



11 July 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: 1251408  
Our Reference No: 1773072  
Applicant: Internet group d.o.o.  
Trade mark: TESLA  
Your ref: 958747001



Examiner: Bonita Ko

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 11 October 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:

**744677, 1648569, 1677969, 1691827, 1713420, 1713421**

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

**Class 7:** *Electric blenders for household use; bottle washing machines; central vacuum cleaning installations; cleaning appliances utilizing steam; degreasers [machines]; dishwashers; high pressure washers; electric machines and apparatus for polishing; electric shoe polishers; spin driers; vacuum cleaner accessories for disseminating perfumes and disinfectants; vacuum cleaner hoses; vacuum cleaners; vacuum cleaner bags; laundry washing machines; washing apparatus; coin-operated washing machines; whitewashing machines; ironing machines; aerated beverage-making machines; aerated water making apparatus; electric beaters; electromechanical apparatus for beverage preparation; bread cutting machines; brewing machines; butter machines; churns; coffee grinders, other than hand-operated; cream/milk separators; electric food processors; apparatus for drawing up beer under pressure; flour mill machines; electric food processors; electromechanical food preparation machines; electric fruit presses for household use; grating machines for vegetables; electric food mills; kneading machines; meat choppers [machines]; mills for household use other than hand-operated; apparatus for making mineral water; machines for making pasta; pepper mills other than hand-operated; electric whisks for household use*

**Class 9:** *Coin-operated mechanisms for television sets; television apparatus; empty toner cartridges for printers and photocopiers; 3D spectacles; electric accumulators; acidimeters for batteries; acoustic conduits; acoustic couplers; acoustic [sound] alarms; adding machines; antennas; aerometers; electric alarm bells; alarms (instruments); alcohol meters; alidades; altimeters; ammeters; amplifiers; telephone answering machines; anti-glare visors; anti-glare glasses; anti-interference devices [electricity]; anti-theft warning apparatus; apertometers [optics]; apparatus and instruments for astronomy; receivers [audio, video]; audiovisual teaching apparatus; audio and video devices for monitoring babies; balances [steelyards]; balancing apparatus; barcode readers; barometers; electric accumulators for vehicles; batteries for lighting; electric cells (batteries); battery jars; accumulator boxes; battery chargers; luminous beacons; bells [warning apparatus]; betatrons; blueprint apparatus; boiler control instruments; branch boxes [electricity]; buzzers; calibrating rings; calipers; photographic apparatus; cassette players; cell switches [electricity]; apparatus for charging electric accumulators; chips [integrated circuits]; breakers (circuit breakers); circuit closers; calculating disks; cleaning apparatus for sound recording discs; compact disc players; comparators; compasses [measuring instruments]; computers; game software; recorded computer operating system programs; software [recorded programs]; recorded computer programs; computer programs [downloadable software]; downloadable computer software applications; computer keyboards; computer peripheral devices; computer memories; electric conductors; control panels [electricity]; electric converters; counters; couplers [data processing equipment]; electric couplings; current rectifiers; cyclotrons; darkroom lamps [photography]; data processing apparatus; detectors; metal detectors for industrial or military use; diagnostic apparatus not for medical use; dictating machines; diffraction apparatus [microscopy]; digital photo frames; directional compasses; disk drives [for computers]; distance measuring apparatus; distance recording apparatus; distribution boards [electricity]; distribution boxes [electricity]; distribution consoles [electricity]; dNA chips; dog whistles; electric door bells; downloadable music files; downloadable image files; downloadable ringtones for mobile telephones; electric ducts; downloadable electronic publications; electronic notice boards; electronic pens (visual display units); electronic pocket translators; electronic agendas; e-book readers; electronic tags for goods; magnetic identification bracelets; encoded magnetic cards; encoded key cards; enlarging apparatus [photography]; epidiascopes; ergometers; facsimile machines; apparatus for fermentation [laboratory apparatus]; galvanic batteries; global positioning system gps apparatus; headphones; heat regulating apparatus; heliographic apparatus; hemline markers; holograms; horns for loudspeakers; identification sheaths for electric wires; magnetic identity cards; automatic indicators of low pressure in vehicle tires; inductors [electricity]; memory cards or integrated circuit cards; integrated circuits; intercommunication apparatus; interfaces [for computers]; invoicing machines; ionization apparatus not for the treatment of air or water; jigs [measuring instruments]; juke boxes for computers; coin-operated musical automata [juke boxes]; junction sleeves for electric cables; lactodensimeters; lactometers; portable computers; bags designed for laptop computers; covers for laptop computers;*

