



29 November, 2012

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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:** 1066624

**Our Reference No:** 1445814

**Applicant:** Obchtchestvo s ogranitchennoi  
otvetstvennostiou "NL Kontinent"



**Trade mark:** NL INTERNATIONAL

**Your ref:** 615857701

**Examiner:** Sarah Jonic

**Report No.** 2

The examination of the above trade mark has been reviewed. The following attachment(s) explain additional 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. I apologise for identifying new problems at this time. The holder now has until **15 February 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.

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

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

### REPORT

I apologise for raising a new issue at this stage of examination. However, the application has been reviewed and the following additional matter has been brought to my attention.

### SECTION 44 – TRADE MARKS WHICH ARE SIMILAR TO OTHER TRADE MARKS

Grounds for rejecting this IRDA exist under the provisions of section 44 of the *Trade Marks Act 1995*.

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:

1520603

The refusal applies to the following ADDITIONAL goods/services:

*Class: 5 Additives to fodder for medical purposes; albuminous foodstuffs for medical purposes; dietetic foods adapted for medical purposes; food for babies; starch for dietetic or pharmaceutical purposes; amino acids for medical purposes; analgesics; antibiotics; antiseptics; bath preparations, medicated; balms for medical purposes; biocides; dietetic beverages adapted for medical purposes; confectionery, medicated; mud for baths; medicinal mud; fumigating sticks; nutritional additives for medical purposes; antiseptic cotton; appetite suppressants for medical purposes; decoctions for pharmaceutical purposes; disinfectants for hygiene purposes; digestives for pharmaceutical purposes; drugs for medical purposes; mineral water for medical purposes; thermal water; elixirs (pharmaceutical preparations); enzymes for medical purposes; enzymes for veterinary purposes; lacteal flour for babies; ferments for pharmaceutical purposes; milk ferments for pharmaceutical purposes; royal jelly (for medical purposes); germicides; glucose for medical purposes; chewing gum for medical purposes; hematogen; medicinal herbs; medicinal oils; cod liver oil; medicinal infusions; milk of almonds for pharmaceutical purposes; yeast for pharmaceutical purposes; liniments; lotions for pharmaceutical purposes; nervines; diabetic bread; pomades for medical purposes; albuminous preparations for medical purposes; bacterial preparations for medical and veterinary use; bacteriological preparations for medical and veterinary use; biological preparations for medical purposes; biological preparations for veterinary purposes; chemical preparations for medical purposes; chemical preparations for pharmaceutical purposes; vitamin preparations; preparations of trace elements for human and animal use; medical*

*preparations for slimming purposes; contact lens cleaning preparations; therapeutic preparations for the bath; chemico-pharmaceutical preparations; preparations for the treatment of burns; opotherapy preparations; pharmaceutical preparations; pharmaceutical preparations for skin care; air purifying preparations; air freshening preparations; veterinary preparations; medicinal roots; salts for medical purposes; bath salts for medical purposes; serums; sanitary towels; tissues impregnated with pharmaceutical lotions; syrups for pharmaceutical purposes; dietetic substances adapted for medical use; milk sugar (lactose); mineral food-supplements; reducing tea for medical purposes; asthmatic tea; herbs teas for medicinal purposes*

