

Lahore

Patents, Trade Marks & Related Rights Bulletin

Bulletin by: **Dr Dimitrios G Eliades**, Barrister, Brisbane

Contents of this issue	Page
Trade Marks — Federal Court	
Validity — trade marks registered in relation to coffee products — whether Italian words “oro” and “cinque stelle” inherently adapted to distinguish the goods of the registered owner — whether primary judge erred in determining distinctiveness by reference to the probability of persons understanding the words and calling to mind their attachment to the goods — whether other traders acting with proper motives would want to use the trade marks in connection with goods — principle in <i>Clark Equipment</i> — inquiry to be informed by the likely use of the marks by traders as informed by potential consumers	4
Where applicant and respondent compete in selling lifts and elevators — where applicant’s trade mark includes the words “lift shop” — whether respondent infringed the applicant’s trade mark or engaged in misleading and deceptive conduct in using the words “lift shop” in its search engine results — whether potential consumers would associate applicant and respondent	7
Infringement — remittal proceedings — gaming machine games and components — circumstantial evidence — primary findings as to knowledge of counterfeiting activities overturned on appeal — what relief available for copyright infringement — Evidence — tendency rule — s 97(1) of Evidence Act 1995 (Cth) — failure to comply with tendency rule where evidence not characterised as tendency evidence at first instance.....	8

Claim that respondent imported and sold sunglasses bearing marks similar to applicant's registered trademarks — whether allegedly infringing marks deceptively similar to applicant's registered trademarks under s 120 of Trade Marks Act 1995 (Cth) — relevance of reputation to test of deceptive similarity 9

Dismissal of proceedings under r 5.23 — dismissal of proceeding in default of appearance — costs — application for indemnity costs — commencement of proceedings for breach of trademark and injunctive relief when trademark had been transferred — failure to appear before the Court..... 10

Patents — IP Australia

Late application by Bridgestone Corporation for extension of time to file notice of opposition to registration of trade mark application 1499915(9) — TYREMATICS and device — filed in the name of Zylux Distribution Pty Ltd..... 12

Opposition by Hilton Hospitality Inc to registration of trade mark applications 1263729(19) — CANBERRA WALDORF; 1263733(19) — PENNANT HILLS WALDORF; 1263734(19) — ROSEHILL WALDORF; 1277438(19) PERTH WALDORF; 1277441(19) SOUTH SYDNEY WALDORF; 1277443(19) THE ENTRANCE WALDORF — filed in the name of Waldorf Australia Group Pty Ltd — opposition by Waldorf Australia Group Pty Ltd to extension of protection to international registration designating Australia 1186964(36, 43) (International Registration No 926493) THE WALDORF=ASTORIA COLLECTION — filed in the name of HLT Domestic IP LLC .. 13

Opposition by Slater & Gordon Pty Ltd to registration of trade mark application 1083124(42) — SLATERS INTELLECTUAL PROPERTY LAWYERS — filed in the name of Ann Rosa Mary Slater 14

Patents — Federal Court

Entitlement — an application made for a patent pursuant to s 29(1) of the Patents Act 1990 (Cth) by a person not ultimately entitled to grant of patent within the terms of 15(1) of the Patents Act — prior to grant of patent, rights to invention and application assigned to entitled person within the meaning of s 15(1) — held that patent application validly made under s 29(1) and properly granted to entitled person within the meaning of 15(1) such that the patent should not be revoked pursuant to 138(3)(a) of the Patents Act — no false suggestion or misrepresentation to the commissioner of patents such that patents should be revoked in exercise of court's discretion under s 138(3)(d) or (e) of the Patents Act 16

Costs — appropriate orders — applicant successful on infringement and resisting invalidity cross-claim — circumstances for limiting the applicants costs 17

Innovation patent — methods and apparatuses for identifying overstay of a vehicle in a parking space — infringement — direct infringement — contributory infringement under s 117(1) of the Patents Act 1990 (Cth) — whether the defence under s 119(1) of the Act available — authorisation — temporal relation between respondent's exploitation and the priority date of the claims —

determination of priority date of the claims where patent based on divisional applications — discussion of test under regs 3.12(1)(b) and (c) of the Patents Regulations 1991 (Cth) — whether claims fairly based on matter disclosed in the priority documents — validity — whether claims fairly based on the matter described in the specification — whether invention as claimed novel — “paper anticipation” — prior use — adequacy of disclosure — whether invention as claimed supported by an innovative step	18
Application for preliminary discovery pursuant to rr 7.22 and 7.23 of the Federal Court Rules 2011 (Cth) — possible proceeding for patent infringement.....	20
Patents — IP Australia	
Opposition to the grant of a patent — whether the best method of performance identified.....	21