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The International
Trademark System



Understanding Examination and Refusal Procedures in the IP Office of Australia

Madrid System Webinar

Geneva
28 September 2020

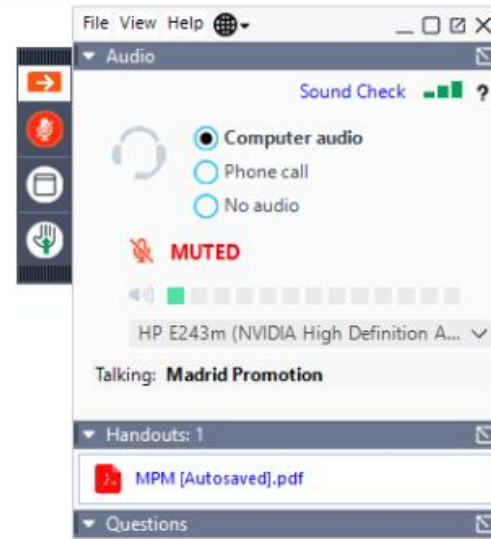
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IRDA Manager, Trade Marks and
Designs Group, IP Australia

Structure of the Webinar

- Presentation: Understanding Examination and Refusal Procedures in the IP Office of Australia
- Question and answer session at the end
- Presentation slides available for download
- Recording will be uploaded on the [Madrid Webinar page](#)
- Short survey to provide feedback

How to use GoToWebinar



Examination and Refusal Procedures in Australia

- Madrid System filings in Australia
- Overview of examination process
- How to avoid provisional refusals
- Notifications and how to respond
- Resources

Madrid System filings in Australia

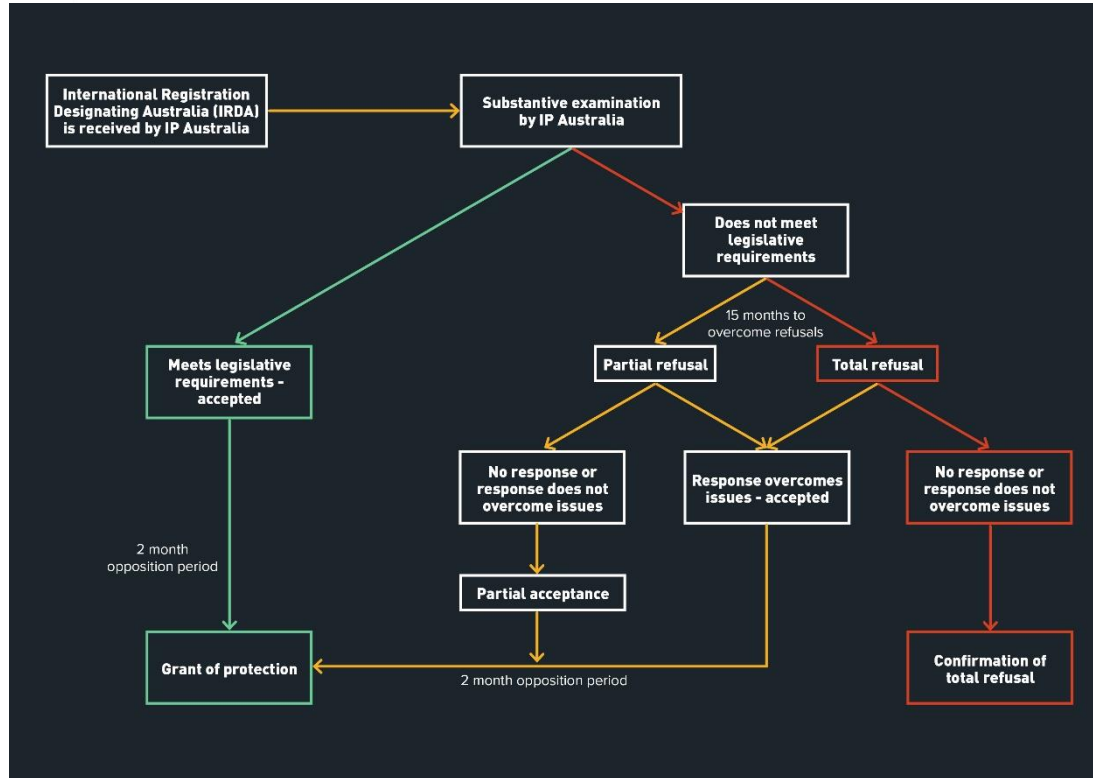
- Party to Madrid Protocol since 11 July 2001
- In 2019*
 - ranked 9th as origin of Madrid applications
 - ranked 6th as designated Madrid member mostly originating from United States of America, United Kingdom and China

*WIPO (2020), *Madrid Yearly Review 2020: International Registration of Marks*.