**Class: 9** *actinometers; aerometers; electronic agendas; alcoholmeters; altimeters; flashlights; amplifiers; anodes; aerials; anticathodes; high-frequency apparatus; apparatus to check franking; heat regulating apparatus; precision measuring apparatus; satellite navigational apparatus; navigation apparatus for vehicles (on-board computers); projection apparatus; slide projectors; radios; radiological apparatus for industrial purposes; television apparatus; remote control apparatus; heliographic apparatus; electro-dynamic apparatus for the remote control of signals; regulating apparatus, electric; measuring devices, electric; monitoring apparatus, electric; electric apparatus for commutation; chemistry apparatus and instruments; weighing apparatus and instruments; apparatus and instruments for physics; sounding apparatus and machines; cameras; air analysis apparatus; gas testing instruments; food analysis apparatus; testing apparatus not for medical purposes; sound reproduction apparatus; sound transmitting apparatus; data processing apparatus; diagnostic apparatus, not for medical purposes; amusement apparatus adapted for use with an external display screen or monitor; sound recording apparatus; time recording apparatus; apparatus for games adapted for use with an external display screen or monitor; teaching apparatus; stereoscopic apparatus; telephone apparatus; audiovisual teaching apparatus; apertometers (optics); fire alarms; anti-theft warning apparatus; acoustic (sound) alarms; personal stereos; scales; barometers; fiber optic cables; cables, electric; cash registers; cinematographic cameras; camcorders; encoded cards, magnetic; identity cards, magnetic; integrated circuit cards; video game cartridges; chronographs (time recording apparatus); flashing lights (luminous signals); commutators; comparators; converters, electric; counters; acoustic conduits; speed checking apparatus for vehicles; retorts; acoustic couplers; couplers (data processing equipment); densimeters; densitometers; detectors; distance measuring apparatus; circuit breakers; sound recording discs; compact discs (audio-video); compact discs; floppy disks; optical discs; anti-interference devices (electricity); balancing apparatus; steering apparatus, automatic, for vehicles; editing appliances for cinematographic films; distribution machines, automatic; dynamometers; telephone receivers; projection screens; fluorescent screens; screens (photography); video screens; transmitters of electronic signals; transmitting sets (telecommunication); magnetic encoders; pressure indicators; tape recorders; ergometers; electronic tags for goods; exposure meters (light meters); door closers, electric; optical fibers (light conducting filaments); wires, electric; filters; frequency meters; galvanometers; gasometers; sprinkler systems for fire protection; loudspeakers; holograms; hydrometers; hygrometers; indicators (electricity); temperature indicators; speed indicators; armatures (electricity); inverters (electricity); theft prevention installations, electric; interfaces for computers; material testing instruments and machines; electric installations for the remote control of industrial operations; measuring instruments; observation instruments; printers for use with computers; navigational instruments; switches, electric; signal lanterns; lasers, not for medical purposes; bar code readers; compact disc players; optical character readers; adding machines;*

calculating machines; money counting and sorting machines; dictating machines; weighing machines; word processors; video recorders; pressure gauges; mechanisms for coin-operated apparatus; disk drives for computers; coin-operated mechanisms for television sets; computer memories; measures; measuring apparatus; capacity measures; rules (measuring instruments); micrometers; microprocessors; microphones; microtomes; modems; monitors (computer hardware); levels (instruments for determining the horizontal); ohmmeters; wavemeters; computers; notebook computers; ozonisers (ozonators); computer peripheral devices; acid hydrometers; lactometers; photocopiers; pedometers; speaking tubes; radiotelephony sets; computer programs, recorded; computer programs (downloadable software); electronic publications, downloadable; chips (integrated circuits); quantity indicators; radar apparatus; audio and video-receivers; current rectifiers; refractometers; refractors; relays, electric; rheostats; saccharometers; scanners (data processing equipment); signals, luminous or mechanical; sonars; sound locating instruments; spectrograph apparatus; spherometers; stereoscopes; sound recording carriers; optical data media; switchboards; electronic notice boards; control panels (electricity); distribution boards (electricity); tachometers; walkie-talkies; taximeters; facsimile machines; range finders; telerupters; portable telephones; theodolites; thermometers, not for medical purposes; thermostats; totalizers; record players; electronic pocket translators; transmitters (telecommunication); transformers; processors (central processing units); urinometers; vacuum gauges; voltmeters

**Class: 16** printed matter; books; booklets; manuals; teaching materials (except apparatus);

**Class: 30** Oat-based food; seasonings; rusks; biscuits; cocoa-based beverages; chocolate-based beverages; coffee-based beverages; tea-based beverages; sweetmeats; gruel, with a milk base, for food; cocoa; cocoa beverages with milk; coffee; coffee beverages with milk; breadcrumbs; chocolate; chocolate beverages with milk; condiments; confectionery; couscous (semolina); crackers; custard; ice cream; pancakes; turmeric for food; edible decorations for cakes; natural sweeteners; thickening agents for cooking foodstuffs; spices; flour for food; starch for food; ferments for pastes; chips; fondants (confectionery); cakes; gluten for food; groats for human food; halvah; infusions, not medicinal; popcorn; malt for human consumption; marzipan; mayonnaise; farinaceous foods; honey; muesli; bread; pastilles (confectionery); almond paste; cake paste; pasta; pate (pastries); meat pies; fruit jellies (confectionery); bread rolls; pizzas; baking powder; pralines; aromatic preparations for food; cereal preparations; cocoa products; flour-milling products; preparations for stiffening whipped cream; ravioli; rice; sandwiches; cooking salt; sorbets (ices); sugar; sushi; tapioca; tarts; tea; pies; vinegar

