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17 December 2014

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

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

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

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**International Registration No:** 1223814

**Our Reference No:** 1660720

**Applicant:** SAGEMCOM BROADBAND SAS



**Trade mark:** SWAN S

**Your ref:** 831967601

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**Examiner:** Derek White

Report No. 1

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 **17 March 2016** (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.

## 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:

1016842, 1163648, 1166172, 1353055, 1497150

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

**Class 9:** All of the goods claimed in this class.

**Class 42:** All of the goods claimed in this class.

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

Derek White for  
REGISTRAR OF TRADE MARKS

Examiner's Telephone Contact: (02) 6222 3625

## 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 : 1016842

**Word:** SWANN ACTIV8

**Image:**

**Class/es:** 9, 36

**Status:** Registered/Protected

**Kind:** n/a

**Lodgement date:** 20 August 2004

**Sealing date:** 27 June 2005

**Acceptance adv:** 17 March 2005

**Registered from:** 20 August 2004

**Registration adv:** 14 July 2005

**Renewal due:** 20 August 2024

**Owners:** Swann Insurance (Aust) Pty Ltd  
000-886-680  
Level 26  
388 George Street  
SYDNEY 2000 NSW  
AUSTRALIA

**Address for service:** Griffith Hack  
Level 3  
509 St Kilda Road  
MELBOURNE  
3004 VIC

### Goods & Services:

#### Class: 9

Computer software and systems

#### Class: 36

Insurance; financial affairs; monetary affairs

### Endorsements:

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

# IP Australia

## Trade Mark : 1163648

**Word:** SWANS

**Image:**

**Class/es:** 9, 14, 21, 25, 28, 41

**Status:** Registered/Protected

**Kind:** n/a

**Lodgement date:** 28 February 2007

**Sealing date:** 23 April 2009

**Acceptance adv:** 15 January 2009

**Registered from:** 28 February 2007

**Registration adv:** 14 May 2009

**Renewal due:** 28 February 2017

**Owners:** Australian Football League  
004-155-211  
AFL House  
140 Harbour Esplanade  
DOCKLANDS 3008 VIC  
AUSTRALIA

**Address for service:** K&L Gates  
Level 25 South Tower  
525 Collins Street  
MELBOURNE 3000 VIC

### Goods & Services:

#### Class: 9

Scientific, nautical, surveying, electric, photographic, cinematographic, video, optical, weighing measuring, signalling, checking, life-saving and teaching apparatus and instruments; apparatus and instruments for recording and/or transmission and/or reproduction of sound and/or images; cameras and radios; automatic vending machines, mechanisms for coin-operated apparatus; cash registers and calculating machines, data processing equipment and computer apparatus and instruments; computer operating programs, computer programs, computer software and video game software; magnetic data carriers; recording discs, audio, video, computer and laser tapes, discs, compact discs, cassettes and cartridges; pre-recorded audio, video, computer and laser tapes, discs, compact discs, cassettes and cartridges; CD-ROMs (compact disc ROMs), digital versatile disc ROMs, sound recordings, video recordings, sound and video recordings; video game and computer game tapes, discs, compact discs, cassettes and cartridges; games in class 9; games for use with television receivers and/or computer monitors and/or other separate display apparatus; helmets and fire-extinguishing apparatus; downloadable electronic publications; recorded video discs and tapes; downloadable digital image recordings; downloadable music recordings; parts, fittings and accessories in class 9 for the aforesaid goods, all of the foregoing goods promoting or marketing or otherwise relating to or associated with or indicating a connection with the game or sport of Australian Football

#### Class: 14

Jewellery, costume jewellery, trinkets, horological instruments, chronometric instruments, sundials, clocks, watches, watch bands, watch straps, watch chains, cuff links, tie clips, tie pins, ornamental pins, earrings, jewellery bracelets, jewellery brooches, jewellery medallions, jewellery necklaces, jewellery rings, jewellery pendants, jewellery buckles, jewellery ornaments, jewellery chains, key chains, key ring trinkets, key ring fobs, medals, coins; goods of precious metal or coated therewith namely badges, boxes, cases, containers and household utensils; and parts, fittings and accessories in class 14 for the aforesaid goods, all of the foregoing goods promoting or marketing or otherwise relating to or associated with or indicating a connection with the game or sport of Australian Football

**Class: 21**

Household or kitchen utensils and containers (not of precious metal or coated therewith), but excluding domestic hollow-ware and utensils made of common metal or common metal alloys, including aluminium; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; all of the foregoing goods promoting or marketing or otherwise relating to or associated with or indicating a connection with the game or sport of Australian Football