Overview of examination process

- Applicable legislation
 - *Trade Marks Act 1995* (Cth)
 - *Trade Marks Regulations 1995* (Cth)
- Known as IRDA (international registration designating Australia)
- Same examination and opposition process for IRDAs and national applications

IRDA examination flowchart



How to avoid refusals - formalities

■ Non-traditional signs

- include description of trade mark
- must accord with pictorial representations

■ Certification/Collective marks can be protected

- supply set of rules governing use of certification mark
- only associations can own collective mark

How to avoid refusals - formalities

- Transliteration of any non-Latin characters appearing in mark must be provided
- Translation of non-English words appearing in mark may be requested
 - if English meaning likely to attract grounds for refusal

How to avoid refusals - classification

- Use NICE classification otherwise goods or services may be identified by IP Australia as being
 - too vague
 - incomprehensible
 - linguistically incorrect

How to avoid refusals - classification

■ Current class headings accepted

- only covers goods or services actually specified in or clearly encompassed by heading

■ Previous class heading terms no longer accepted

- class 6: goods of common metal not included in other classes
- class 14: goods of precious metal or coated therewith, not included in other classes
- class 16: goods made from paper or cardboard (not included in other classes)

How to avoid refusals - classification

■ Previous class heading terms no longer accepted

- class 17: goods made from rubber, gutta-percha, gum, asbestos or mica, not included in other classes
- class 18: goods made of leather or imitation leather, not included in other classes
- class 20: goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics
- class 24: textile goods not included in other classes
- class 31: products of grains or agriculture, horticulture and forestry not included in other classes

How to avoid refusals - classification

■ Madrid Goods & Services Manager

- <https://webaccess.wipo.int/mgs/>

■ Trade Marks Classification Search

- <http://xeno.ipaustralia.gov.au/tmgns/facelets/tmgoods.xhtml>

Trade marks classification search

Australian Government
IP Australia

Trade Marks Classification Search

Search term Search Clear [advanced search](#)

Search Tips Classes of Goods Classes of Services

- This is a full term or part word search, so searching for "car body" will only return results containing the full phrase as written. In order to search for each word individually, add the "and" keyword, so "car and body" will search for goods and services containing both of those words.
- You can also append an "*" character to the end of your search term to search for all descriptors containing a word that begins with the search term. For example, "car*" will return results containing "carbon", "cartridge", etc.
- The "or" keyword can be used to separate search terms and search for goods and services with any of the words separated by "or". For example "car or filler" will return "Filler for rubber" and "Car paints".
- Search for singulars - plurals will be searched for automatically. Searching for "car" will look for "car" or "cars"; searching for "car or body" will search for "car", "cars", "body" or "bodies".
- Goods and Services are divided into 45 classes. You can view the complete lists of Trademark classes using the tabs above.
- Please do not copy and paste items from the list into the application form.

[Return to ATMOSS](#) | © Commonwealth of Australia 2013 ([more info](#))

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How to avoid refusals - absolute and relative grounds

■ Absolute and relative grounds

- trade mark containing certain signs (section 39 and regulation 4.15)
- trade mark not distinguishing goods or services (section 41)

How to avoid refusals - absolute and relative grounds

■ Absolute and relative grounds

- trade mark scandalous or its use contrary to law (section 42)
- trade mark likely to deceive or cause confusion (section 43)
- trade mark conflicting with other marks (section 44)

How to avoid refusals - section 41

- Trade mark must be capable of distinguishing traders goods or services from those of others
- Equates to concept of distinctiveness
- Considerations
 - ordinary meaning of mark
 - likelihood other traders might legitimately need to use mark in relation to goods or services

