

**EXAMINATION FOR REGISTRATION AS A PATENT AND/OR  
TRADE MARKS ATTORNEY**

**SEPTEMBER 2001**

**SUBJECT C: TRADE MARK LAW**

Time Allowed: 3 ½ hours

Instructions to Candidates

1. Standard required to pass: 50%
2. Reading time: 10 minutes
3. Candidates should attempt ALL FIVE questions
4. The maximum marks for each question are indicated beside the question number
5. Candidates should, where relevant, support their answers by reference to decided cases, and provisions of the Trade Marks Act 1995

**QUESTION ONE (Total – 20 marks)**

Over the last year, Albert has imported and distributed shiploads of saucepans made in Germany by Herman and bearing the trade mark HERMAN. To protect his market, Albert has lodged application to register HERMAN for “Kitchenware including saucepans”.

Albert has been contacted by a Mr Lee, a Taiwanese businessman, who has offered to manufacture exactly the same saucepans for a lower cost. He has ordered a shipment of the saucepans from Taiwan and instructed that the trade mark HERMAN be impressed on each article.

The Examiner’s report has now issued, rejecting Albert’s application on the ground that HERMAN is a common surname and therefore not capable of distinguishing the goods.

Albert consults you on how to deal with the Examiner’s report and also about whether Herman, the German manufacturer, could cause him any difficulty. Albert says he lodged his application before any sale in Australia of the saucepans imported from Germany. However advertisements featuring the saucepans had appeared in magazines published in Europe and sold in Australian newsagents.

Advise Albert.

**QUESTION TWO (Total – 20 marks)**

- (a) To what extent is the use by a company of its own name excepted from actions for infringement by the Trade Marks Act 1995? Is similar protection provided against actions for passing off and breach of S52 of the Trade Practices Act 1994? **(10 marks)**

AND

- (b) What action may be taken to prevent the unauthorised use of an unregistered trade mark in Australia? Is it relevant that the trade mark is not only unregistered but also not prima facie registrable? **(10 marks)**

**QUESTION THREE (Total – 20 marks)**

State briefly the facts, findings and principles of law in the following cases:

- (a) Australian Woollen Mills Ltd v FS Walton and Co (1937) 58 CLR 641 **(5 marks)**
- (b) Con Agra v McCain Foods (Aust) Pty Ltd (1992) 23 IPR 383 **(5 marks)**
- (c) Down to Earth (Victoria) Co-operative Society Ltd v Schmidt (1998) 41 IPR 632 **(5 marks)**
- (d) Re Alex Pirie & Sons Application (1933) 50 RPC 147 **(5 marks)**

**QUESTION FOUR (Total – 20 marks)**

For the past five years Anna has operated several whole-food restaurants in Victoria and she is now contemplating extending into other states. She applied to register her trade mark EXPRESSIONS in March 1998 for “restaurant services” and the mark was registered in January 2000.

Since December 1998 Bob has run a hairdressing salon called CREATIVE EXPRESSIONS in Perth. In March 1999 he set up a small coffee and sandwich bar within the hairdressing salon, selling to customers only at first but later to passers by. Bob applied to register his trade mark for hairdressing services and coffee bar services in June 2000 and the application has been advertised as accepted. Anna’s patent attorney has now written to Bob demanding that he withdraw the application and cease and desist from use of CREATIVE EXPRESSIONS.

Bob comes to you for help telling you that he has never heard of Anna or her EXPRESSIONS restaurants and that he has put up a big sign in his salon saying “We have no connection with Anna’s EXPRESSIONS”.

Referring to relevant principles and appropriate case law, advise Bob.

**QUESTION FIVE (Total – 20 marks)**

Would infringement be found in the following situations? Assume the plaintiff's mark is validly registered in each case.

- (a) The plaintiff owns a registration of EXCITEMENT for softdrinks. The defendant's softdrink is labelled "EXHILARATION (just like EXCITEMENT)". **(4 marks)**
- (b) The plaintiff owns a defensive registration for POLO for "Bed linen". The defendant uses WATER POLO for "Towels". **(4 marks)**
- (c) The plaintiff's registered mark BEAR covers brandy. The defendant uses a device of a polar bear for ginger ale. **(4 marks)**
- (d) The plaintiff owns registrations of FLYING HORSE, WORKING HORSE, REARING HORSE and BUCKING HORSE for motor bikes. The defendant uses LEAPING PONY for non-motorised scooters. **(4 marks)**
- (e) The plaintiff's registration of POWERHOUSE covers "earthmoving equipment" and "rental and leasing of earthmoving equipment". The defendant trades under the business name "Smith's Powerhouse Hire Co", hiring out POWERHOUSE equipment. **(4 marks)**

**END OF PAPER**