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World Intellectual Property Organisation (WIPO)  
International Bureau  
34, chemin des Colombettes  
1211 Geneva 20  
Switzerland

Fax No: 0015 41 22 7335428

No. of pages: 8

Dear Sir/Madam

### NOTIFICATION OF REFUSAL OF PROTECTION BASED ON AN OPPOSITION

**THIS REFUSAL IS ISSUED PURSUANT TO RULE 17(1) TO 17(3) OF THE  
COMMON REGULATIONS UNDER THE MADRID AGREEMENT  
CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND  
THE PROTOCOL RELATING TO THAT AGREEMENT**

International Registration number:	951788
For the mark:	GUECCA
In the name of:	Mehmet Gedikli
Opposition by:	Guccio Gucci SpA
Our ref:	1226690

We advise that following receipt of a Notice of Opposition to the above Trade Mark on 20 June 2008, it is necessary to issue this formal refusal letter. This refusal covers all of the goods of the International Registration (Rule 17(2)(vi)).

Please find attached a copy of the Notice of Opposition including the grounds for opposition (Rule 17(2)(iv)).

We also attach:

- Copies of the trade mark(s) upon which the opposition is based, (if conflicting trade mark numbers have been provided in the notice of opposition) showing all relevant details (Rule 17(2)(v), Rule 17(3)).
- A copy of subdivision 3 of Part 17A of the *Trade Marks Regulations 1995* (Rule 17(2)(iv)).

We are

IP Australia • Patents • Trade Marks • Designs • Plant Breeder's Rights  
ABN 38 113 072 755

Please  
attach

Subdivision 3 points to other relevant sections of the *Trade Marks Act 1995* (the Act) and the *Trade Marks Regulations 1995* (the Regulations). Both the Act and the Regulations may be accessed at the following website address:

[www.ipaustralia.gov.au/resources/legislation\\_index.shtml](http://www.ipaustralia.gov.au/resources/legislation_index.shtml)

The following information can also be accessed at  
[www.ipaustralia.gov.au/resources/forms\\_trademarks.shtml](http://www.ipaustralia.gov.au/resources/forms_trademarks.shtml):

- \* brochures about opposition matters giving an overview of opposition proceedings and representation at a hearing
- \* the *Trade Marks Office Manual of Practice and Procedure*.

The trade marks opposition process can be lengthy, as 3 months is nominally allowed for each of the 3 evidence stages - evidence in support of the opposition, evidence in answer and evidence in reply - and these periods may be extended. The due date for serving and filing evidence in answer to the opposition (unless an extension of time is requested) will be **3 months** from the date on which the opponent serves its evidence in support on the holder at its address for services in Australia (**Rule 17(2)(vii) or Rule 18(1)(e) as applicable**).

For answers to questions regarding any opposition matter please email:

To [assist@ipaustralia.gov.au](mailto:assist@ipaustralia.gov.au)

www.ipa

**ADDRESS FOR SERVICE IN AUSTRALIA: important information for the holder of an opposed international registration designating Australia**

If the holder wishes to make written representations or to be heard in relation to the opposition, then the holder **must** notify the Registrar, in writing, of the holder's address for service in Australia.

Although there is no time limit for the holder to nominate an address for service in Australia, it is in the holder's best interests to provide an address for service in Australia as soon as possible.

Please also note that the opponent will **not** be required to serve a copy of its evidence in support of the opposition on the holder, if the holder has not provided an address for service in Australia within the time allowed (subregulation 17A.33(3)).

Yours faithfully

  
Jason Corsini  
Trade Marks and Designs Hearings  
IP Australia  
Direct dial: +61 2 6283 2916

7 July, 2008

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**Australia****Trade Marks Act 1995****IN THE MATTER OF**

Australian Trade Mark No. 1226690  
in the name of Mehmet Gedikli  
-and-  
Opposition by Guccio Gucci SpA

**Section 52****Notice of Opposition**

Guccio Gucci SpA (Opponent) of via Tornabuoni, 73/R, Firenze 50123, Italy, gives notice of opposition to registration of, or extension of protection to an International Registration Designating Australia in the form of, Australian trade mark application no. 1226690 (Opposed Application) for the mark "GUECCA (stylized) (Opposed Trade Mark) in the name of Mehmet Gedikli (Applicant).

