

**PROFESSIONAL STANDARDS BOARD FOR PATENT
AND TRADE MARK ATTORNEYS
2001 EXAMINATION**

TOPIC GROUP D - TRADE MARK PRACTICE

Duration: 4 hours plus 10 minutes reading and noting time

Instructions to candidates:

- Candidates should write their candidate number on the front cover of each examination book used;
- Candidates should attempt all six questions;
- The marks allocated to each question are noted beside the question. Based on the marks allocated, a suggested time allowance is also noted;
- Candidates may take into the examination room the Australian Trade Marks Act or any other Australian legislation.

Question 1: 15 marks. Suggested time - allow no more than 35 minutes.

Explain and detail the practice of the Australian Trade Marks Office in relation to:-.

- (a) the registration of trade marks in relation to plants;
- (b) the registration of words which are both surnames and the names of towns or cities (e.g. Ryan, Melbourne and Richmond);
- (c) the advertisement of acceptance of applications which have been accepted within six months of the date of their filing; and
- (d) the filing of an application under section 92 in relation to a trade mark which is the subject of a pending application.

Question 2: 20 marks. Suggested time - allow no more than 45 minutes.

Your client, Fast 'N Tasty, Inc. is the owner of the trade mark "Fast 'N Tasty" in a number of countries of the world and it licences the use of the trade mark under franchise agreements to individual operators that run Fast 'N Tasty cafeteria style restaurants in several countries of the world. Whilst the trade mark is quite well known overseas it has not been used in Australia and is not well known in Australia. Fast 'N Tasty, Inc. filed a trade mark application for registration of the trade mark "Fast 'N Tasty" in Australia in connection with restaurant and cafeteria services on 1 February 2001. Your client's trade mark application has been examined but an objection has been raised under section 41(5). It is asserted by the Examiner that the phrase "Fast 'N Tasty" is descriptive and is not inherently adapted to distinguish the services of the applicant from services of others.

Your client has now discovered that a non related organisation that has called itself Fast 'N Tasty Pty Ltd was incorporated in Australia on 1 July 2001 and has since commenced use of the trade mark "Fast 'N Tasty" in relation to a number of cafeterias in Perth, Western Australia.

The client seeks you advice in connection with the following:-

- (a) what steps can be taken at the present time to prevent Fast 'N Tasty Pty Ltd from using the trade mark "Fast 'N Tasty" in relation to the cafeterias which it is operating in Perth, Western Australia?
- (b) what action can Fast 'N Tasty, Inc. take to secure registration of the trade mark "Fast 'N Easy" in Australia?
- (c) what advice can you give in terms of strategy to assist the client to secure the exclusive right to use the trade mark "Fast 'N Tasty" in relation to cafeteria services throughout Australia?

Question 3: 20 marks. Suggested time - allow no more than 45 minutes.

You act on behalf of X Pty Ltd in connection with its application to register the trade mark "ECLAIR" in Australia in relation to clothing. X Pty Ltd has not commenced use of the trade mark "ECLAIR" but intends to use the mark in relation to a full range of women's clothing

You have received an examination report and the following marks have been cited against the application:-

(Question continued on following page)

- (i) Trade Mark: ECAIR
Class: 9
Goods: Clothing for protection against fire; protective clothing in this class.
Filing Date: 8 September 1999

- (ii) Trade Mark: ECLARE
Class: 25
Goods: Skirts, dresses and hats.
Filing Date: 16 December 1983

- (iii) Trade Mark: ECLAIR
Class: 25
Goods: Boys shorts and trousers.
Filing Date: 10 February 1952

Your client's trade mark application was filed on 10 January 2001.

You have made investigations on behalf of the client in connection with the possible use of each of the three cited marks. It would appear that the first trade mark "ECAIR" is not currently in use in Australia. The second trade mark "ECLARE" has been used for many years in relation to hats but no other goods. Finally, the third mark appears to have been recently acquired by a major clothing manufacturer and it has in the last three months been used by this company in relation to men's trousers. Your investigations reveal that before the current owner purchased the rights in the third trade mark that the mark had been out of use and that the previous owner had discontinued use of it some 5 to 10 years ago. It had been quite a well known mark for use on boys shorts. The new owner of the third mark has also recently filed a new application to register the trade mark "ECLAIR" for "articles of clothing including men's trousers". However, this application was filed after your client's application and therefore has not been cited against your client's case.

Explain to your client what options it has in order to deal with each of the citations and what action you recommend.

Question 4: 20 marks. Suggested time - allow no more than 45 minutes.

Your client has been the registered proprietor in Australia of the trade mark "IOLA" for all goods in class 3 for ten years. The trade mark has been used broadly and is well known and regarded in connection with an exclusive perfume.

(Question continued on following page)

Your client has recently become aware that a third party has made application to register the trade mark "IOLIA" in Australia in relation to soap in class 3 and towels and face washers in class 24. Your client has made some investigations concerning the third party and it would appear that it has made use of the trade mark "IOLIA" in Australia for approximately three months in relation to all of the goods for which they seek registration. The client wishes to prevent the third party from registering the trade mark or using it in relation to any goods in class 3 or in class 24.

Advise the client as to the strength of its position and in particular:-

- (i) whether it can expect to successfully oppose the third party's trade mark application;
- (ii) whether it can prevent the third party from using the trade mark "IOLIA" in relation to soap;
- (iii) whether it can prevent the third party from using the trade mark "IOLIA" in relation to face washers and towels; and
- (iv) whether the client can take any action to improve its position and if so what action it should take.

Question 5: 15 marks. Suggested time - allow no more than 35 minutes.

Your client is the registered proprietor of the trade mark "Gulp" in Australia in relation to soft drinks. It is now looking at selling its soft drinks and securing trade mark protection in a number of countries of the world. In particular the client is interested in protection in the following countries:-

United Kingdom

France

Germany;

Switzerland;

Ireland;

Japan;

China;

Canada;

United States of America; and

New Zealand.

(Question continued on following page)

Please detail the various options available to the Australian company in pursuing protection in each of these places and the advantages and disadvantages that arise in relation to the different options.

Question 6: 10 marks. Suggested time - allow no more than 25 minutes.

You have a new client that has approached you concerning possible registration of its trade mark in Australia, Canada and the United States. You have been advised by the client that it has made use of its trade mark in Australia for approximately 10 years but has never taken steps to register it. The client is now looking at exporting the goods that it makes into both the United States and Canada. The client uses its trade mark in relation to a range of clothing and clothing accessories such as bags, belts and cufflinks.

Explain in the form of a letter to the client what steps you recommend and what differences of practice there are between the three countries of interest to the client. In particular your letter should indicate what is required in each of these three countries in order to file a trade mark application and what use requirements there are in each of the countries in order to secure registration. You can assume that the client has conducted no searching and that the trade mark is an invented word which is inherently distinctive.

END OF EXAM PAPER