**Class: 25**

Clothing, apparel, leisure wear, sportswear, uniforms, babywear, underwear, underpants, boxer shorts, singlets, leotards, shirts, sports shirts, blouses, T-shirts, tank tops, skivvies, rugby tops, grandpa tops, shorts, board shorts, tracksuits, warm-up suits, pants, warm-up pants, sweat pants, trousers, jeans, dresses, skirts, clothing belts, knitwear, jumpers, sweaters, guernseys, jerseys, cardigans, vests, neckwear, cravats, neckties, scarves, jackets, bomber jackets, blazers, formal wear, suits, coats, parkas, anoraks, rainwear, raincoats, swimsuits, sleepwear, pyjamas, nightshirts, night gowns, dressing gowns, bath robes, cloth bibs, aprons, clothing gloves, mittens, headwear, hats, caps, berets, beanies, ear muffs, clothing hoods, visors, headbands, wristbands, socks, stockings, hosiery, footwear, shoes, boots, sandals and slippers, all of the foregoing goods promoting or marketing or otherwise relating to or associated with or indicating a connection with the game or sport of Australian Football

**Class: 28**

Games, playthings, playing cards, gymnastic and sporting goods in class 28, balls for games, playballs, rubber action balls, foam action balls, balls for sports, golf balls, footballs, toy footballs, miniature footballs, pumps for inflating sporting balls, needles for such pumps, sports gloves, football gloves, golf gloves, golf bags, golf tees, exercise and physical training apparatus and articles, toys, toy vehicles, toy cars, dolls, jigsaw puzzles, board games; coin operated games, coin freed games; self contained apparatus and instruments for playing games including mechanical games, electronic games, computerised games, battery operated games, games that are portable, games that include a built-in display, games that include a built-in program, games that receive one or more programs; hand held portable self contained apparatus and instruments for playing games; Christmas tree stands, synthetic Christmas trees and Christmas tree decorations; parts, fittings and accessories in class 28 for the aforesaid goods; video games and computer games for playing in game arcades and game playing venues; electronic video arcade game machines, all of the foregoing goods promoting or marketing or otherwise relating to or associated with or indicating a connection with the game or sport of Australian Football

**Class: 41**

Entertainment, amusement and recreation; cultural activities; sporting activities, sport competitions, sport matches, sport games, sport exhibitions, sport events, hosting sport award functions, sport information, education, sport education, physical education,



coaching, sport coaching, physical coaching, training, sport training, physical training; publication of books, magazines, pamphlets and printed matter (other than publicity texts); library services, video library facilities and video storage facilities; museum services; radio and television entertainment; film, video, radio and television production; hire of film, video and sound recordings; gaming, provision of gaming machines and provision of gaming facilities; operating lotteries; football competitions, football matches, football games, football exhibitions, football events, football telecasts entertainment, football broadcasts entertainment, football education, football information, football awards, football coaching, arranging football clinics, conducting football clinics; production of football videos and films; football mascot performances, football cheer leader performances and dance team performances, all of the foregoing services promoting or marketing or otherwise relating to or associated with or indicating a connection with the game or sport of Australian Football

**Endorsements:**

Provisions of subsection 41(5) applied.\* Provisions of subsection 44(4) and/or Reg 4.15A(5) applied.\*

# IP Australia

## Trade Mark : 1166172

**Word:** SWANN  
**Image:** WING,STYL. IN DISC; 2 CHARACTERS,CHINESE

**Class/es:** 9  
**Status:** Registered/Protected  
**Kind:** n/a  
**Lodgement date:** 15 March 2007  
**Sealing date:** 10 June 2008  
**Acceptance adv:** 28 February 2008  
**Registered from:** 15 March 2007  
**Registration adv:** 26 June 2008  
**Renewal due:** 15 March 2017

**Owners:** Swann Communications Pty Ltd  
4/650 Church Street  
RICHMOND 3121 VIC  
AUSTRALIA

**Address for service:** Collison & Co  
GPO Box 2556  
ADELAIDE 5001 SA

### Goods & Services:

#### Class: 9

Access control equipment and systems; antennas; anti-theft warning apparatus; alarms and alarm systems; intrusion and theft detectors; baby monitors; cables electric; cables (coaxial -); cameras cinematographic; cameras (photography); electrical, electronic, optical and photographic equipment and systems; electric locks; electronic security devices and systems, electric doorbells; intrusion and theft detectors; lenses (optical -); monitoring, measuring control and surveillance equipment and systems; monitoring apparatus; peepholes (magnifying lenses) for doors; pens (electronic); receivers (audio - and video - ); remote control apparatus; security apparatus; security cameras; telephone apparatus; telephone receivers; television monitoring apparatus; theft prevention installations, electric; time recording apparatus for security systems; video recorders and video screens all included in class 9; none of the foregoing being computer software, computer hardware or computer systems