The grounds of opposition are as follows:

- 1 the Opposed Trade Mark contains or consists of a sign, or so nearly resembles a sign, that is not to be used as a trade mark (s39);
- 2 the Opposed Trade Mark is not capable of distinguishing the Applicant's goods/services (s41);
- 3 the Opposed Trade Mark contains or consists of scandalous matter (s42);
- 4 use of the Opposed Trade Mark would be contrary to law (s42);
- 5 use of the Opposed Trade Mark in relation to the specified goods/services would be likely to deceive or cause confusion (s43);
- 6 the Opposed Trade Mark is substantially identical with or deceptively similar to one or more trade mark registrations and/or applications having an earlier priority date in respect of similar goods/services or closely related goods/services (including Australian trade marks nos 265546 & 325817) (s44 and reg 4.15A);
- 7 the Applicant is not the owner of the Opposed Trade Mark (s58);
- 8 the owner of/ predecessor in title to a substantially identical or deceptively similar trade mark (Similar Mark), being the subject of a prior registration or application in relation to which the Applicant claims prior use of the Opposed Trade Mark, first used the Similar Mark in respect of similar or closely related goods/services before the Applicant/predecessor in title to the Opposed Trade Mark first used the Opposed Trade Mark, and has continuously used the Similar Mark in respect of those goods/services since that first use (s58A);
- 9 the Applicant does not intend to use, or authorise the use of, the Opposed Trade Mark in Australia, or to assign the Opposed Trade Mark to a body corporate for use by the body corporate in Australia, in relation to all the goods/services specified in the Opposed Application (s59);

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- 10 another trade mark had, before the priority date of the Opposed Application, acquired a reputation in Australia such that the use of the Opposed Trade Mark would be likely to deceive or cause confusion (s60);
- 11 the Opposed Trade Mark contains or consists of a sign that is a geographical indication for goods (Designated Goods) and the goods specified in the Opposed Application (Relevant Goods) are similar to the Designated Goods or the use of the Opposed Trade Mark in relation to the Relevant Goods would be likely to deceive or cause confusion (s61);
- 12 the Opposed Application or a document filed in support of the Opposed Application was amended contrary to the Trade Marks Act 1995 (s62);
- 13 the Opposed Application was accepted for registration/protection in Australia on the basis of evidence or representations that were false in material particulars (s62);
- 14 the Opposed Application was made in bad faith (s62A);
- 15 by reason of the matters set forth in any one or more of the foregoing paragraphs the Registrar in the exercise of her discretion ought to refuse registration/protection in Australia of the Opposed Trade Mark.

The Opponent's address for service is (attorney code F7):

Corrs Chambers Westgarth Lawyers  
National Trade Mark Group  
Bourke Place  
600 Bourke Street  
MELBOURNE VIC 3000

Date: 20 June 2008

  
Stephen Stern  
Solicitor and Partner of Corrs Chambers Westgarth  
Solicitors for the Opponent

To: The Registrar of Trade Marks

Fee: \$250.00

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## Trade Mark Details

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## Trade Mark Details

## Trade Mark : 265546

**Word:** GUCCI  
**Image:**  
**Lodgement Date:** 02-FEB-1973  
**Registered From:** 02-FEB-1973  
**Renewal Due:** 02-FEB-2018  
**Class/es:** 25  
**Status:** Registered/Protected  
**Kind:** n/a  
**Type:** Word

**Owner/s:** Guccio Gucci SpA  
Via Tornabuoni 73/R  
50123 Firenze  
ITALY

**Address for Service:** Corrs Chambers Westgarth  
National Trade Mark Group  
600 Bourke Street  
MELBOURNE  
3000, VIC

## Goods &amp; Services

**Class:** 25 Ladies' and gentlemen's clothing

**Indexing Details - Word Constituents**  
GUCCI

**Indexing Details - Image Constituents**

## Trade Mark Details

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## Trade Mark Details

## Trade Mark : 325817

**Word:** GUCCI  
**Image:**  
**Lodgement Date:** 16-JAN-1979  
**Registered From:** 16-JAN-1979  
**Renewal Due:** 16-JAN-2010  
**Class/es:** 25  
**Status:** Registered/Protected  
**Kind:** n/a  
**Type:** Word

