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25 March, 2007

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**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: 913426

Our Reference No: 1165123

Applicant: Unitel GmbH & Co. KG

Trade mark: Unitel

Your ref: 356096101

Examiner: Chris COOPER

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 **25 June 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. CONFLICTING TRADE MARKS - SECTION 44

Grounds for rejecting this IRDA exist under the provisions of section 44 of the Trade Marks Act as this trade mark is substantially identical with, or deceptively similar to, the following trade marks, and is for similar goods and/or closely related services or similar services and/or closely related goods:

925593, 1075774

The refusal applies to all the claimed goods and services.

I have enclosed details of the trade marks mentioned above.

You may respond to this refusal by making submissions, providing evidence of use of the trade mark in Australia and/or by requesting a hearing. If you wish to respond in any of these ways, you **must** do so in writing and supply an address for service in Australia.

The evidence of use could show:

- * prior use, or
- * honest concurrent use, or
- * any other circumstances.

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 in Australia.*
- *Gathering and compilation of this material may be time-consuming and expensive*
- *The evidence you provide may still be insufficient to overcome the refusal.*



for
REGISTRAR OF TRADE MARKS

Examiner's Telephone Contact: 02 6283 2968

IP Australia

Trade Mark : 925593

Word: UNITEL COMMUNICATE CAPTIVATE COLLABORATE
Image: 4 BRUSHSTROKES BREAK RECT.

Class/es: 9, 35, 38, 42
Status: Registered/Protected
Kind: n/a
Lodgement date: 2/09/2002
Sealing date: 4/01/2005
Acceptance adv: 16/09/2004
Registered from: 2/09/2002
Registration adv: 13/01/2005
Renewal due: 2/09/2012

Owners: Unitel Australia Pty Ltd
071-659-348
Level 3, Tower 1,
Darling Park,
201 Sussex Street,
SYDNEY 2000 NSW
AUSTRALIA

Address for service: Clayton Utz
PO Box H3
AUSTRALIA SQUARE
1215 NSW

Goods & Services:

Class: 9

Telecommunications and communications equipment, apparatus and systems including but not limited to telephone systems and equipment, electronic directory and electronic mapping equipment, apparatus and systems; computer equipment, apparatus and systems, including but not limited to computer software, computer hardware, CD ROMs and modems; video and audio equipment, apparatus and systems; associated parts, accessories and fittings for the aforementioned; video tapes; compact discs (audio video); compact discs (read only memory); films (exposed); apparatus for games adapted for use with television receivers; publications in electronic format; recorded programs for operating computers; magnetic data carriers; cards in this class including transaction cards, smart cards, memory cards, cards containing a computer chip; and other updateable memory cards; peripheral equipment in this class for such cards

Class: 35

Business and advertising services including advertising services relating to the provision and promotion of telephone and business directories; effecting transactions for products and services via an interactive computer communications network; computerised ordering and sales of goods and services via computer terminals and networks

Class: 38

Telecommunication and communication services; information about telecommunication and communication services including web pages, computer programs and other data; communication and transmission of messages, images and information between and among data carriers and readers by telephone, optical fibre and other means; electronic mail services; provision of telecommunication access and links to computer databases and the Internet

Class: 42

Computer services in this class including on-line computer services and interactive computer communications network services; technical consultancy and advice; design and development of electrical and electronic equipment and computer software; analysis and testing of electrical and electronic equipment and computer software; construction and updating of computer software; licensing of computer software

Endorsements:

Provisions of paragraph 44(3)(a) applied.*



IP Australia

Trade Mark : 1075774

Word: UNITEL DELIVERING THE FUTURE
Image: 2 STRIPES, WAVY, INTERSECTING FORM INFINITY SYMBOL

Class/es: 9, 35, 38, 42
Status: Registered/Protected
Kind: n/a
Lodgement date: 13/09/2005
Sealing date: 8/12/2006
Acceptance adv: 2/03/2006
Registered from: 13/09/2005
Registration adv: 21/12/2006
Renewal due: 13/09/2015

Owners: Unitel Australia Pty Ltd
Level 3 Tower 1
Darling Park
201 Sussex Street
SYDNEY 2000 NSW
AUSTRALIA

Address for service: Clayton Utz
PO Box H3
AUSTRALIA SQUARE
1215 NSW

Goods & Services:

Class: 9

Telecommunications and communications equipment, apparatus and systems including but not limited to telephone systems and equipment, electronic directory and electronic mapping equipment, apparatus and systems; computer equipment, apparatus and systems, including but not limited to computer software, computer hardware, CD ROMs and modems; none of the foregoing being exposed, cinematographic and photographic films, photographic plates, sound and video recordings, tapes, discs and DVD's; video and audio equipment, apparatus and systems, namely audio and video conferencing equipment; associated parts, accessories and fittings for the aforementioned; apparatus for games adapted for use with television receivers; publications in electronic format; recorded programs for operating computers; magnetic data carriers; cards in this class including transaction cards, smart cards, memory cards, cards containing a computer chip; and other updateable memory cards; peripheral equipment in this class for such cards