**Class: 32** Aperitifs, non-alcoholic; beer; whey beverages; non-alcoholic fruit juice beverages; isotonic beverages; non-alcoholic beverages; cocktails, non-alcoholic; table waters; essences for making beverages; non-alcoholic fruit extracts; extracts of hops for making beer; fruit juices; vegetable juices (beverages); milk of almonds (beverage); lemonades; must; fruit nectars, non-alcoholic; orgeat; pastilles for effervescing beverages; preparations for making liqueurs; preparations for making mineral water; preparations for making beverages; preparations for making aerated water; powders for effervescing beverages; syrups for beverages

**Class: 35** Bill-posting; import-export agencies; commercial information agencies; advertising agencies; business management assistance; commercial or industrial

*management assistance; cost price analysis; employment agencies; business management and organization consultancy; personnel management consultancy; professional business consultancy; publicity columns preparation; shop window dressing; demonstration of goods; distribution of samples; dissemination of advertising matter; business management of performing artists; business appraisals; tax preparation; marketing studies; efficiency experts; business management of hotels; computerized file management; business information; rental of advertising space; publicity material rental; rental of advertising time on communication media; updating of advertising material; organization of trade fairs for commercial or advertising purposes; organization of exhibitions for commercial or advertising purposes; payroll preparation; economic forecasting; publication of publicity texts; advertising; on-line advertising on a computer network; advertising by mail order; radio advertising; television advertising; marketing research; personnel recruitment; compilation of information into computer databases; public relations; business inquiries; document reproduction; photocopying; psychological testing for the selection of personnel; modelling for advertising or sales promotion; relocation services for businesses; news clipping services; secretarial services; arranging newspaper subscriptions for others; opinion polling; systemization of information into computer databases; word processing; transcription; book-keeping; auditing; auctioneering*

***Class: 41*** *Modeling for artists; night clubs; sport camp services; timing of sports events; health club services; physical education; animal training; teaching; videotaping; educational examination; providing on-line electronic publications, not downloadable; providing amusement arcade services; practical training (demonstration); education information; entertainment information; recreation information; gaming; rental of audio equipment; rental of sound recordings; rental of sports equipment, except vehicles; electronic desktop publishing; providing sports facilities; organization of exhibitions for cultural or educational purposes; arranging and conducting of colloquiums; arranging and conducting of congresses; arranging and conducting of conferences; arranging and conducting of workshops; arranging and conducting of seminars; arranging and conducting of symposiums; arranging of beauty contests; organization of competitions (education or entertainment); operating lotteries; organization of sports competitions; vocational guidance (education or training advice); photography; party planning (entertainment); videotape film production; cinema presentations; publication of books; publication of electronic books and journals on-line; production of shows; publication of texts, other than publicity texts; scriptwriting services; photographic reporting; entertainer services; providing casino facilities (gambling); club services (entertainment or education); discotheque services; providing recreation facilities; news reporters services; recording studio services; translation; movie studios*

I have enclosed details of the trade mark(s) mentioned above.

