

2000 Examination for Registration as Patent/Trade Marks Attorney

General Report

Trade Mark Law

Question 1

- (a) Most candidates had a good grasp of the nature of the doctrine of imperfect recollection, although some thought it was the only test when comparing trade marks. Reference to relevant cases such as *Rysta Ltd's Application* (1943) 60 RPC 87 and *de Cordova v Vick Chemical Co* (1951) 68 RPC 163 marked the better answers.
- (b) The facts of the cases were generally well known, but many answers omitted significant findings and principles.

Question 2

This question required analysis of whether Agia/Maxia could establish use of the IMPREVIUM trade mark in Australia before the date of filing of Alpha's applications. Good answers showed awareness of the development of Australian case law concerning marks adopted by Australians notwithstanding their use and/or registration in other countries. Proprietorship under the Trade Marks Act and at common law, as well as possible actions for passing off and under the Trade Practices Act 1974, should have been discussed.

Question 3

- (a) The inherent distinctiveness of the word HORSE for apparatus for locomotion should have been questioned. Not all candidates were aware that "jet engines" could be "parts" of such apparatus.
- (b) The fact that antibiotics are used to treat animals as well as humans should have been significant in answers.
- (c) The words "but not limited to STREET MASTER tyres" were the key to this question.
- (d) The concept of a family of trade marks and the issue of whether electronic games are the same, or of the same description, as computer hardware and software, required discussion.

- (e) This question was concerned with what constitutes trade mark use. Good answers showed awareness of the recent case of Sports Break Travel Pty Limited v P&O Holdings Limited 2000 AIPC 91-584 (SCHOOLIES).

Question 4

This question required a discussion of proprietorship, noting Mary's original use of the mark, Fred's application for it, the different labels attached to the goods; possible action under the Trade Practices Act as well as the Trade Marks Act; and unjustified threats.

Question 5

- (a) Demonstration of understanding of relevant principles of registrability was required here. There is no necessarily "right" answer.
- (b) Candidates who referred to the Trade Practices Act 1974 as well as legislation such as the Olympic Insignia Protection Act 1987 did well.
- (c) A surprising number of candidates apparently thought that geographical indications meant simply "geographical terms".