



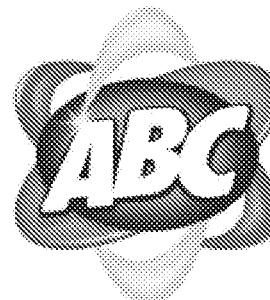
31 March 2016

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)

International Registration No: 1291862  
Our Reference No: 1757917  
Applicant: ABC DETERJAN SANAYI VE  
TICARET ANONIM SIRKETI  
Trade mark: ABC  
Your ref: 944968501



Examiner: Jaimie Ringering

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 30 June 2017 (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.

## ***Basis of the Report***

The following issues have been raised under the ***Trade Marks Act 1995*** and will need to be addressed before your trade mark can be accepted:

- Section 44 – Trade Marks Which Are Similar To Other Trade Marks

## 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 mark(s), and is for similar or closely related goods and/or services:

**476622, 847355, 973321, 1209352, 1209353, 1357977, 1468173, 1566119, 1576669**

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

**Class 3:** *Bleaching and cleaning preparations, detergents other than for use in manufacturing operations and for medical purposes, stain removers; dishwasher detergents; perfumery; cosmetics; fragrances; deodorants for personal use and animals; soaps*

**Class 5:** *Pharmaceutical and veterinary preparations for medical purposes; sanitary preparations for medical use; hygienic pads; hygienic tampons; plasters; materials for dressings*

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.

Jaimie Ringering for  
REGISTRAR OF TRADE MARKS

Examiner's Telephone Contact: 0262837916

**IP Australia**  
**Trade Mark : 476622**

**Word:** ABC  
**Class(es):** 5  
**Status:** Registered/Protected  
**Kind:** n/a  
**Lodgement date:** 17 November 1987  
**Sealing date:** 12 December 1991  
**Registered from:** 17 November 1987  
**Registered adv:** 2 January 1992  
  
**Owner(s):** Beiersdorf Aktiengesellschaft  
Unnastrasse 48  
D-20245  
Hamburg  
GERMANY

**Address for service:** Shelston IP Pty Ltd.  
Level 21  
60 Margaret Street  
SYDNEY  
NSW  
2000  
AUSTRALIA

**Goods & Services:**

5      Medicated plasters

**Endorsements:**

The provisions of sub-section 26(2) applied\* The preceding endorsement(s) were recorded prior to commencement of the Trade Marks Act 1995.\*

**IP Australia**  
**Trade Mark : 847355**

**Word:** ABCFlex  
**Class(es):** 10  
**Status:** Registered/Protected  
**Kind:** n/a  
**Lodgement date:** 22 August 2000  
**Sealing date:** 5 March 2001  
**Convention details:** 75/936 162 6 March 2000  
**Registered from:** 22 August 2000  
**Registered adv:** 22 March 2001

**Owner(s):** Conmed Corporation  
310 Broad Street  
Utica, N.Y. 13501  
UNITED STATES OF AMERICA

**Address for service:** Griffith Hack  
GPO Box 1285  
MELBOURNE  
VIC  
3001  
AUSTRALIA

**Goods & Services:**

10 Medical devices including probes for gastroenterology and gastrointestinal surgery

**IP Australia**  
**Trade Mark : 973321**

**Word:** ABC DERM  
**Class(es):** 3  
**Status:** Registered/Protected  
**Kind:** n/a  
**Lodgement date:** 7 August 2003  
**Sealing date:** 29 March 2004  
**Registered from:** 7 August 2003  
**Registered adv:** 22 April 2004

**Owner(s):** Laboratoire Bioderma  
75, cours Albert Thomas  
F-69003 Lyon  
FRANCE

**Address for service:** Griffith Hack  
GPO Box 1285  
MELBOURNE  
VIC  
3001  
AUSTRALIA

**Goods & Services:**

3      Cosmetic products, namely dermocosmetic preparations for skin care, for children and infants

**Endorsements:**

Trade Mark Description: Colour Claimed: The letters ABC are written in white in blue cubes, the term DERM is written in blue. \*



**IP Australia**  
**Trade Mark : 1209352**

**Word:** ABC ARBONNE BABY CARE  
**Class(es):** 3  
**Status:** Registered/Protected  
**Kind:** n/a  
**Lodgement date:** 8 November 2007  
**Sealing date:** 28 April 2008  
**Convention details:** 77272547 5 September 2007  
**Registered from:** 8 November 2007  
**Registered adv:** 8 May 2008

