



Australian Government

IP Australia

Discovery House, Phillip ACT 2606  
PO Box 200, Woden ACT 2606  
Australia  
Phone: 1300 651 010  
International Callers: +61-2 6283 2999  
Facsimile: +61-2 6283 7999  
Email: [assist@ipaustralia.gov.au](mailto:assist@ipaustralia.gov.au)  
Website: [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)

6 February, 2007

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

**NOTIFICATION OF PROVISIONAL REFUSAL OF AN INTERNATIONAL  
REGISTRATION DESIGNATING AUSTRALIA (IRDA)**

**THIS REFUSAL IS ISSUED IN ACCORDANCE WITH RULE 17(1) TO 17(3)**

---

**International Registration No:** 899828

**Our Reference No:** 1144398

**Applicant:** LAUNCH TECH CO., LTD.

**Trade mark:** X-431

**Your ref:** 354309201

---

**Examiner:** Kushanthi PEIRIS

Report No. 1

The above trade mark has been examined and the following attachment(s) explain the matters which at present prevent the International Registration from being accepted and, where possible, the ways in which the holder may be able to resolve the issues. The holder has until **6 May 2008** (15 months) in which to do so. This refusal takes effect after that date.

The holder may respond in writing to this refusal, however, any response must be sent through an address for service in Australia.

**Review**

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.

## 1. TRADE MARKS NOT CAPABLE OF DISTINGUISHING - SECTION 41

**Grounds for rejecting this International Registration Designating Australia (IRDA) exist under sub section 41(5) of the Trade Marks Act.**

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.

Your IRDA is refused as the trade mark is not capable of distinguishing the specified goods/services because it consists of a combination of the letter X and the numeral 431. Combinations of letters and numbers are commonly used on the goods you have claimed as product codes, model numbers or catalogue numbers.

Other traders should be able to use this combination in connection with goods similar to yours.

The refusal applies to **all the claimed goods**.

*You may respond to this refusal by:*

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

I have attached an information sheet that indicates the type of evidence needed.

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

- *Evidence is usually in the form of a statutory declaration giving a history and indication of the extent of the use of your trade mark*
- *gathering and compilation of this material may be time-consuming and expensive*
- *the evidence you provide may still be insufficient to overcome the objection*



For REGISTRAR OF TRADE MARKS  
Examiner's Telephone Contact: (02) 62832476

## **REQUIREMENTS FOR EVIDENCE OF USE UNDER SUBSECTION 41(5)**

Evidence of use must be in declaratory form, preferably in the form of a statutory declaration. 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, the declaration 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.

Under subsection 41(5) 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 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**

The following information should be included in the declaration:

- the international registration number;
- our reference
- a representation of the trade mark;
- the holder's name;
- the declarant's name and address;
- the declarant's position within the holder company and length of service in that position;
- when the trade mark was first used (preferably the month and year) and the period of use;
- the names of the states or regions within Australia, and/or other countries in which the trade mark has been used;
- the goods or services in respect of which the trade mark has been used;
- annual turnover figures in Australian dollars which, in relation to use on a wide range of classes of varied goods or services, should be broken down to refer to goods or services of a similar nature;
- advertising of the trade mark, the means by which it was advertised, and the annual expenditure involved in Australian dollars;
- exhibits showing actual use of the trade mark;
- any other relevant information.

**Regulation 17A.28      Grounds for rejecting IRDA**

- (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 (6) (a) to the filing date in respect of an application were a reference to the date of international registration or the date of recordal, 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**

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) 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 a 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 a use of the trade mark by the predecessor in title (see subsection 7(3) and section 8).

- (2) 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 (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.

- (3) In deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons.

- (4) Then, if the Registrar is still unable to decide the question, the following provisions apply.

- (4) Then, if the Registrar is still unable to decide the question, the following provisions apply.

- (5) If the Registrar finds that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons but is unable to decide, on that basis alone, that the trade mark is capable of so distinguishing the designated goods or services:

- (a) the Registrar is to consider whether, because of the combined effect of the following:

- (i) the extent to which the trade mark is inherently adapted to distinguish the designated goods or services;

- (ii) the use, or intended use, of the trade mark by the applicant;

- (iii) any other circumstances;

the trade mark does or will distinguish the designated goods or services as being those of the applicant; and

- (b) if the Registrar is then satisfied that the trade mark does or will so distinguish the designated goods or services—the trade mark is taken to be capable of distinguishing the applicant's goods or services from the goods or services of other persons; and

- (c) if the Registrar is not satisfied that the trade mark does or will so distinguish the designated goods or services—the trade mark is taken not to be capable of distinguishing the applicant's goods or services from the goods or services of other persons.

*Note 1:* For goods of a person and services of a person see section 6.

**Note 2:** 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 (1) and 7(3) and section 8).

(6) If the Registrar finds that the trade mark is not inherently adapted to distinguish the designated goods or services from the goods or services of other persons, the following provisions apply:

(a) if the applicant establishes that, because of the extent to which the applicant has used the trade mark before the filing date in respect of the application, it does distinguish the designated goods or services as being those of the applicant—the trade mark is taken to be capable of distinguishing the designated goods or services from the goods or services of other persons;

(b) in any other case—the trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons.

**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:** 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 (1) and 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.

**Note 1:** For deceptively similar see section 10.

**Note 2:** For similar services see subsection 14(2).

**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.

(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.