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5 October, 2011

International Bureau, WIPO
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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)**

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|---|---|
| **International Registration No:** | 1075544 |
| **Our Reference No:** | 1426854 |
| **Applicant:** | Bio-Rad Medical Diagnostics GmbH |
| **Trade mark:** | TANGO INFINITY |
| **Your ref:** | 584683701 |

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**Examiner:** Subrata Pal Report No. 2

I have examined the above trade mark. 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 **5 January 2013** (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.** Please allow time for me to consider any responses by ensuring they are received by this office at least four weeks before the above date.

**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.

NCS INTERNATIONAL
CERTIFIED QUALITY MANAGEMENT SYSTEM
ISO9001

## REPORT

I apologise for raising a new issue at this stage of examination. However, this IRDA has been reviewed and the following ground for rejection of the IRDA exists. Please note that this ground for refusal is in addition to the provisional refusal of 29 July 2011.

### 2. 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:

Your trade mark is substantially identical with, or deceptively similar to, the following trade marks, and is for similar or closely related goods and/or services:

1021831

**The refusal applies to the following goods:**

**Class 1:** *all the goods claimed.*

I have enclosed details of the trade mark mentioned above.

*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 witnessed 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. 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.

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

Subrata Pal for
REGISTRAR OF TRADE MARKS
Examiner's Telephone Contact: (02) 6283 2550

## 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 supplied in electronic form. 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** will not become API. However, copies of declarations may be requested under the *Freedom of Information Act 1982* (FOI Act). If this occurs, IP Australia will 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.

# IP Australia

# Trade Mark : 1021831

**Word:** TANGO
**Image:**

**Class/es:** 1, 5
**Status:** Registered/Protected
**Kind:** n/a
**Lodgement date:** 24 September 2004
**Sealing date:** 25 May 2005
**Acceptance adv:** 10 February 2005
**Registered from:** 24 September 2004
**Registration adv:** 9 June 2005
**Renewal due:** 24 September 2014

**Owners:** George William Mason
78 Plymouth Road
R D 4
New Plymouth
NEW ZEALAND

John Brodie Matthews
78 Plymouth Road
R D 4
New Plymouth
NEW ZEALAND

John Sutherland Auld
78 Plymouth Road
R D 4
New Plymouth
NEW ZEALAND

Peter James Hayward
78 Plymouth Road
R D 4
New Plymouth
NEW ZEALAND

Christine Anne Hayward
78 Plymouth Road
R D 4
New Plymouth
NEW ZEALAND

**Address for service:** PIPERS Melbourne
PO Box 839
PORT MELBOURNE 3207 VIC

**Goods & Services:**

Trade Mark Application No: 1426854

**Class: 1**

Chemicals for use in agriculture, horticulture, forestry and industry

**Class: 5**

Preparations for destroying vermin: fungicides, herbicides, pesticides and insecticides

**Endorsements:**

# 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 (6) (a) 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) 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.

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.

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.