**Owner(s):** Arbonne International, LLC  
9400 Jeronimo Road,  
Irvine, California,  
92618,  
UNITED STATES OF AMERICA

**Address for service:** Addisons Lawyers  
GPO Box 1433  
SYDNEY  
NSW  
2001  
AUSTRALIA

**Goods & Services:**

3 Non-medicated skin care preparations; hair care preparations; sun screen; lotions; creams, and baby oil

# IP Australia

## Trade Mark : 1209353

**Word:** ABC ARBONNE BABY CARE  
**Class(es):** 3  
**Status:** Registered/Protected  
**Kind:** n/a  
**Lodgement date:** 8 November 2007  
**Sealing date:** 28 April 2008  
**Convention details:** 77272555 5 September 2007  
**Registered from:** 8 November 2007  
**Registered adv:** 8 May 2008

**Owner(s):** Arbonne International, LLC  
9400 Jeronimo Road,  
Irvine, California,  
92618,  
UNITED STATES OF AMERICA

**Address for service:** Addisons Lawyers  
GPO Box 1433  
SYDNEY  
NSW  
2001  
AUSTRALIA

### Goods & Services:

- 3 Non-medicated skin care preparations; hair care preparations; sun screen; lotions; creams, and baby oil





IP Australia  
**Trade Mark : 1357977**

**Word:** ABC  
**Class(es):** 3  
**Status:** Registered/Protected  
**Kind:** n/a  
**Lodgement date:** 22 April 2010  
**Sealing date:** 22 March 2012  
**Registered from:** 22 April 2010  
**Registered adv:** 29 March 2012

**Owner(s):** ABC Tissue Products Pty Limited  
34-36 Redfern Street  
WETHERILL PARK  
NSW  
2164  
AUSTRALIA

**Address for service:** FB Rice  
Level 23  
44 Market Street  
SYDNEY  
NSW  
2000  
AUSTRALIA

**Goods & Services:**

3 Soaps and detergents including foam soap and liquid hand soap

**Endorsements:**

Provisions of paragraph 44(3)(b) and/or Reg 4.15A(3)(b) applied.\* Provisions of subsection s44(4) and/or Reg 4.15A(5) applied. \*



**IP Australia**  
**Trade Mark : 1468173**

**Word:** ABC  
**Class(es):** 5  
**Status:** Registered/Protected  
**Kind:** n/a  
**Lodgement date:** 7 December 2011  
**Sealing date:** 14 October 2013  
**Registered from:** 7 December 2011  
**Registered adv:** 17 October 2013

**Owner(s):** FOSHAN NANHAI DANZAO XINNONG ZHONGXING LEATHER  
PRODUCTS FACTORY  
Hengjiang Development Zone, Danzao,  
Nanhai, Foshan Guangdong  
CHINA

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

**Goods & Services:**

5 Sanitary napkins; sanitary pads; sanitary panties



**IP Australia**  
**Trade Mark : 1566119**

**Word:** ABC Pure+  
**Class(es):** 5  
**Status:** Registered/Protected  
**Kind:** n/a  
**Lodgement date:** 10 July 2013  
**Sealing date:** 13 February 2014  
**Registered from:** 10 July 2013  
**Registered adv:** 20 February 2014

**Owner(s):** Glory Tea Pty Ltd  
566 Station St  
BOX HILL  
VIC  
3128  
AUSTRALIA

**Address for service:** Glory Tea Pty Ltd  
566 Station St  
BOX HILL  
VIC  
3128  
AUSTRALIA

**Goods & Services:**

- 5 Milk foods for infants; Milk powder for babies; Milk powder for foodstuffs for babies; Milk powder for nutritional purposes for babies; Milk powders (foodstuff for babies)

# IP Australia

## Trade Mark : 1576669

**Word:** ABC SHOE MARKET  
**Class(es):** 3,25,40  
**Status:** Registered/Protected  
**Kind:** n/a  
**Lodgement date:** 27 August 2013  
**Sealing date:** 24 March 2014  
**Registered from:** 27 August 2013  
**Registered adv:** 27 March 2014