Please note that this refusal is in addition to the initial refusal in relation to the following goods for conflicting trade marks 807976, 964496, 964497, 972521, 990477, 996693, 1017357, 1031322, 1153002:

***Class: 3*** *Abrasives; adhesives for cosmetic purposes; breath freshening sprays; aromatics (essential oils); fabric softeners for laundry use; astringents for cosmetic purposes; cosmetic creams; polishing creams; shoe polish; shoemakers' wax; laundry wax; cosmetics; cosmetic preparations for eyelashes; eyebrow cosmetics; cosmetic pencils; washing soda, for cleaning; scouring solutions; floor wax removers;*

*bleaching preparations (decolorants) for cosmetic purposes; dentifrices; depilatory preparations; deodorants for personal use; stain removers; scale removing preparations for household purposes; detergents other than for use in manufacturing operations and for medical purposes; toilet water; starch for laundry purposes; polish for furniture and flooring; make-up; greases for cosmetic purposes; cleansing milk for toilet purposes; hair spray; nail polish; windshield cleaning liquids; lotions for cosmetic purposes; mascara; beauty masks; preparations for soaking laundry; cosmetic kits; neutralizers for permanent waving; perfumes; pomades for cosmetic purposes; potpourris; make-up powder; cosmetic preparations for baths; sunscreen preparations; hair waving preparations; polishing preparations; color-brightening chemicals for household purposes (laundry); antistatic preparations for household purposes; cosmetic preparations for skin care; make-up removing preparations; laundry glaze; make-up preparations; dry-cleaning preparations; perfumery; shaving preparations; toiletries; antiperspirants; grinding preparations; leather bleaching preparations; lacquer-removing preparations; color-removing preparations; rust removing preparations; nail care preparations; mouth washes, not for medical purposes; smoothing preparations; soap; shampoos; shampoos for pets; bath salts, not for medical purposes; tissues impregnated with cosmetic lotions; cosmetic dyes; hair dyes*

*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. 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.

Sarah Jonic for  
REGISTRAR OF TRADE MARKS

Examiner's Telephone Contact: 6283 7906

## 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 (other than on USB keys or via cloud computing technologies). 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.

# IP Australia

## Trade Mark : 1520603

**Word:** NL INTERNATIONAL  
**Image:** GLOBE, MERIDIANS INDENTED BY LTRS  
**Class/es:** 5, 29, 30, 32, 35, 38, 41  
**Status:** Taken for Examination  
**Kind:** n/a  
**Lodgement date:** 29 December 2011  
**Convention date:** 6 July 2011  
**Owners:** NL International Luxembourg S.A.  
17, Avenue Grande Duchesse Charlotte  
L-3441 Dudelange  
LUXEMBOURG

**Address for service:** Refer to WIPO Address for Correspondence

### Goods & Services:

#### Class: 5

Hygiene preparations, dietetic substances for medical use, dietetic foodstuffs for medical use, biological preparations for medical use, dietetic beverages for medical use, confectionery for pharmaceutical use, chemico-pharmaceutical preparations, chemical preparations for medical use, chemical preparations for pharmaceutical use, nutritional supplements and substitutes for medical use, decoctions for pharmaceutical use, elixirs (pharmaceutical; preparations), essences for medical use, fiber for consumption (non-nutritive), herbs for smoking for medical use, chewing gum for medical use, gum for medical use, medicinal plants, oils for medical use, medicinal infusions, lotions for pharmaceutical use, medication for human medicine, mineral water for medical use, narcotics, trace element preparations for human consumptions, ointments for pharmaceutical use, medicinal potions, medicinal roots, tonics (medication), remedies for human medicine, sedatives, serums, syrups for pharmaceutical use, sleeping aids, sugar for medical use, mineral food supplements, medicinal teas, herbal teas, vitamin and mineral preparations as food supplements; glycerine for medical purposes

#### Class: 29

Meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, fruit, vegetable and plant extracts for human consumption, jellies, jams, compotes, eggs, milk and dairy products, edible oils and fats, seaweed extracts for food, processed almonds, processed peanuts, butter, milk beverages with milk predominating, bouillon, preparations for making bouillon, preserved mushrooms, desiccated coconut, concentrates (broth), frosted fruits, broth, creams (milk products), crystallized fruits, fruit peel, preserved beans, cheese, gelatine for food, fruit jellies, fruit pulp, jellies for food, preserved soya beans for food, vegetable juices for cooking, whey, margarine, marmalades, prepared nuts, nut oils (foodstuffs), preserved olives, fish products, pickles, pollen prepared for foodstuffs, protein for human consumption, vegetable fibers for human consumption, raisins, salted meats, sausages, tofu, yogurt, cooked dishes and meals made with meat, fish, poultry, fruit, vegetables, eggs, milk and dairy products, dietetic cooked dishes and meals, not for medical use, made with meat, fish, poultry, fruit, vegetables, eggs, milk and dairy products, canned fruits, canned vegetables, canned fish, canned meat and soups; dietetic foodstuffs, nutritional