notebook computers; electronic tablets; lasers not for medical use; light-emitting diodes [LED]; lighting ballasts; lightning conductors [rods]; electric locks; logs [measuring instruments]; electric loss indicators; loudspeakers; sound transmitting apparatus; sounding apparatus and machines; magic lanterns; magnetic tapes; magnetic tape units [for computers]; magnetic encoders; magnetic wires; magnets; magnifying glasses [optics]; marking gages [joinery]; masts for wireless aerials; mathematical instruments; megaphones; memory cards for video game machines; mercury levels; meteorological balloons; meteorological instruments; metronomes; microphones; microprocessors; microscopes; kilometer recorders for vehicles; modems; money counting and sorting machines; electric monitoring apparatus; monitors [computer programs]; monitors [computer hardware]; mouse [computer peripheral]; mouse pads; navigation apparatus for vehicles [on-board computers]; navigational instruments; optical disks; optical data media; optical lamps; optical goods; photocopiers; photometers; apparatus for use in phototelegraphy; photovoltaic cells; apparatus and instruments for physics; plane tables [surveying instruments]; planimeters; x-Y plotters; plumb lines; pocket calculators; polarimeters; portable media players; printed circuits; printed circuit boards; printers for use with computers; prisms [optics]; probes for scientific use; processors [central processing units]; projection screens; projection apparatus; readers [data processing equipment]; record players; reflecting disks, for wear, for the prevention of traffic accidents; refractometers; refractors; remote control apparatus; satellite navigation apparatus; scanners [data processing equipment]; screens [photography]; screens for photoengraving; screw-tapping gauges; semi-conductors; slide projectors; slide-rules; smartphones; sockets, plugs and other contacts [electric connections]; solar batteries; sound recording strips; speed checking apparatus for vehicles; speed indicators; speed regulators for record players; spherometers; spirit levels; spools [photography]; step-up transformers; personal stereos; stereoscopes; stereoscopic apparatus; switchboards; switchboxes [electricity]; switches; tachometers; tape recorders; taximeters; teaching apparatus; telephone apparatus; telephone transmitters; portable telephones; hands-free kits for telephones; radiotelegraphy sets; telephone receivers; telephone wires; teleprinters; teleprompters; telerupters; telescopes; temperature indicators; labels indicating temperature, other than for medical purposes; terminals [electricity]; material testing instruments and machines; thermometers, not for medical use; thermostats; thermostats for vehicles; thread counters; ticket dispensers; automatic time switches; time recording apparatus; time clocks [time recording devices]; tone arms for record players; totalizers; road traffic cones; traffic-light apparatus [signaling devices]; transmitters of electronic signals; transmitters [telecommunication]; transmitters [telecommunication]; transponders; triodes; urinometers; uSB flash drives; vacuum tubes [radio]; vacuum gauges; variometers; vehicle radios; vehicle breakdown warning triangles; verniers; video telephones; video cassettes; video game cartridges; video recorders; video screens; video devices for monitoring babies; videotapes; voltage surge protectors; voting machines; boards for integrated circuits; walkie-talkies; weighbridges; weighing machines; weighing apparatus and instruments; weights; whistle alarms; wire connectors [electricity]; electric wires; wrist rests for use with computers

**Class 11:** Lamp reflectors; lamps for lighting; electric lamps; electric light bulbs; light bulbs; light-emitting diode [LED] lighting apparatus; lighters; lighting apparatus and installations; electric lights for Christmas trees; flashlights; safety lamps; street lamps; flashlights for lighting; luminous tubes for lighting; beverage-cooling apparatus; electric coffee percolators; electric coffee machines; electric cooking utensils; cooking apparatus and installations; electric appliances for making yogurt; filters for drinking water; electric fans for personal use; hair driers; hand-drying apparatus for washrooms; air driers; desiccating apparatus; driers [apparatus]; drying apparatus and installations; electric laundry driers; cooling installations and machines; cooling apparatus and installations; cooling installations for liquids; freezers; ice machines and apparatus; ice cube machines; milk-cooling equipment; refrigerating cabinets; refrigerating chambers; refrigerating display cabinets [display cases]; refrigerating containers; refrigerating apparatus and installations; refrigerators; germicidal lamps for purifying air

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.

