery in relation to the provision of these services.

Other traders should be able to use PIONEER or something very similar in connection with services similar to yours.

The refusal applies to the following goods/services:

Class 40: All services claimed

Class 42: All services claimed

What you can do now

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

You may respond to this refusal by:

- Making submissions and/or

- Providing evidence of use showing that the trade mark is capable of distinguishing the goods/services in Australia and/or

- Requesting a hearing.

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

- Evidence must be supplied as a declaration and should be accompanied by supporting evidence and information regarding the extent of the use of your trade mark in Australia.

- Gathering and compiling this evidence may be time-consuming and expensive

- The evidence you provide may be insufficient to overcome the refusal

If you wish to respond in any of these ways, you must do so in writing and supply an address for service in Australia or New Zealand. If you do not respond by the date mentioned on the first page of this report, this IRDA will be refused for the above goods/services.

Issues raised under Section 44 of the Trade Marks Act 1995.
Cited Trade Mark Number(s): 361991, 389289, 614511, 1162626, 1300132

What are the issues with your trade mark?

Trade Mark Number(s): 361991, 389289, 614511, 1162626, 1300132

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:

Class 5: All goods claimed
Class 42: Scientific and technological services, namely, scientific and technological research, analysis, inspection, quality audit, consulting, design, engineering, development and laboratory testing services for others; chemical research and development services; testing or scientific research on biotechnology and providing scientific information and research consultancy relating thereto;

I have enclosed details of the trade mark(s) 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: 361991

Trade mark details:

Trade mark:	PIONEER
Class(es):	31
Status:	Registered
Filed on:	29 June 1981
Property type:	Word
Registered from:	29 June 1981

Owner Details

Owner name:	Pioneer Hi-Bred International, Inc
Owner address:	7100 NW 62nd Avenue, PO Box 1014, Johnston, Iowa 50131-1014 United States of America

Representative details:

Representative name:	Houlihan2 Pty Ltd
Representative address:	PO Box 611 VIC 3104 Australia

Goods and services:

Class: 31	Agricultural seeds, grains and legumes for sowing and planting (not being for human consumption); natural agricultural products (not for human consumption), including living microbial cultures as feed additives for feeding animals; microbial cultures for use in fermentation of feedstuffs for animals and as feed additives and for feeding animals; all of the foregoing being goods in this class

Other trade mark information:

Other trade mark information:	The preceding endorsement(s) were recorded prior to commencement of the Trade Marks Act 1995.; It is a condition of registration that the word PIONEER willnot be used as a varietal name.

Trade mark: 389289

Trade mark details:

Class(es):	31
Status:	Registered
Filed on:	29 March 1983
Property type:	Figurative
Entered on register:	21 August 1986
Registered from:	29 March 1983

Owner Details

Owner name:	Pioneer Hi-Bred International, Inc
Owner address:	7100 NW 62nd Avenue, PO Box 1014, Johnston, Iowa 50131-1014 United States of America

Representative details:

Representative name:	Houlihan2 Pty Ltd
Representative address:	PO Box 611 VIC 3104 Australia

Goods and services:

Class: 31	Seeds and grains legumes; natural agricultural products incuding living microbial cultures as feed additives for the feeding animals; microbial cultures in this class for use in the fermentation of feed stuffs for aminals, and as feed additives mar and for feeding aminals; all being goods in this class.

Other trade mark information:

Other trade mark information:	It is a condition of registration that the blank space in the mark shall, when the mark is in use, either be left vacant, or be occupied only by matter which is wholly descriptive and has no trade mark significance in relation to the goods in respect of which the mark is registered. It is a condition of registration that the word PIONEER will not be used as a varietal name.; The preceding endorsement(s) were recorded prior to commencement of the Trade Marks Act 1995.