### Endorsements:

The applicant has advised that the Chinese characters appearing in the trade mark may be transliterated as SI WANG and translated into English as THINK HOPE.\*

 **Swann**

思望

 **Swann**

思望

# IP Australia

## Trade Mark : 1353055

**Word:** V SWANS  
**Image:** SWAN,STYLISTED,WINGS-OUTSTRETCHED

**Class/es:** 9, 14, 16, 21, 25, 28, 41  
**Status:** Registered/Protected  
**Kind:** n/a  
**Lodgement date:** 26 March 2010  
**Sealing date:** 10 May 2012  
**Acceptance adv:** 2 February 2012  
**Registered from:** 26 March 2010  
**Registration adv:** 17 May 2012  
**Renewal due:** 26 March 2020

**Owners:** Swan Districts Football Club Inc.  
Steel Blue Oval  
Old Perth Road  
BASSENDEAN 6054 WA  
AUSTRALIA

**Address for service:** Squire Patton Boggs  
Level 10 Gateway  
1 Macquarie Place  
SYDNEY 2000 NSW

### Goods & Services:

#### Class: 9

Scientific, nautical, surveying, electric, photographic, cinematographic, video, optical, weighing measuring, signalling, checking, life-saving and teaching apparatus and instruments; apparatus and instruments for recording and/or transmission and/or reproduction of sound and/or images; cameras and radios; automatic vending machines, mechanisms for coin-operated apparatus; cash registers and calculating machines, data processing equipment and computer apparatus and instruments; computer operating programs, computer programs, computer software and video game software; magnetic data carriers; recording discs, audio, video, computer and laser tapes, discs, compact discs, cassettes and cartridges; pre-recorded audio, video, computer and laser tapes, discs, compact discs, cassettes and cartridges; CD-ROMs (compact disc roms), digital versatile disc ROMs, sound recordings, video recordings, sound and video recordings; video game and computer game tapes, discs, compact discs, cassettes and cartridges; games in class 9; games for use with television receivers and/or computer monitors and/or other separate display apparatus; helmets and fire-extinguishing apparatus; downloadable electronic publications; recorded video discs and tapes; downloadable digital image recordings; downloadable music recordings; parts, fittings and accessories in class 9 for the aforesaid goods, all of the foregoing goods promoting or marketing or otherwise relating to or associated with or indicating a connection with the game or sport of Australian football and netball

#### Class: 14

Jewellery, costume jewellery, trinkets, chronometric instruments, sundials, clocks, watches, watch bands, watch straps, watch chains, cuff links, tie clips, tie pins,

ornamental pins, earrings, jewellery bracelets, jewellery brooches, jewellery medallions, jewellery necklaces, jewellery rings, jewellery pendants, jewellery buckles, jewellery ornaments, jewellery chains, key chains, key ring trinkets, key ring fobs, medals, coins; goods of precious metal or coated therewith namely badges, boxes, cases, containers and household utensils; and parts, fittings and accessories in class 14 for the aforesaid goods, all of the foregoing goods promoting or marketing or otherwise relating to or associated with or indicating a connection with the game or sport of Australian football and netball

**Class: 16**

Paper, cardboard, goods in class 16 made from paper and/or cardboard; printed matter, printed publications, books, magazines, newspapers, activity books, statistical books, guide books, reference books, newsletters, pamphlets, printed programs, printed entertainment programs, printed game programs, printed fixtures; printed matter for the radio, television and print media; exercise books, diaries, calendars, memo pads, folders, note books, multi-ring binders, portfolios, printed statistics sheets, adhesives, trading cards, sports trading cards, football trading cards, mascot trading cards, entertainment trading cards, post cards, greeting cards, note cards, stamps, sports stamps, football stamps, posters, stickers, bumper stickers, decalcomanias, albums, scrap books, autograph books, photographs, mounted photographs, pictures, tickets and control tokens; all of the foregoing goods promoting or marketing or otherwise relating to or associated with or indicating a connection with the game or sport of Australian football or netball