Bonita Ko for  
REGISTRAR OF TRADE MARKS

Examiner's Telephone Contact: 0262832276

# IP Australia

## Trade Mark : 744677

**Word:** TESLA  
**Class(es):** 9,11  
**Status:** Registered/Protected  
**Kind:** n/a  
**Lodgement date:** 23 September 1997  
**Sealing date:** 13 August 1999  
**Registered from:** 23 September 1997  
**Registered adv:** 2 September 1999

**Owner(s):** TESLA Holding a.s.  
Prague 9,  
Hloubetin,  
Podebradska 56/186, 180 66  
CZECH REPUBLIC

**Address for service:** Griffith Hack  
GPO Box 4164  
SYDNEY  
NSW  
2001  
AUSTRALIA

### Goods & Services:

- 9 Thermionic devices, including valves, cathode ray tubes, magnetrons and photomultipliers; electric and electronic circuit devices, including transformers, inductors, capacitors, resistors, thermistors and potentiometers; semiconductor devices, including diodes, transistors, thyristors, diacs and triacs; integrated circuits and hybrid integrated circuits; data processing apparatus and instruments, including electronic processors, microprocessors and memory devices; computing apparatus and instruments, including computer hardware and computer peripherals; computer software stored in memory devices, on tape and on disks; lasing devices and instruments, including laser devices for recording, transmitting, communicating and measuring purposes; optoelectronic devices and instruments; telecommunication apparatus and instruments, including telephones, telephone switching systems and automatic telephone exchanges; oscilloscopes, electron microscopes, spectrometers, spectrophotometers, nuclear resonance spectrometers and particle accelerators; meteorological apparatus and instruments; radar signal generating and transmitting/receiving apparatus and instruments; navigation apparatus and instruments; ultrasonic transmitting, receiving, recording and imaging apparatus and instruments; apparatus and instruments for use in recording, storing, transmitting and reproducing data, audio information and video information; apparatus and instruments for use in generating, transmitting and receiving radio and/or television signals, including radio and television recording and broadcasting studio equipment, transmitters, relay systems, ground-terminal satellite stations, and radio and television monitors, receivers and recorders; transmitting and receiving antennae; information recording and/or storing devices, including magnetic encoding data carriers, tapes, records and disks; electric batteries; traffic control and signalling apparatus, devices and systems; electric and electronic alarm systems; electrical connectors; parts, fittings, components; accessories and cases in class 9 for the aforesaid goods; with the exclusion of transformers for producing high voltages at high frequencies and instruments which measure, are calibrated in or give read-outs using units of magnetic flux density or magnetic density
- 11 Lighting apparatus and devices; light emitting devices in class 11; electric lamps, including incandescent lamps, fluorescent lamps, compact fluorescent lamps and glow discharge tubes



# IP Australia

## Trade Mark : 1648569

**Word:** TESLA  
**Class(es):** 9  
**Status:** Accepted  
**Kind:** n/a  
**Lodgement date:** 23 September 2014

**Owner(s):** Global Electrical Supplies Pty Limited  
4-8 Ferndell St  
GRANVILLE  
NSW  
2142  
AUSTRALIA

**Address for service:** Spruson & Ferguson  
GPO Box 3898  
SYDNEY  
NSW  
2001  
AUSTRALIA

### Goods & Services:

- 9 Apparatus for connecting electrical circuit components; apparatus for controlling the supply of electrical current; apparatus for electrical safety protection; apparatus for protecting computers from electrical power supply faults; apparatus for the control of power supply to electrically driven motors; ballasts for electrical lighting fittings; blanking plates adapted for electrical connections; cable glands for use with electrical apparatus; cable reels (non-mechanical) incorporating electrical sockets; components for over-voltage protection for electrical apparatus; connectors being electrical terminals; ducts for electrical wiring; electrical apparatus for controlling the speed of motors; electrical apparatus for converting alternating current to direct current; electrical cable; electrical cable connectors; electrical cables for connecting computers; electrical circuit breakers; electrical circuit components; electrical circuit control devices; electrical communication apparatus for transmitting data; electrical communications cables; electrical components; electrical components for use with television aerials; electrical conduits; electrical connecting terminal blocks; electrical connection boxes; electrical connection insulation apparatus; electrical connectors; electrical connectors for connecting laptop computers to telephone lines; electrical contact separating devices; electrical contacts; electrical control apparatus; electrical controlling apparatus for motors; electrical controls; electrical converters; electrical couplings; electrical distribution boxes; electrical ducts; electrical enclosures made from sheet steel; electrical extension leads; electrical frequency converters; electrical indicating devices; electrical junction boxes; electrical leads; electrical mains wiring apparatus for use with domestic appliances; electrical plug connectors; electrical plugs; electrical power adaptors; electrical push button panels; electrical push button switch assemblies; electrical push button switches; electrical push buttons being luminous; electrical push switches; electrical relays; electrical sensors; electrical socket outlets protected by residual current devices; electrical sockets; electrical supply units (other than generators); electrical surge arrestors; electrical switch assemblies; electrical switch boards; electrical switch boxes; electrical switch cabinets; electrical switch timers; electrical switches; electrical switchgear; electrical terminal connectors; electrical terminals; electrical tracks for lights; electrical transformers; electrical transformers for use with lighting; electrically conductive metal components for use as earthing; electricity boxes for electrical installations; extensions insulated electrical wires in cord form; female connectors for electrical cables; flexible electrical conductors; flexible electrical conduits; holders for electrical components; indicator lamps showing activation of electrical apparatus; industrial contactor starters (electrical); insulating plates for electrical components; joining units (electrical contacts); junction boxes for electrical circuits; male connectors for electrical