**Owner/s:** Guccio Gucci SpA  
Via Tornabuoni 73/R  
50123 Firenze  
ITALY

**Address for Service:** Corrs Chambers Westgarth  
National Trade Mark Group  
600 Bourke Street  
MELBOURNE  
3000, VIC

**Goods & Services**

**Class:** 25 Clothing including boots, shoes and slippers

**Indexing Details - Word Constituents**  
GUCCI**Indexing Details - Image Constituents**

This mark was registered under the Trade Marks Act 1955 in Part A

## TRADE MARK REGULATIONS

### Subdivision 3 Opposition to IRDA

#### 17A.29 Opposition

- (1) If the Registrar has notified in the *Official Journal* the acceptance of an IRDA, a person may oppose the extension of protection in Australia to the trade mark that is the subject of the IRDA by filing a notice of opposition.
- (2) The notice of opposition must:
  - (a) be in an approved form; and
  - (b) be filed with the Registrar:
    - (i) within 3 months from the day on which the acceptance of the IRDA is notified in the *Official Journal*; or
    - (ii) if an extension of time is granted under regulation 17A.30, within the extended time allowed.
- (3) The Registrar must notify the International Bureau of the opposition in accordance with rule 16 or 17, as applicable, of the Common Regulations.

#### 17A.30 Extension of time for filing

- (1) A person may apply to the Registrar for an extension of time in which to file a notice of opposition.
- (2) Regulations 5.2, 5.3 and 5.4 (except subregulations 5.4 (2) and (3)) apply, with the necessary modifications, to an application for extension of time under subregulation (1).
- (3) Subsection 52 (5) of the Act applies to an application for extension of time under subregulation (1).

#### 17A.31 Grounds for opposing IRDA

- (1) The extension of protection may be opposed on any of the grounds on which an IRDA may be rejected under Subdivision 2, except the ground that the trade mark cannot be represented graphically.
- (2) The extension of protection may also be opposed on any of the grounds set out in sections 58 to 61 and section 62A of the Act, as affected by subregulation (3).
- (3) Sections 58 to 61 and section 62A 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
    - (iii) to the registration of a trade mark were a reference to the extension of protection in Australia to the trade mark that is the subject of the IRDA; and

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- (b) the reference in paragraph 60 (a) to the priority date for the registration of the trade mark were a reference to the priority date for the trade mark that is the subject of the IRDA.

(4) The extension of protection may also be opposed on the grounds that:

- (a) a document filed in support of the IRDA was amended contrary to the Act; or  
(b) the Registrar accepted the IRDA on the basis of evidence provided, or a representation made, by the holder that was false in a material particular.

*Note* Section 66 of the Act makes provision in relation to amendment of documents filed with the Registrar.

**17A.32 Circumstances in which opposition may proceed in name of a person other than the person who filed the notice**

Section 53 of the Act applies in respect of a notice of opposition filed under this Subdivision.

**17A.33 Opposition proceedings**

- (1) The Registrar must give to the opponent and to the holder of the IRDA an opportunity of being heard on the opposition.  
(2) Regulations 5.7 to 5.17 apply, with the necessary modifications, for the purposes of the opposition.  
(3) Despite subregulations (1) and (2), a requirement to serve a document on the holder, or to give the holder an opportunity to make written representations or to be heard, does not apply until the holder has notified the Registrar, in writing, of the holder's address for service in Australia.

**17A.34 Decision on opposition**

- (1) Unless the opposition proceedings are discontinued or dismissed, the Registrar must decide:  
(a) to refuse protection in respect of all of the goods or services listed in the IRDA; or  
(b) to extend protection in respect of some or all of the goods or services listed in the IRDA (with or without conditions or limitations);  
having regard to the extent (if any) to which any ground on which the IRDA was opposed has been established.  
(2) The Registrar must tell the International Bureau of his or her decision.

**17A.35 Appeal**

- (1) Section 56 of the Act applies in relation to the Registrar's decision on the opposition as if a reference in that section:  
(a) to an applicant were a reference to the holder of an IRDA; and  
(b) to a decision under section 55 of the Act were a reference to a decision under regulation 17A.34.  
(2) If an appeal is made, the Registrar must tell the International Bureau of the decision on the appeal as soon as practicable after that decision is made.