Class: 35

Business and advertising services including advertising services relating to the provision and promotion of telephone and business directories; effecting transactions for products and services via an interactive computer communications network; computerised ordering and sales of goods and services via computer terminals and

networks; excluding the ordering and sale of exposed, cinematographic, photographic films, photographic plates, sound and video recordings, tapes, discs and DVD's

Class: 38

Telecommunication and communication services; information about telecommunication and communication services including web pages, computer programs and other data; communication and transmission of messages, images and information between and among data carriers and readers by telephone, optical fibre and other means; excluding the communication and transmission of exposed, cinematographic, photographic films, sound and video recordings, tapes, discs and DVD's; electronic mail services; provision of telecommunication access and links to computer databases and the Internet

Class: 42

Computer services in this class including on-line computer services and interactive computer communications network services; technical consultancy and advice; design and development of electrical and electronic equipment and computer software; analysis and testing of electrical and electronic equipment and computer software; construction and updating of computer software; licensing of computer software; none of the aforementioned being in relation to exposed, cinematographic and photographic films, photographic plates, sound and video recordings, video tapes, discs and DVD's

Endorsements:

Provisions of paragraph 44(3)(b) applied.*



EVIDENCE OF HONEST CONCURRENT USE OR PRIOR USE

(Subsections 44(3) and 44(4))

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 that:

your trade mark was honestly adopted and, concurrent with the cited trade mark, has been in use in Australia for a significant period of time prior to the filing date of your IRDA - this is known as **honest concurrent use** (s44(3)(a));

some other circumstances exist which justify allowing your trade mark to proceed in the face of the citation - this is known as **other circumstances** (s44(3)(b)); or

you or the predecessor in business have continuously used your trade mark in Australia on the same or similar goods and/or services or on closely related goods and/or services, from before the priority date of the cited trade mark(s) until the time you filed your current application - this is known as **prior use** (s44(4)).

Honest Concurrent Use

Evidence required - A declaration, preferably a statutory declaration, made by the holder, a principle officer of the holder company or by a person authorised to make it on behalf of the holder.

The following information should be included in the declaration:

the history of the trade mark including;

when and why this trade mark was selected,

whether the holder knew of the cited trade mark when he or she selected this trade mark, and;

details of the use of the trade mark, particularly;

the total length of time the holder, or predecessor in business has used the trade mark,

a detailed account of the goods or services on which the mark has been used from the time of first use through to the present,

figures, in Australian dollars, which show the extent of sales of these goods or services, an account of the States, and Territories of Australia in which those sales occurred, and;

a description of the advertising that has taken place, including;

a brief account of advertising undertaken in Australia,

a broad indication, in Australian dollars, of the amount spent on advertising,

samples of the advertisements and details of the publications in which they appeared - if they are available, and;

examples of the trade mark as it has been used on the goods, or in relation to the services - such as trade brochures and swing tickets.

EVIDENCE OF HONEST CONCURRENT USE OR PRIOR USE (continued)

(Subsections 44(3) and 44(4))

In some circumstances the examiner may request additional declarations to support your IRDA. These should be obtained from members of the trade who are not connected with your business. Each declarant needs to give the following information:

- his or her name, address, employment details/position in company, including the name of his or her employer,
- the length of time the declarant has been in this position;
- a statement of the declarant's knowledge of use of the trade mark, particularly;
- the length of time he or she has been aware of that use,
- the states and/or territories of Australia in which he or she is aware of that use,
- the goods or services on which he or she has known that use,
- a statement indicating whether the declarant knows of the cited trade mark/s and, if so, whether he or she is aware of any confusions between the two trade marks.

Other Circumstances

Where use of the trade mark is by itself insufficient, other circumstances may exist which will allow your trade mark to qualify for registration under paragraph 44(3)(b).

Evidence required - To establish a claim under this subsection, a declaration, preferably a statutory declaration, made by the holder, a principal officer of the holder company or by a person authorised to make it on behalf of the holder, is required which sets out:

the information required for honest concurrent use;

an account of the other circumstances which the holder believes apply, and;

details of circumstances which it believes are relevant and which will satisfy the Registrar that it is proper to accept the IRDA.

A letter of consent from the proprietor(s) of the cited trade mark(s), considered along with the declaration just mentioned, may provide circumstances which will permit acceptance of the holder's trade mark under paragraph 44(3)(b).

Prior Use

Where the holder believes its use of the trade mark in Australia occurred before the priority date of the cited mark, the IRDA may qualify for acceptance under subsection 44(4).

Evidence required - To support a prior use claim, a declaration, preferably a statutory declaration, from the holder, a principal officer of the holder company or by a person authorised to make it on behalf of the holder, is required and should include:

the date the trade mark was first used, in Australia, on the nominated or similar goods or in relation to the nominated or similar services (either by the holder or a predecessor in business);

an indication that the holder was still using the trade mark, in Australia, at the date Australia was designated in the international application or registration.

an indication of continuous use, in Australia, of the trade mark since the date Australia was designated in the international application or registration.

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, or 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.