cables; markers for electrical conductors; mounting boards for electrical components; noise suppressors (electrical components); plastic housings adapted for electrical apparatus; plug-in electrical connectors; power distribution apparatus for use in electrical systems; power distributors (electrical); power units for supplying (other than generating) electrical current; sockets (electrical); sockets for electric plugs for use on domestic electrical apparatus; speed regulators (electrical); terminal boxes (electrical); wall plates adapted for electrical components; wall plates for electrical components; wall plates for electrical connections

**Endorsements:**

Evidence and/or other circumstances provided under subsection 41(4).\* Provisions of paragraph s44(3)(a) and/or Reg 4.15A(3)(a) applied.\*

# IP Australia

## Trade Mark : 1677969

**Word:** Tesla  
**Class(es):** 9  
**Status:** Under Examination - Extension Fees Not Required  
**Kind:** n/a  
**Lodgement date:** 1 March 2015

**Owner(s):** Milana Franic  
10 Rockfield St  
EPPING  
VIC  
3076  
AUSTRALIA

**Address for service:** Milana Franic  
10 Rockfield St  
EPPING  
VIC  
3076  
AUSTRALIA

### Goods & Services:

- 9 Battery chargers; Chargers for electric batteries; Consumer type nickel cadmium battery chargers; Electric battery chargers; Portable field chargers; Power supply devices for battery chargers; Apparatus for recharging electrical accumulators; Automotive electric batteries; Automotive electrical components; Batteries for electric vehicles; Batteries, electric, for vehicles; Electric apparatus for use in parking control; Electric apparatus for use in traffic control; Electric apparatus for vehicle problem diagnosis; Electric batteries for land vehicles; Electric batteries for powering electric vehicles; Electric batteries for water vehicles; Electric control apparatus for motor land vehicles; Electric control devices for lifting apparatus; Electric control devices for turbines; Electric door locks; Electric door locks for vehicles; Electric locks for vehicles; Electric operators (switches) for vehicle windows; Electric storage batteries for land vehicle engines; Electric storage batteries for use with motors; Electrical batteries for cars; Electrical charge apparatus; Electrical control apparatus for automatic gates for car parks; Electrical control panels for burglar alarm systems; Electrical control panels for smoke alarm systems; Electrical devices for security purposes in vehicles; Electrical measuring apparatus for use in automobiles; Electrical switches for automobile controls; Electrically heated clothing; Electrically operated speed sensing apparatus for incorporation into vehicles; Mechanical locks (electric, metal) for use in motor vehicles; Mechanical locks (electric, non-metallic) for use in motor vehicles; Releasable locking devices (electric); Reserve electrical power supply apparatus (other than generators); Solar cells for electricity generation; Solar collectors for electricity generation; Solar energy collectors for electricity generation; Solar panels for electricity generation; Solar panels for the production of electricity; Temperature control apparatus (electric switches) for vehicles; Vehicle locks (electric); Wall plates adapted for electrical components; Wall plates for electrical components; Wall plates for electrical connections; Wiring looms and harnesses for vehicles (electric cables)

IP Australia  
**Trade Mark : 1691827**

**Word:** TESLA  
**Class(es):** 3,7  
**Status:** Registered/Protected  
**Kind:** n/a  
**Lodgement date:** 6 May 2015  
**Sealing date:** 5 April 2016  
**Registered from:** 6 May 2015  
**Registered adv:** 7 April 2016

