

**PROFESSIONAL STANDARDS BOARD FOR PATENT  
AND TRADE MARK ATTORNEYS  
2000 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: 20 marks. Suggested time - allow no more than 45 minutes.**

- (a) Your client is the opponent in an opposition to the registration of a trade mark and has not completed its evidence in support of the opposition within the initial three month period following the filing of the Notice of Opposition. You have applied for a three month extension of time for completing this evidence. The applicant has objected to the extension being granted. Explain the Office practice in relation to the resolution of this objection. Your answer should indicate what correspondence you would expect to receive from the Trade Marks Office, the procedures that will be involved and what action you can take should the extension request be refused.
- (b) It has come to your attention that a trade mark application which you have been prosecuting on behalf of your client has lapsed. Lapsing was unintentional and 20 months have now expired since the issue of the first examination report. In accordance with normal practice the date for acceptance was 15 months from the date of first report. Explain clearly what steps can be taken to restore the application at this stage. Your answer should indicate what documents should be filed with the Trade Marks Office and whether any fees are payable. Please also indicate the relevant statutory provisions and regulations.

*(Question continued on following page)*

- (c) You act on behalf of X Pty Ltd in an opposition to the registration of a trade mark. X Pty Ltd is the applicant for registration. In the opponent's evidence in reply significant new material has been served. The new material relates to an issue which was not raised in either the evidence in support or evidence in answer. Advise the client as to its options in addressing this new material. Your answer should detail the office practice and the relevant regulations to the Trade Marks Act 1995.
- (d) You act on behalf of a client in connection with an application for registration of a trade mark. A prior mark has been cited against the application and investigations have revealed that the prior mark is in use and has been in use for at least the last ten years. Your client's own trade mark has also been in use for many years and you are attempting to secure acceptance under section 44(3)(a). It is now almost 21 months since the issue of a first examination report. You need further time to complete evidence in support of the claim to honest concurrent use. Please advise the client whether an extension of time can be obtained and if so the basis on which the extension can be sought. If the client has a number of options please outline these options.

**Question 2: 15 marks. Suggested time - allow no more than 35 minutes.**

For many years the firm for which you work has acted for the famous Australian sportsman Dave Sorenson. Whilst Mr Sorenson has been retired now for many years he is well loved by the Australian public and has an enviable reputation. Mr Sorenson is represented by an agent in Australia that has organized the manufacture and sale of merchandise bearing the Sorenson name and in the past Mr Sorenson through your firm has secured registration of the word Sorenson as a trade mark in class 28 in relation to sporting goods, in class 9 in relation to recorded video cassettes and in class 41 in relation to entertainment services.

Recently, and in honour of Mr Sorenson, the Victorian State Government changed the name of Collins Street - the major thoroughfare in Melbourne, to Sorenson Street. A new video library has opened on Sorenson Street which has called itself "Sorenson's", a sports store has opened calling itself "Sorenson's Sports" and a hairdresser has opened calling itself "Short & Curly on Sorenson".

Mr Sorenson has approached you to ascertain what steps can be taken to prevent the unauthorized use of the Sorenson name in relation to each of these stores. Advise the client.

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

Your client, Tunnel Clothing Pty Ltd, is a clothing manufacturer. The company manufactures clothing in Melbourne and sells it through major retailers in most capital cities of Australia. Tunnel Clothing commenced business three years ago and manufactures only women's blouses, shirts and tops. The products are expensive and well regarded. You are advised that the company commissioned extensive market research prior to adopting the trade mark TUNNEL and had established that no other company or person was using the trade mark in Australia. Indeed enquiries suggested that there had been no previous use of the word TUNNEL as a trade mark in relation to clothing sold in Australia in the past. Since the time of adopting the trade mark the products of Tunnel Clothing have been supported by a strong advertising campaign especially on television in Melbourne and Sydney and the brand has proved to be popular and well regarded.

Tunnel Clothing has come to you because they have recently become aware of the sale of non authorised products under the trade mark TUNNEL at discount clothing stores known as "Harry's The Price Slashers". Your client has provided to you samples of t-shirts and fleecy cotton pants which are being sold at Harry's The Price Slashers and they are clearly labelled with the trade mark TUNNEL. The labels indicate that the products are produced by a company known as Bandit Pty Ltd.