How to avoid refusals - section 41

■ Recent examples

realestate.com.au Home Loans

- Class 36: Financial services, etc

Real Estate Home Loans Pty Ltd v REA Group Ltd [2019] ATMO 129

- Class 9: Protective clothing (body armour), etc

Aldi Foods Pty Ltd [2019] ATMO 174



How to avoid refusals - section 44

- Search for earlier trade marks that are
 - substantially identical
 - deceptively similarand cover
 - similar/closely related goods or services

How to avoid refusals - section 44

■ Recent example

CAESARSTONE

VS

·CÆSAR·

 caesarstone

Caesarstone Ltd v Ceramiche Caesar S.p.A. (No 2) [2018] FCA 1096

How to avoid refusals - section 44

■ Australian Trade Mark Search

- quick search

<https://search.ipaustralia.gov.au/trademarks/search/quick>

- advanced search

<https://search.ipaustralia.gov.au/trademarks/search/advanced>

Australian trade mark search - quick

The screenshot shows the Australian Trade Mark Search website. At the top left is the Australian Government IP Australia logo. At the top right is the Australian Trade Mark Search logo. Below these is a dark navigation bar with a home icon and 'Quick search' on the left, and 'Advanced search' and a notification bell icon on the right. The main content area features a search bar with the placeholder text 'Search for words in trade marks, owner names or trade mark numbers' and icons for image search and search. Below the search bar is a link for 'advanced search »'. A row of six colored icons (info, A, camera, image with A, people, calendar) is positioned above a blue information box. The box is split into two columns: 'Disclaimer summary' and 'Quick search'. The disclaimer text states that search results are not to be relied upon and that IP Australia is not liable for any action taken. The 'Quick search' text explains that it searches across trade marks and owner names, including plurals and slight variations, and offers filtering options.

Australian Government
IP Australia

Australian Trade Mark Search

Quick search

Advanced search

Search for words in trade marks, owner names or trade mark numbers

advanced search »

Disclaimer summary

Please note that the results of any search you conduct should not be relied upon, because any subsequent application you make will still be subject to a search by a trade mark examiner as part of the assessment process. That process may reveal new materials and information you did not find. IP Australia is not liable for any action taken and expense incurred in using this service.

Quick search

This will search across trade marks and their owner names. Although it will also find plurals, you should search for slight variations of your trade mark, such as common misspellings and words that sound similar. When uploading images, consider alternative images that look similar. You can filter your results in the search results screen, or undertake more specific searches using Advanced search.

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Australian trade mark search - advanced



Home > Advanced search

My list (0) My searches (0) Quick search

Notifications (2) Menu

Word

Part AND Part +

Image [image terms](#)

Part AND Part +

Word phrase

Single

Class [classification search](#)

Associated ...

Status group Status

All All

Date

Lodgement From To

Type **Kind** **Flags** **Exclude inactive**

All types All kinds None None



Search

Save Clear

How to avoid refusals - section 39

- Trade mark must not contain prescribed signs
- Prescribed signs set out in regulation 4.15 include
 - certain words or symbols such as ‘Patent’ or ‘Protected International Trade Mark’
 - Australian Commonwealth, State or Territory arms, flags or seals
 - signs notified under provisions of Paris Convention

How to avoid refusals - section 42

- Trade mark must not contain or consist of scandalous matter
 - offensive language
 - personal, racial or religious abuse
 - abuse of national flag
- Use of trade mark must not be contrary to law



How to avoid refusals - section 43

- Trade mark must not be likely to deceive or cause confusion
 - contains obvious and direct connotation
 - immediate danger of deception or confusion
 - arising from mark itself

Notifications and how to respond

- Decision communicated via WIPO
- Notifications issued in English
- Provisional refusal will include information on
 - relevant grounds for refusal
 - goods or services affected by refusal
 - options to overcome refusal
 - deadline to resolve refusal

Notifications and how to respond

■ How to overcome refusals

- amend goods or services
- supply evidence of use under section 41
- supply evidence of prior continuous use or honest concurrent use under section 44