**Owner(s):** Eco Laundry Room (No. 1) Pty Ltd as trustee for Eco Laundry Room I.P  
(No.1) Unit Trust.  
22 Harrington Sq  
ALTONA  
VIC  
3018  
AUSTRALIA

**Address for service:** LLOYDS LEGAL PTY LTD  
L 10  
99 William St  
MELBOURNE  
VIC  
3000  
AUSTRALIA

**Goods & Services:**

- 3 Laundry washing preparations; Powder for washing clothes; Washing soda, for cleaning; Cleaning preparations for laundry use; Cleaning preparations impregnated into cloth; Ironing preparations; Drying agents for dishwashing machines; Detergent rinse aid products for use in dishwashing machines; Rinse additives for dishwashing machines; Commercial laundry detergents; Detergents for laundry use; Fabric softeners (for laundry use); Laundry bleaching preparations; Laundry detergent; Natural starches for laundry purposes; Powder for laundry purposes; Preparations for laundry purposes; Preparations for laundry use; Preparations for soaking laundry; Prepared wax for laundry use; Soaps for laundry use; Softening agents for laundry purposes; Substances for laundry use; Abrasive powder (other than for dental purposes); Abrasive preparations; Scouring powders; Scouring preparations; Scouring solutions; Dry-cleaning preparations
- 7 Coin-operated spin drying machines for laundry use; Dry cleaning (laundry) machines; Laundry folding machines; Laundry presses; Laundry washing machines; Machines for washing laundry (coin-operated); Machines for washing laundry (electric); Washing machines (laundry); Washing machines for laundry; Electric domestic appliances for vacuuming; Electric domestic appliances for washing; Electric household appliances for mixing food; Electric household cleaning appliances; Automatic washing machines; Cloth washing machines; Clothes agitating devices for washing machines; Clothes washing machines; Coin-operated washing machines; Colour-washing machines; Combination washing and drying machines; Combined washing and brushing machines; Combined washing and drying machines; Combined washing machines and tumble driers; Domestic washing machines; Electric domestic machines for washing; Industrial washing machines; Machines for washing clothing (coin-operated); Machines for washing clothing (electric); Mechanical components for washing machines; Washing and/or drying machines; Washing machines; Washing machines incorporating drying facilities; Washing machines incorporating tumble driers; Clothes drying (spin) machines; Electric drying machines; Machines for drying clothes; Vacuum cleaning machines for use in households; Domestic vacuum cleaners; Industrial vacuum machines for cleaning; Cloth spin-dryers; Cloth ironing

machines; Cloth ironing presses; Domestic ironing machines; Domestic pressing (ironing) machines; Electric ironing machines; Electric ironing presses; Electric pressing irons for industrial purposes; Ironing machines for clothing; Dishwashers; Electric food blenders; Electric food mixers; Electric food processors; Electric household apparatus for mixing food; Food waste disposal machines; Machines for dispensing (vending) foods; Clothes pressing machines; Machines for airing clothes; Automatic vending machines; Coin-operated vending machines; Electronic machines for dispensing (vending) beverages; Electronic machines for dispensing (vending) snacks; Liquid dispensing (vending) apparatus; Machines for dispensing (vending) drinks; Machines for dispensing (vending) liquids; Machines for dispensing liquids (other than vending); Machines for issuing (vending) receipts; Machines for issuing (vending) tokens; Vending machines; Vending machines for vouchers; Detergent rinse aid dispensers being parts of dishwashing machines; Automatic door opening apparatus (electric); Blenders, electric, for household purposes; Electric domestic vacuum cleaners; Electric vacuum cleaners for commercial use; Electric vacuum cleaners for domestic use; Electric vacuum cleaners for industrial use; Refrigerated beverage dispensing units (coin-operated); Clothes presses; Electro mechanical clothes presses; Automatic dispensing (vending) machines; Automatic dispensing machines; Automatic distribution (vending) machines; Automatic vending machines for the dispensing of beverages; Electric floor cleaners (vacuuming machines) for domestic use; Electric floor cleaners (vacuuming machines) for industrial use; Electronic machines for dispensing (vending) cold beverages; Electronic machines for dispensing (vending) hot beverages; Floor cleaning (vacuuming) machines; Floor cleaning (washing) machines; Garbage disposal machines; Industrial dry-cleaning machines; Ironing machines; Ironing presses (ironing machines); Liquid dispensing machines for dispensing pre-measured amounts; Liquid dosage machines for dispensing pre-measured amounts; Liquid filtering apparatus (parts of engines or machines); Machines for carpet cleaning (vacuuming); Machines for drying; Pumps being parts of spin drying machines; Pumps being parts of washing machines