supplements and meal substitutes not for medical use made with meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, fruit, vegetable and plant extracts for human consumption, jellies, eggs, milk and dairy products, edible oils and fats, seaweed extracts for food, processed peanuts, butter, preserved mushrooms, concentrates (broth), gelatine for food, vegetable juices for cooking, margarine, fish products, prepared pollen for food, vitamins, minerals, proteins for human consumption, vegetable fibers for human consumption

**Class: 30**

Flours and preparations made with cereals, salt, vinegar, spices, seaweed (condiments), edible ices, pasta, almond confectionery, almond paste, starch or flour for food purposes, peanut confectionery, flavorings, other than essential oils, flavorings, other than essential oils, for cakes, aromatic preparations for food, preserved pot herbs, seasonings, oat-based food, oat flakes, liquorice sticks (confectionery), beverage flavorings other than essential oils, cocoa products, coffee, coffee flavorings, vegetal preparations for use as coffee substitutes, unroasted coffee, dried cereal flakes, chicory (coffee substitute), cocoa, chocolate, condiments, confectionery, couscous (semolina), ice cream, natural sweeteners, thickening agents for cooking foodstuffs, essences for foodstuffs (except etheric essences and essential oils), malt extracts for food, starch for food, ferments for pastes, bean meal, wheat flour, farinaceous foods, corn flakes, royal jelly for human consumption (not for medical purposes), glucose for food, candy, chewing gum not for medical purposes, pastilles (confectionery), fruit paste (confectionery), fruit paste (confectionery), gruel with a milk base for food, puddings, gluten for food, groats for human food, leaven, yeast, maize flour, grilled maize and popcorn, malt extracts for food, malt for food, mayonnaise, molasses, golden syrup, non-medicinal infusions, honey, bread, unleavened bread, gingerbread, crackers, flour-milling products, mustard, noodles, barley meal, maize flakes, pepper, potato flour for food, cake powder, pralines, bee glue for human consumption (beekeeping products), liquorice (confectionery), rice, sauces (condiments), semolina, soya flour, sherbets (edible ices), sugar, candy for food, tapioca, tapioca flour for food, tea, frozen yogurt (edible ices), cooked dishes and meals made with flour, cereals, cereal preparations, pasta, rice, cocoa, chocolate, coffee or tea; dietetic dishes and ready-made meals not for medical purposes made with flours, cereals, cereal preparations, farinaceous food pastes, rice, cocoa, chocolate, coffee or tea; dietetic foodstuffs, nutritional supplements and meal substitutes not for medical use made with flours, cereals, preserved pot herbs, preparations made from cereals, salt, vinegar, spices, seaweed (condiments), farinaceous food pastes, starch for food use, flavorings other than essential oils, aromatic preparations for food use, cocoa, coffee, coffee flavoring, vegetal preparations as coffee substitutes, unroasted coffee, chicory (coffee substitute), chocolate, condiments, natural sweeteners, thickening agents for cooking foodstuffs, thickening agents for cooking foodstuffs, essences for foodstuffs (except etheric essences and essential oils), malt extracts for food, starch for food, ferments for pastes, royal jelly for human consumption (not for medical purposes), glucose for food, gluten for food, groats for human food, leaven, yeast, prepared maize, malt for food, molasses, honey, flour-milling products, mustard, pepper, bee glue for human consumption (beekeeping products), rice, semolina, sugar, tea, biscuits and dietetic biscuits not for medical use, biscuits and dietetic biscuits not for medical use

**Class: 32**

Beers, mineral and aerated waters and other non-alcoholic beverages, fruit drinks and fruit juices, syrups and preparations for making beverages, non-alcoholic aperitifs, essences for making beverages, pastilles for effervescing beverages, beverage powders, isotonic beverages, energy beverages, syrups for beverages, non-alcoholic cocktails, table waters, preparations for making aerated water, non-alcoholic fruit extracts, vegetable juices (beverages), soda, sherbets (beverages)