In your meeting with your client it becomes clear that Tunnel Clothing whilst conducting market research had not conducted any trade mark searches before adopting the trade mark. Nor had they filed an application for registration. A search of the Australian Trade Marks Office records reveals an existing registration in class 25. The registration is for the word TUNNEL in block capital letters and is registered for women's clothing. The trade mark has been registered since 1964 and you note that an assignment of the trade mark to Bandit Pty Ltd was recorded only two months ago.

Advise Tunnel Clothing Pty Ltd on the following:-

- (i) what steps can be taken to prevent the continued sale of the clothing of Bandit Pty Ltd bearing the TUNNEL trade mark at Harry's the Price Slashers?
- (ii) what risks does the client run in continuing to use the trade mark TUNNEL?
- (iii) what action, if any, is available to cancel the trade mark registration held by Bandit Pty Ltd?

*(Question continued on following page)*

- (iv) can Tunnel Clothing Pty Ltd secure registration of the trade mark TUNNEL in class 25 in its own right?

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

Your client Acme Sports has come to you as it is intending to introduce a new tennis racquet which is to be sold both in Australia & New Zealand. The client wishes to sell the tennis racquets under the trade mark PLANET. The client is very keen to use this mark as it is a subsidiary company of an international sports goods manufacturer and the PLANET trade mark is used extensively on tennis racquets sold in other countries of the world by the client's parent.

Searches in both Australia and New Zealand reveal existing registrations for the trade mark PLANET in class 28 in the name of Snell's Sports Goods Pty Ltd. Details of the registrations are as follows:-

Australia

Trade Mark:	PLANET
Class:	28
Goods:	Sports balls including tennis balls, basketballs and footballs.
Filing Date:	18 November 1994
Date on which trade mark registration granted:	1 October 1995

New Zealand

Trade Mark:	PLANET
Class:	28
Goods:	Sports balls including tennis balls, basketballs and footballs.
Filing Date:	18 November 1994
Date on which trade mark registration granted:	1 December 1996

Investigations have revealed that Snell's Sports Goods Pty Ltd have used the trade mark PLANET, but only in relation to footballs. These footballs have and continue to be sold in both countries.

Advise the client as to the availability of the trade mark for use and registration in both Australia and New Zealand in relation to tennis racquets.

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

Your client is interested in securing trade mark protection for its trade mark ACME in a number of overseas countries. The client uses the trade mark in relation to telescopes sold in Australia and now wishes to export these telescopes to the United States, Canada, Japan, Hong Kong and several countries in Europe. The client has not yet used the trade mark in any of these countries and it may be some time before use is commenced. It may be assumed that searches have not revealed any conflicting mark in any of these countries which would prevent registration.

Advise the client as to the following:-

- (i) whether it is possible to file a trade mark application for registration of the trade mark in the United States before the client commences selling telescopes in that country;
- (ii) whether it is possible to secure registration of the trade mark in the United States prior to the commencement of use in that country;
- (iii) whether it is possible to file an application for registration of the trade mark in Canada before the client commences selling telescopes in that country;
- (iv) whether it is possible to secure registration in Canada prior to the commencement of use in that country;
- (v) the options available to obtain protection in Europe. The client has expressed particular interest in Great Britain, France, Germany, Switzerland, Italy and Spain;
- (vi) what risks are involved if the client does not register the trade mark in Japan but simply uses in that country;
- (vii) what risks are involved if the client elects not to register the trade mark in Hong Kong but simply uses in that country.

**Question 6: 10 marks. Suggested time - allow no more than 20 minutes.**

You act on behalf of a financial institution that conducts business in Australia. It is looking at expanding its operations into Asia and New Zealand and wishes to register its key trade marks in the following countries:-

*(Question continued on following page)*

India  
Singapore  
Indonesia  
Malaysia  
Hong Kong  
New Zealand

In Australia the client holds registrations for its key trade marks in relation to financial services in class 36 and for CD ROMs, audio tapes and computer software in class 9. Advise the client whether protection of its trade marks is going to be possible in relation to the provision of financial services in each of the countries of interest. In any country where protection is not available please advise the client of any alternative strategy for protecting the client's interests. In relation to New Zealand the client has identified a New Zealand company as a potential business partner and it is intended that the client will grant a licence to the New Zealand Company to use all of its trade marks in that country. Advise your client as to the steps which should be taken to best protect its interests in New Zealand.

**END OF EXAM PAPER**