**Class: 21**

Household containers (not of precious metal or coated therewith); sponges; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; all of the foregoing goods promoting or marketing or otherwise relating to or associated with or indicating a connection with the game or sport of Australian football and netball

**Class: 25**

Clothing, shirts, T-shirts, shorts, pants, trousers, knitwear, jumpers, cardigans, sweatshirts, neckwear, neckties, jackets, blazers, suits, coats, scarves, rainwear, swimwear, sleepwear, headwear, hats, caps, socks, footwear, shoes, boots and slippers, all of the foregoing goods promoting or marketing or otherwise relating to or associated with or indicating a connection with the game or the sport of Australian football and netball

**Class: 28**

Games, playthings, playing cards, sporting goods in class 28, balls for games, playballs, rubber action balls, foam action balls, balls for sports, footballs, toy footballs, miniature footballs, pumps for inflating sporting balls, needles for such pumps, sports gloves, football gloves, exercise and physical training apparatus and articles, toys, toy vehicles, toy cars, jigsaw puzzles, board games; coin operated games, coin freed games; self contained apparatus and instruments for playing games including mechanical games, electronic games, computerised games, battery operated games, games that are portable, games that include a built-in display, games that include a built-in program, games that receive one or more programs; hand held portable self contained apparatus and instruments for playing games; parts, fittings and accessories in class 28 for the aforesaid goods; video games and computer games for playing in game arcades and game playing venues; electronic video arcade game machines, all of the foregoing goods promoting or marketing or otherwise relating to or associated with or indicating a connection with the game or sport of Australian football and netball

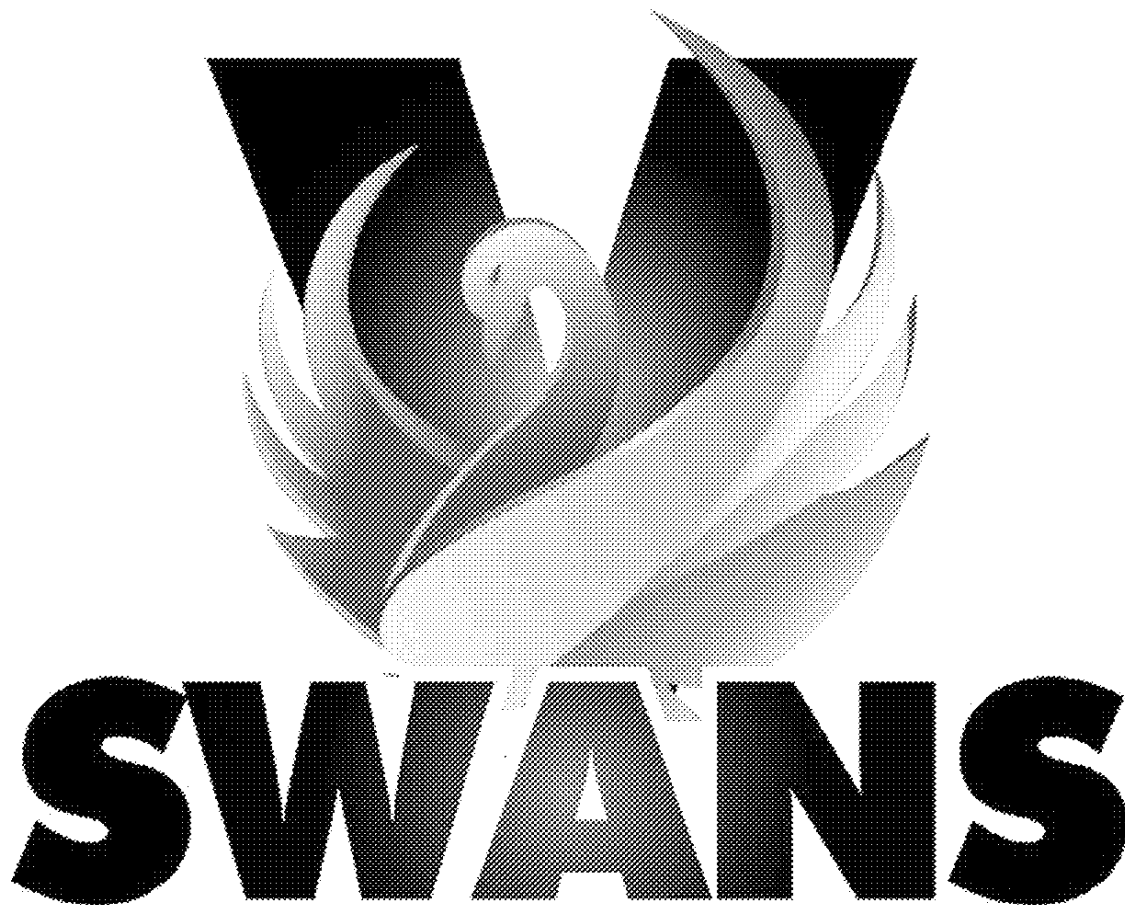
**Class: 41**

Entertainment, amusement and recreation; cultural activities; sporting activities, sport competitions, sport matches, sport games, sport exhibitions, sport events, hosting sport