**Owner(s):** Viktor Listopad  
5505/501 Adelaide St  
BRISBANE  
QLD  
4000  
AUSTRALIA

Victoria Listopad  
5505/501 Adelaide St  
BRISBANE  
QLD  
4000  
AUSTRALIA

**Address for service:** Viktor Listopad & Victoria Listopad  
5505/501 Adelaide St  
BRISBANE  
QLD  
4000  
AUSTRALIA

### Goods & Services:

- 3      Cleaning preparations for use on shoes; Pastes for cleaning shoes; Pastes for polishing shoes; Polishes for shoes; Shoe cleaners (preparations); Shoe cleaning materials (preparations); Shoe cleaning preparations; Shoe cream; Shoe dressing preparations; Shoe grease (polish); Shoe polish; Shoe sprays; Shoe wax
- 25      Athletics shoes; Ballet shoes; Basketball shoes; Bath shoes; Bathing shoes; Beach shoes; Canvas shoes; Dance shoes; Deck shoes; Dress shoes; Esparto shoes or sandals; Flat shoes; Football shoes; Formed shoe parts; Gymnastic shoes; Heel protectors for boots and shoes; Hiking shoes; Leather shoes; Men's shoes; Midsoles for boots and shoes; Pads for shoes (other than orthopaedic); Rubber shoes (other than for protection against accident or injury); Running shoes; Shoe insoles, other than for orthopaedic use; Shoe pads, other than for orthopaedic use; Shoes; Shoes for casual wear; Shoes for infants; Shoes for leisurewear; Shoes for sports wear; Slip-on shoes; Soccer shoes; Sporting shoes; Sports shoes; Training shoes; Walking shoes; Wooden shoes; Working shoes (other than for the prevention of accident or injury)
- 40      Shoemaking

## 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.

## **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.

*Note 1:* For deceptively similar see section 10.

*Note 2:* For similar services see subsection 14(2).

*Note 3:* For priority date see section 12.

*Note 4:* The regulations may provide that an application must also be rejected if the trade mark is substantially identical with, or deceptively similar to, a protected international trade mark or a trade mark for which there is a request to extend international registration to Australia: see Part 17A.

- 3) If the Registrar in either case is satisfied:
  - a) that there has been honest concurrent use of the 2 trade marks; or
  - b) that, because of other circumstances, it is proper to do so; the Registrar may accept the application for the registration of the applicant's trade mark subject to any conditions or limitations that the Registrar thinks fit to impose. If the applicant's trade mark has been used only in a particular area, the limitations may include that the use of the trade mark is to be restricted to that particular area.

*Note:* For limitations see section 6.

- 4) If the Registrar in either case is satisfied that the applicant, or the applicant and the predecessor in title of the applicant, have continuously used the applicant's trade mark for a period:
  - a) beginning before the priority date for the registration of the other trade mark in respect of:
    - i) the similar goods or closely related services; or
    - ii) the similar services or closely related goods; and
  - b) ending on the priority date for the registration of the applicant's trade mark; the Registrar may not reject the application because of the existence of the other trade mark.

*Note 1:* An authorised use of the trade mark by a person is taken to be a use of the trade mark by the owner of the trade mark (see subsection 7(3)).

*Note 2:* For predecessor in title see section 6.

*Note 3:* For priority date see section 12.

### **Regulation 17A.13 Use of trade mark**

- 1) The holder of an IRDA:
  - a) must be using, or must intend to use, the trade mark that is the subject of the IRDA in relation to the goods, services or goods and services listed in the IRDA; or
  - b) must have authorised, or intend to authorise, another person to use the trade mark in relation to those goods, services or goods and services; or
  - c) must intend to assign the trade mark to a body corporate that is about to be constituted with a view to the use by the body corporate of the trade mark in relation to the goods, services or goods and services.

- 2) If there is reason to suspect that the holder does not meet a requirement of subregulation (1) in relation to any of the goods or services mentioned in the IRDA, the Registrar may require the holder to make a declaration to the Registrar that those provisions apply to all of those goods and services.

#### **Regulation 17A.14 Specification of goods and services**

- 1) The expression 'all goods', 'all services', 'all other goods' or 'all other services' must not be used in an IRDA to specify the goods or services in respect of which protection is sought.
- 2) If a term has been identified by the International Bureau as being:
- a) too vague for the purposes of classification; or
  - b) incomprehensible; or
  - c) linguistically incorrect;

the term must not be used in an IRDA to specify the goods or services in respect of which protection is sought, unless the Registrar is satisfied that the term is sufficiently clear in the circumstances.

#### **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.