Trade mark image:


PIONEER

Trade mark: 614511

Trade mark details:

Trade mark:	PIONEER
Class(es):	42
Status:	Registered
Filed on:	22 October 1993
Property type:	Word
Entered on register:	09 May 1995
Registered from:	22 October 1993

Owner Details

Owner name:	Pioneer Hi-Bred International, Inc
Owner address:	7100 N.W. 62nd Avenue PO Box 1014 Johnston Iowa 50131-1014 United States of America

Representative details:

Representative name:	Houlihan2 Pty Ltd
Representative address:	PO Box 611 VIC 3104 Australia

Goods and services:

Class: 42	Agricultural crop planning consulting services

Trade mark: 1162626

Trade mark details:

International registration number:	912239
Trade mark:	PIONEER
Class(es):	5, 10
Status:	Protected
Filed on:	6 June 2006
Property type:	Word
Entered on register:	12 December 2008
Registered from:	6 June 2006

Owner Details

Owner name:	Pioneer Surgical Technology, INC.
Owner address:	375 River Park Circle Marquette, MI 49855 United States of America

Representative details:

Representative name:	Spruson & Ferguson
Representative address:	GPO Box 3898 60 Margaret Street NSW 2001 Australia

Goods and services:

Class: 5	Implantable orthopedic devices, namely, surgical implants and bone implants composed of living or natural materials; spinal fixation and stabilization materials composed of living or natural materials; bone fillers consisting of living or natural materials; bone cement for medical purposes
Class: 10	Implantable orthopedic devices, namely, surgical implants and bone implants composed of artificial materials; spinal fixation and stabilization devices; surgical instruments for use in orthopedic and spinal surgery

Convention details

Convention date:	24 May 2006
Trade mark number:	78891855
Country:	United States Of America

Trade mark: 1300132

Trade mark details:

International registration number:	441939
Trade mark:	Pionier
Class(es):	1, 3, 4, 5, 17
Status:	Protected
Filed on:	17 October 2008
Property type:	Word
Entered on register:	16 August 2010
Registered from:	17 October 2008

Owner Details

Owner name:	Hansen & Rosenthal GmbH & Co. KG
Owner address:	Am Sandtorkai 64 20354 Hamburg Germany

Representative details:

Representative name:	Griffith Hack
Representative address:	GPO Box 4164 NSW 2001 Australia

Goods and services:

Class: 1	Sizing preparations and products; by-products of mineral oils, mineral oil and wax derivatives, all as chemical products for industry; by-products of mineral oils for use in chemistry, industry, for manufacturing medicines, drugs and pharmaceutical preparations, milking grease, stopping and insulating materials, varnishes, colorants, lacquers, resins, adhesive substances, polishes, substances for furbishing and preserving leather, products for waxing or polishing floors, perfumery, cosmetic products, essential oils, soaps, cleaning and polishing preparations (except for leather), printers' colours and for use as softeners
Class: 3	Petroleum jelly, petroleum jelly oils and mineral oils, all these products for cosmetic purposes; mineral oils for perfumery and cosmetics, essential oils
Class: 4	Mineral oils, mineral oil and wax derivatives, all as chemical products for industry; petroleum jelly and petroleum jelly oils for technical purposes; mineral oils and greases; synthetic oils; liquefied fuels; lighting products; dust laying compositions; oils and greases for technical processes; oils

	and greases for motor vehicles; oils and greases for machines; lubricants; benzine; winding oils, textile oils, mineral oils for manufacturing adhesive substances; white oils; refined oils, paraffin oils; mineral oils for use in chemistry, industry and science, for manufacturing medicines, pharmaceutical drugs and preparations, milking grease, stopping and insulating materials, varnishes, colorants, lacquers, resins, adhesive substances, polishes, materials used for leather care and polishing, products for waxing or polishing floors, perfumery, cosmetic products, essential oils, soaps, laundering preparations, rust protection agents, cleaning and polishing preparations (except for leather), printers' colours; mineral oils for manufacturing substances for glazing and preserving leather
Class: 5	Petroleum jelly and petroleum jelly oils for medicinal purposes; products for weed and pest prevention and control; mineral oils for medicinal, sanitary and pharmaceutical use, and as milking grease
Class: 17	Stopping and insulating materials containing mineral oils

REQUIREMENTS FOR EVIDENCE OF USE

Subsection 41(4) *Trade Marks Act 1995*

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

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

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

EVIDENCE REQUIRED

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

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

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

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

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

Please note:

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

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 Austaralia'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.