**Class: 35**

Advertising, commercial business management, commercial administration, providing subscriptions, for others, to newspapers, newsletters, commercial messages, providing subscriptions, for others, to telecommunications services, particularly in the context of the retail or wholesale selling of goods, business management assistance, professional business consulting, efficiency experts, business information, business research, import-export agencies, commercial information agencies, cost-price analysis, dissemination of advertisements, procurement services for others; purchasing of goods and services for other businesses, administrative processing of purchase orders, presentation of goods on communication media for retail sale, transcription of communications, accounting, commercial advice and information for consumers, advertising mailing, demonstration of goods, dissemination (distribution) of samples, dissemination of advertising material (leaflets, prospectuses, printed matter, samples), distribution of advertising material (leaflets, prospectuses, printed matter, samples), updating of advertising documentation, drawing up of statistics, marketing studies, arranging of exhibitions, seminars, conferences or colloquiums for commercial or advertising purposes, invoicing, collection of data in computer databases, systemization of data in computer databases, computerized file management, book-keeping, rental of vending machines, rental of advertising time on any communication media, rental of advertising space, modeling services for advertising or sales-promotion services, sponsorship search, preparation of payslips, human resources consulting, personnel recruitment, job placement agencies, sales promotion for others, publication of publicity texts, on-line advertising on a computer network or on any telecommunication medium, advertising by mail-order, information searches in computer files for others, organization and management of promotional or advertising campaigns to develop customer loyalty, administrative and commercial management of orders for goods passed or received over the Internet or by any other communication medium, retail sale of sanitary goods, dietetic substances adapted for medical use, dietetic foodstuffs adapted for medical use, biological preparations for medical purposes, dietetic beverages adapted for medical use, candy for pharmaceutical purposes, chemico-pharmaceutical goods, chemical preparations for medical purposes, chemical preparations for pharmaceutical purposes, nutritional supplements and substitutes for medical purposes, decoctions for pharmaceutical purposes, elixirs (pharmaceutical preparations), essences for medical purposes, edible fibers (non-nutritive), herbs for smoking for medical purposes, chewing gums for medical purposes, gums for medical purposes, medicinal herbs, oils for medical purposes, medicinal infusions, lotions for pharmaceutical purposes, medications for human medicine, mineral waters for medical purposes, narcotics, trace-element preparations for human consumption, ointments for pharmaceutical purposes, medicinal drinks, medicinal roots, tonics (medicines), remedies for human medicine, sedatives, serums, syrups for pharmaceutical purposes, soporifics, sugar for medical purposes, mineral food supplements, medicinal tea, herbal teas, vitamin and mineral preparations as food supplements; glycerine for medical purposes, meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, fruit, vegetable and plant extracts for human consumption, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, seaweed extracts for food, processed almonds, processed peanuts, butter, milk beverages with milk predominating, bouillon, desiccated coconut, concentrates (bouillon), frosted fruits, broth, creams (milk products), crystallized fruits, fruit peel (zest), preserved beans, cheese, gelatine for food, fruit jellies, fruit pulp, jellies for food, preserved soya beans for food, preserved pot herbs, vegetable juices for cooking, whey, margarine, marmalades, prepared nuts, nut oils (foodstuffs), preserved olives, fish products, pickles, prepared pollen for food, protein for human consumption, vegetable fibers for human consumption, raisins, salted meats, sausages, tofu, yogurt, cooked dishes and

