

REPORT TO CANDIDATES

TOPIC GROUP D

Trade Mark Practice – 2000

QUESTIONS:

1. Question 1 concerned matters of Trade Marks Office Practice, in particular matters concerning prosecution of applications and oppositions. Candidates were expected to have a good knowledge of the practice of the office and it was expected that at least the following issues would have been identified:
 - (a) Extensions of time for completing evidence in opposition matters are regularly granted after the initial three month period even if an objection is raised by the other party. It was expected that Candidates would identify the key pieces of correspondence which would be received from the Trade Marks Office and in particular the likelihood that there would be no hearing convened in connection with the objection.
 - (b) It was expected that candidates would be familiar with the provisions of section 224 (2) and would explain the nature of the supporting documentation that was needed to secure an extension under this section.
 - (c) Candidates were expected to discuss the operation of regulation 5.51 and the option for X Pty Ltd to seek to file further evidence in relation to the new matters which were raised by the Opponent in the evidence in reply. Candidates should also have discussed the discretion of the Registrar under regulation 5.16 and the (somewhat remote) possibility of having the new matters excluded at the hearing on the basis that they were not properly matters of reply.
 - (d) Candidates should have recognized that deferment for acceptance under regulation 4.13 was unlikely to be available as the period in which the request should have been filed had expired. Reg 4.12 (1) (a). Candidates should have discussed the possibility of extending the prescribed period for making an application for deferment of acceptance under section 224 or alternatively for seeking further time under the “special circumstances” provisions.
2. Candidates should have identified that Mr Sorenson had potential rights under the Trade Marks Act, under the Trade Practices Act and at common law for passing off. These potential actions against each of the various stores should have been canvassed. Candidates were expected to discuss the three levels of infringement under sections 120(1), 120(2) and 120(3) and which of these provisions might potentially have applied to each of the respective stores and whether any of the defences under section 122(1) were available to any of the respective stores given the name of the street in which the stores were located.
3. This question required candidates to indicate that trade mark registration does not of itself provide a right to use a trade mark and that use of the registered trade mark by Bandit Pty Ltd might still amount to a passing off or be in breach of the Trade Practices Act. Candidates were expected to discuss section 230 and the potential for Tunnel Clothing to take action against Bandit Pty Ltd for passing off or trade practices breach. Candidates were also expected to note that the registration of Bandit Pty Ltd may well be vulnerable to removal under section 92. Whilst Bandit Pty Ltd acquired the mark more than a month after Tunnel Clothing sought advice it was still possible that use commenced less than a month earlier and that the registration was vulnerable under section 92.

It was also expected that candidates would have discussed the provisions of sections 88 and 89 and the possibility for Bandit's registration to be cancelled on the basis that use of the mark would be likely to deceive or cause confusion. Finally, with respect to the client itself securing registration, candidates were expected to discuss the provisions of section 44(3)(a) and (b), the evidence which would be required and the prospects of securing registration under these provisions given that the mark had been in use by the client for only three years.

4. This question required candidates to compare and contrast provisions under Australian and New Zealand law. Importantly, in Australia the relevant registration of the trade mark PLANET should have been seen as vulnerable to restriction on the grounds of non use. The registration was more than five years old and for at least some of the goods there appears to have been no use for three or more years. Candidates should therefore have identified the possibility of restricting the Australian registration to "footballs".

With respect to New Zealand a registration does not become vulnerable to removal until after the expiration of five years from the date on which the trade mark is registered. Accordingly, candidates should have noted that the New Zealand registration was not vulnerable to removal or restriction on the grounds of non use.

Candidates should have discussed section 120(2) and the possibility of infringement in Australia even if the registration had been restricted. In New Zealand there is no infringement of a trade mark registration unless the goods sold fall within the specification of goods of the registration. The client's interest was only in relation to tennis racquets and as these goods do not fall within the specification of goods of the New Zealand registration candidates should have identified that there would have been no action available to Snells Sports Goods Pty Ltd for infringement of its New Zealand registration by the sale of tennis racquets in that country. Candidates should have noted that both in Australia and New Zealand the prior mark would have been cited against any new application and that the comparison in both countries for registration concerns not only the goods for which the mark is registered but also goods which are of the same description to those registered. Finally, in both Australia and New Zealand there was the potential for common law action even if the registrations were restricted or otherwise not infringed and this should have been raised in completing the answer to this question.

5. In answer to this question candidates were expected to know the basic rules in relation to applications for trade mark registration in the United States, Canada, Europe, Japan and Hong Kong. In particular candidates were expected to identify those countries where it was necessary to demonstrate use in the country before the trade mark could be registered and those countries which recognize user rights and those which do not. With respect to Europe, candidates should have identified the possibility of filing a CTM application or separate applications in each of the countries designated. Candidates should also have noted that Switzerland could not have been covered in a CTM application.
6. Question 6 concerned the potential for obtaining protection of trade marks in various countries in South East Asia and New Zealand. Candidates were expected to know whether there were any countries where service mark protection was still unavailable. With respect to New Zealand candidates should have recognized that a licensee should be recorded as a registered user. Candidates should also have discussed the need to positively control the licensee's use of the mark and supervise the quality of the goods and services being provided.