# IP Australia

## Trade Mark : 1713420

**Word:** TESLA  
**Class(es):** 9,36,37,42  
**Status:** Under Examination - Extension Fees Not Required  
**Kind:** n/a  
**Lodgement date:** 11 August 2015  
**Convention details:** 86/532390 11 February 2015

**Owner(s):** Tesla Motors, Inc. incorporated in the State of Delaware  
3500 Deer Creek Road, Palo Alto  
California 94304  
UNITED STATES OF AMERICA

**Address for service:** Spruson & Ferguson  
GPO Box 3898  
SYDNEY  
NSW  
2001  
AUSTRALIA

### Goods & Services:

- 9 Electric battery system and equipment for storage and supply of electricity to entire dwellings, buildings, and man-made fixtures; electric battery system and equipment for use in the storage, supply, transmission and stabilization of electricity supplied by or to an electric power grid or other source of electric power generation; computer software for monitoring, optimizing and regulating the storage, transmission and discharge of energy to and from such electric battery systems
- 36 Leasing services relating to electric battery systems for the storage, discharge, supply, transmission and stabilization of electricity; financing services relating to electric battery systems for the storage, discharge, supply, transmission and stabilization of electricity
- 37 Installation, integration, maintenance and repair and upgrading of electric battery systems, and consulting related thereto, for the storage, discharge, supply, transmission and stabilization of electricity
- 42 Monitoring of electric battery systems for storing and supplying electricity; operating, maintaining, optimizing and regulating electric battery systems for storage, discharge, supply, transmission and stabilization of electricity, and consulting services related thereto

### Endorsements:

Convention priority claimed: 11 February 2015, United States of America, No. 86/532390 in respect of ALL ITEMS IN THIS CLASS ARE CLAIMED IN THE CONVENTION APPLICATION in class 9; ALL ITEMS IN THIS CLASS ARE CLAIMED IN THE CONVENTION APPLICATION in class 36; ALL ITEMS IN THIS CLASS ARE CLAIMED IN THE CONVENTION APPLICATION in class 37; ALL ITEMS IN THIS CLASS ARE CLAIMED IN THE CONVENTION APPLICATION in class 42.\*

# IP Australia

## Trade Mark : 1713421

**Word:** TESLA  
**Class(es):** 9,36,37,42  
**Status:** Under Examination - Extension Fees Not Required  
**Kind:** n/a  
**Lodgement date:** 11 August 2015  
**Convention details:** 86/532393 11 February 2015

**Owner(s):** Tesla Motors, Inc. incorporated in the State of Delaware  
3500 Deer Creek Road, Palo Alto  
California 94304  
UNITED STATES OF AMERICA

**Address for service:** Spruson & Ferguson  
GPO Box 3898  
SYDNEY  
NSW  
2001  
AUSTRALIA

### Goods & Services:

- 9 Electric battery system and equipment for storage and supply of electricity to entire dwellings, buildings, and man-made fixtures; electric battery system and equipment for use in the storage, supply, transmission and stabilization of electricity supplied by or to an electric power grid or other source of electric power generation; computer software for monitoring, optimizing and regulating the storage, transmission and discharge of energy to and from such electric battery systems
- 36 Leasing services relating to electric battery systems for the storage, discharge, supply, transmission and stabilization of electricity; financing services relating to electric battery systems for the storage, discharge, supply, transmission and stabilization of electricity
- 37 Installation, integration, maintenance and repair and upgrading of electric battery systems, and consulting related thereto, for the storage, discharge, supply, transmission and stabilization of electricity
- 42 Monitoring of electric battery systems for storing and supplying electricity; operating, maintaining, optimizing and regulating electric battery systems for storage, discharge, supply, transmission and stabilization of electricity, and consulting services related thereto

### Endorsements:

Convention priority claimed: 11 February 2015, United States of America, No. 86/532393 in respect of ALL ITEMS IN THIS CLASS ARE CLAIMED IN THE CONVENTION APPLICATION in class 9; ALL ITEMS IN THIS CLASS ARE CLAIMED IN THE CONVENTION APPLICATION in class 36; ALL ITEMS IN THIS CLASS ARE CLAIMED IN THE CONVENTION APPLICATION in class 37; ALL ITEMS IN THIS CLASS ARE CLAIMED IN THE CONVENTION APPLICATION in class 42.\*

**TESLA**

## 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.