meals made with meat, fish, poultry, fruit, vegetables, eggs, milk and milk products, dietetic cooked dishes and meals, not for medical purposes, made with meat, fish, poultry, fruit, vegetables, eggs, milk and milk products, canned fruits, canned vegetables, canned fish, canned meat and soups; dietetic food products, food supplements and meal substitutes, not for medical purposes, made with meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, fruit, vegetable and plant extracts for human consumption, jellies, eggs, milk, milk products, edible oils and fats, seaweed extracts for human consumption, processed peanuts, butter, preserved mushrooms, concentrates (bouillon), gelatine for human consumption, preserved pot herbs, vegetable juices for cooking, margarine, fish products, prepared pollen for human consumption, vitamins, minerals, proteins for human consumption, vegetable fibers for human consumption, flours and preparations made from cereals, salt, vinegar, spices, seaweed (condiments), edible ices, farinaceous food pastes, confectionery made with almonds, almond pastes, starch for food, confectionery made with peanuts, flavorings other than essential oils, flavorings for cakes, other than essential oils, flavoring preparations for food, seasonings, foodstuffs made with oats, oat flakes, stick liquorice (confectionery), flavorings for beverages other than essential oils, cocoa products, coffee, coffee flavorings, plant preparations as coffee substitutes, green coffee, dried cereal flakes, chicory (coffee substitute), chocolate cocoa, condiments, confectionery, couscous (semolina), ice creams, natural sweeteners, thickening agents for cooking foodstuffs, essences for food (except essences for cooking foodstuffs), essences for food (except ethereal essences and essential oils), malt extracts for food, starch from roots and tubers, for food, ferments for pastes, bean flour, wheat flour, dishes made with flour, corn flakes, royal jelly for human consumption (not for medical purposes), glucose for food, candy, chewing gum not for medical purposes, pastilles (confectionery), fruit pastes (confectionery), gruel, with a milk base, for food, puddings, gluten for food, groats for human consumption, leaven, yeast, cornflour, grilled corn, popcorn, malt extracts for food, malt for food, mayonnaise, molasses, non-medicinal infusions, honey, bread, unleavened bread, gingerbread, crackers, flour-milling products, mustard, noodles, barley flour, maize flakes, pepper, potato flour for food, cake powder, pralines, propolis for human consumption (product of beekeeping), liquorice (confectionery), rice, sauces (condiments), semolina, soya flour, sherbets (edible ices), sugar, sugar candy for food, tapioca, tapioca flour for food, tea, iced yogurt (edible ices), cooked meals and dishes made from flours, cereals, cereal preparations, farinaceous food pastes, rice, cocoa, chocolate, coffee or tea; dietetic dishes and cooked meals not for medical purposes made with flours, cereals, cereal preparations, farinaceous food pastes, rice, cocoa, chocolate, coffee or tea; dietetic food products, food supplements and meal substitutes, not for medical purposes, made with flours, cereals, cereal preparations, salt, vinegar, spices, seaweed (condiments), farinaceous food pastes, starch for food, flavorings other than essential oils, flavoring preparations for food, cocoa, coffee, coffee flavorings, plant preparations as coffee substitutes, green coffee, chicory (coffee substitute), chocolate, condiments, natural sweeteners, thickening agents for cooking foodstuffs, essences for food (except ethereal essences and essential oils), malt extracts for food, starch from roots and tubers, for food, ferments for pastes, royal jelly for human consumption (not for medical purposes), glucose for food, gluten for food, groats for human consumption, leaven, yeast, processed corn, malt for food, molasses, honey, flour-milling products, mustard, pepper, propolis for human consumption (product of beekeeping), rice, semolina, sugar, tea, rusks and dietetic rusks not for medical purposes, cookies and dietetic cookies not for medical purposes, beers, mineral and aerated waters and other non-alcoholic beverages, fruit juices and fruit drinks, syrups and preparations for making beverages, non-alcoholic aperitifs, essences for preparing beverages, pastilles for effervescing beverages, beverage powders, isotonic beverages,

energy beverages, syrups for beverages, non-alcoholic cocktails, table waters, preparations for making aerated water, non-alcoholic fruit extracts, vegetable juices (beverages), sodas, sherbets (beverages)

**Class: 38**

Telecommunications, rental of access time to global information media, providing discussion forums on the Internet, providing access to databases, providing telecommunication channels intended for the on-line purchase of goods, telecommunication information, electronic messaging, transmission of messages, of data, of information

**Class: 41**

Training, entertainment, modeling agencies for advertising purposes, club services (entertainment, education or training), arranging of colloquiums, congresses, seminars, conferences, sports competitions, operation of non-downloadable electronic publications on-line, practical training (demonstration), digital imaging services, information on training or entertainment, electronic desktop publishing, arranging and conducting of training workshops, publication of texts other than publicity texts, electronic publication of periodicals on-line, rental of sports equipment other than vehicles

**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.