award functions, sport information, education, sport education, physical education, coaching, sport coaching, physical coaching, training, sport training, physical training; seminars; training courses; workshops; publication of books, magazines, pamphlets and printed matter (other than publicity texts); library services, video library facilities and video storage facilities; museum services; radio and television entertainment; film, video, radio and television production; hire of film, video and sound recordings; gaming, provision of gaming machines and provision of gaming facilities; operating lotteries; football and competitions, football and netball matches, football and netball games, football and netball exhibitions, football and netball events, football and netball telecasts entertainment, football and netball broadcasts entertainment, football and netball education, football and netball information, football and netball awards, football and netball coaching, arranging football and netball clinics, conducting football and netball clinics; production of football and netball videos and films; football and netball mascot performances, football and netball cheer leader performances and dance team performances, all of the foregoing services promoting or marketing or otherwise relating to or associated with or indicating a connection with the game or sport of Australian football and netball

**Endorsements:**

Provisions of paragraph 44(3)(b) and/or Reg 4.15A(3)(b) applied.\*



# IP Australia

## Trade Mark : 1497150

**Word:** SWANN  
**Image:** WING,STYL. IN DISC

**Class/es:** 9, 16, 35  
**Status:** Registered/Protected  
**Kind:** n/a  
**Lodgement date:** 19 June 2012  
**Sealing date:** 8 March 2013  
**Acceptance adv:** 29 November 2012  
**Registered from:** 19 June 2012  
**Registration adv:** 14 March 2013  
**Renewal due:** 19 June 2022

**Owners:** Swann Communications Pty Ltd  
4/650 Church Street  
RICHMOND 3121 VIC  
AUSTRALIA

**Address for service:** Shelston IP  
Level 21  
60 Margaret Street  
SYDNEY 2000 NSW

### Goods & Services:

#### Class: 9

Access control equipment and systems; antennas; anti-theft warning apparatus; alarms and alarm systems; intrusion and theft detectors; baby monitors; cables electric; cables (coaxial); cameras (cinematographic); cameras (photography); electrical, electronic, optical and photographic equipment and systems; electronic locks; electronic security devices and systems; electric door bells; intrusion and theft detectors; lenses (optical); monitoring, measuring control and surveillance equipment and systems; monitoring apparatus; peepholes (magnifying lenses) for doors; pens (electronic); receivers (audio and video); remote control apparatus; security apparatus; security cameras; telephone apparatus; telephone receivers; television monitoring apparatus; theft prevention installations, electric; time recording apparatus for security systems; video recorders and video screens; none of the foregoing being computer software, computer hardware or computer systems

#### Class: 16

Paper and paper products; cardboard and cardboard products; flyers; pamphlets; calendars; cards; labels; letters; newsletters; writing paper; printed matter; printed publications; catalogues; information and instruction manuals; printed forms; advertisements; envelopes; adhesive printed stickers

#### Class: 35

Advertising services; advertising and promotion services via a global communications network in respect of access control equipment and systems, antennas, anti-theft warning apparatus, alarms and alarm systems, intrusion and theft detectors, baby monitors, cables electric, cables (coaxial), cameras (cinematographic), cameras (photography), electrical, electronic, optical and photographic equipment and systems,

electronic locks, electronic security devices and systems, electric door bells, intrusion and theft detectors, lenses (optical), monitoring, measuring control and surveillance equipment and systems, monitoring apparatus, peepholes (magnifying lenses) for doors, pens (electronic), receivers (audio and video), remote control apparatus, security apparatus, security cameras, telephone apparatus, telephone receivers, television monitoring apparatus, theft prevention installations, electric, time recording apparatus for security systems, video recorders and video screens, navigation apparatus for vehicles in the nature of onboard computers, remote controlled helicopters

**Endorsements:**

Colour Series Description: The device in the first trade mark in the series of trade marks is depicted in BLUE as shown in the representation attached to the application form.\*





## **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.