■ How to respond to refusals

- address for service in Australia or New Zealand
- use IP Australia's eServices portal

eServices


The screenshot shows the IP Australia eServices website. At the top, there is a dark header with the Australian Government logo and 'IP Australia' text on the left, and 'eSERVICES HOME' with a font size adjuster and a color palette on the right. The main content area has a light grey background with a grid pattern. On the left, a cartoon character named Alex greets users. The central part features a 'SIGN IN TO eSERVICES' section with input fields for 'Username:' and 'Password:', a 'SUBMIT' button, and a link for 'Forgot your username/password?'. Below this is a 'NOT REGISTERED?' section with a 'REGISTER FOR eSERVICES' button. Further down, there are sections for 'RENEWING A TRADE MARK?' and 'COVID-19 RELIEF MEASURES', each with explanatory text and links.

Australian Government
IP Australia

eSERVICES HOME - A A A +

eSERVICES

HI, I'M ALEX. WELCOME TO eSERVICES



eServices is the secure, reliable and convenient way to access a range of IP Australia's transactions and services including our Trade mark Headstart service.

You can use eServices to apply, register, renew and pay for IP rights.

I have more information here if you are having difficulties registering eServices registration help.

SIGN IN
TO eSERVICES

Username:

Password:

[Forgot your username/password?](#)

SUBMIT

NOT REGISTERED? [REGISTER FOR eSERVICES](#)

RENEWING A TRADE MARK?

We're building a new online services platform. For now, you can trial the new platform (beta).

Click here to [RENEW YOUR TRADE MARK](#).

For more information about IP Australia's new portal email: MDB-TDS@paustralia.gov.au

COVID-19 RELIEF MEASURES

IP Australia has put in place a streamlined process to provide free extensions of time to assist customers impacted by the COVID-19 outbreak. Please visit our [COVID-19 page](#) for the details of how to access this and Frequently Asked Questions (FAQs) related to your IP right. It also includes details of how you can receive a free extension of time of up to three months, including [guidance on how to apply](#).

Resources

■ Madrid Member Profiles - Australia

- <https://www.wipo.int/madrid/memberprofiles/#/>

■ Madrid Fee Calculator

- <https://www.wipo.int/madrid/feescalculator/>

Resources

■ IP Australia

- <https://www.ipaustralia.gov.au/>

■ Trade Mark Assist

- <https://trademarks.business.gov.au/assist/welcome>

■ Trade Marks Office Manual of Practice and Procedure

- http://manuals.ipaustralia.gov.au/trademarks/trade_marks_examiners_manual.htm

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Search trade marks



Apply for a trade mark



Ask Alex for help



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Trade mark assist



Welcome to Trade Mark Assist

Get started!

Hello, I'm Alex, IP Australia's virtual assistant and your guide to Trade Mark Assist!

Trade Mark Assist will help you learn some of the trade mark basics, explore your proposed trade mark and identify common mistakes before you apply.

There are many things to consider when applying for a trade mark. Trade Mark Assist can help you:

- Explore your proposed trade mark
- Discover if your proposed trade mark contains a word or phrase that may be difficult to register
- Identify the goods and services you wish to protect
- Search for existing trade marks that may be a problem

This is an educational tool. Information provided should not be interpreted as legal advice.


Please read our [disclaimer](#) prior to using Trade Mark Assist.

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Trade marks office manual

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IP Australia

Trade Marks Office Manual of Practice and Procedure

The following is a list of the updates that have been issued since 1999 in relation to the Manual of Practice and Procedure. The list is in reverse chronological order. To assist users, new and changed (but not deleted) text in the Manual is highlighted in yellow for one month following publication, except where a part or subpart has been extensively revised and re-written, which will be indicated in the below change summary.

Year	Part/s & details	Printed version footer
2020	Part 10 - pages reviewed; no changes required; effective dates only updated Relevant Legislation Introduction 2. Formality requirements - Identity 4. Translation/transliteration of Non-English words and non-Roman characters 5. Specification of goods and/or services 7. Signature 8. Complying with formality requirements Annex A2 - Identity of the applicant	24 August 2020
	Part 26 - 6. Factors to consider when comparing trade marks - page updated	
	Part 38 - 3. Revocation process - page updated to clarify process	



Q&A Session about the Webinar

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