

Slide 1

Australian Government
IP Australia

SERIES TRADE MARKS

® TM

www.ipaustralia.gov.au

Slide 2

Australian Government
IP Australia

Slide - 2


Section 51

Under section 51 of the Act a person may make a single application under subsection 27(1) of the Act for two or more trade marks:

- if** the trade marks resemble each other in material particulars
- and** the trade marks **differ only** in respect of one or more of the following:
 - statements or representations as to the goods or services in relation to which the trade marks are to be used;
 - statements or representations as to number, price, quality or names of places;
 - the colour of any part of the trade mark.

If:

- the application meets all the requirements of this Act; and
- the Registrar is required (under section 68) to register the trade marks; he or she must register them as a series in one registration




Australian Government
IP Australia

Slide - 3

Material Particulars

To qualify as a series the trade marks must first resemble each other in material particulars. That is, the identifying feature or features in each trade mark of the series must be essentially the same and any differences minor. In many cases the identifying feature/s entirely comprise the distinctive elements of the trade mark. However, it should be noted that in some cases descriptive/non-distinctive material can form part of the material particulars of a trade mark – particularly if its size and presentation within the trade mark are dominating features. Any differences between the material particulars must be such that they do not substantially affect the identity of the trade marks when each member of the series is compared to each of the others.



Australian Government
IP Australia

Slide - 4


Paragraph 51(1)(a), (b), (c)

[Subsection 51\(1\)](#) provides the second consideration in determining the validity of a series.

The wording of [subsection 51\(1\)](#) emphasises that the trade marks in the series must differ **only** in respect of **one or more** of the ways specified in paragraphs (a), (b) and (c).

[Subsection 51\(1\)](#) places substantial restrictions on what sort of trade marks can form a valid series. It does this by specifying in paragraphs (a), (b) and (c) a narrow range of ways in which the trade marks can differ. It also requires that series trade marks differ **only** in respect of the ways specified. It does however allow the trade marks to differ in **one or more** of these ways.

This means that even if the material particulars resemble each other, the validity of a series will be quickly determined on the basis of whether differences between the trade marks are within those specified in the three paragraphs of subsection 51(1)




Australian Government
IP Australia

Slide - 5

Paragraph 51(1)(a), (b), (c)

(1) A person may make a single application under subsection 27(1) for the registration of 2 or more trade marks in respect of goods and/or services if the trade marks resemble each other in material particulars and differ only in respect of one or more of the following matters:

- (a) statements or representations as to the goods or services in relation to which the trade marks are used or are intended to be used;
- (b) statements or representations as to number, price, quality or names of places;
- (c) the colour of any part of the trade mark.



Slide 6

Australian Government
IP Australia

Slide - 6

51(1)(a) statements or representations as to the goods or services in relation to which the trade marks are to be used

Example 1
Class 25 claim for Clothing, footwear, headgear.


IDAK CLOTHING
IDAK FOOTWEAR
IDAK HEADGEAR


Example 2
Class 9 claim for Televisions.

IDAK TV
IDAK TELEVISION

Example 3
Class 25 claim for Clothing, footwear, headgear, and a
Class 35 claim for Retailing of clothing, footwear and headgear

IDAK SHIRTS
IDAK HATS
IDAK SLIPPERS



 Australian Government
IP Australia

Slide - 7


51(1)(b) statements or representations as to number, price, quality or names of places


Number

Example 1
IDAK 1
IDAK 2

Example 2
IDAK FIRST
IDAK 1ST

Example 3
IDAK 2
IDAK TWO



 Australian Government
IP Australia

Slide - 8


51(1)(b) statements or representations as to number, price, quality or names of places

Number

Example 4
IDAK ONE
IDAK TWO

Example 5
IDAK 6 PACK
IDAK 6

Example 6
IDAK one
IDAK TWO



 Australian Government
IP Australia

Slide - 9


51(1)(b) statements or representations as to number, price, quality or names of places

Price

Example 1
IDAK \$2.00
IDAK \$10.00

Example 2
IDAK £2.00
IDAK \$10.00
IDAK ¥500



 Australian Government
IP Australia

Slide - 10


51(1)(b) statements or representations as to number, price, quality or names of places


Quality

When considering quality the goods and services must be taken into account and research undertaken to ascertain whether the terms are ordinarily used to indicate quality in the relevant industry.

Example 1
IDAK STANDARD
IDAK DELUXE

Example 2
IDAK SUPREME
IDAK DELUXE
IDAK PREMIER





 Australian Government
IP Australia

Slide - 11

51(1)(b) statements or representations as to number, price, quality or names of places

Example 3
IDAK SUPERIOR
IDAK DELUXE
IDAK PREMIER!




 Australian Government
IP Australia


Slide - 12

51(1)(b) statements or representations as to number, price, quality or names of places

Example 4
Class 43 claim for *Hotel accommodation*,
Class 36 claim for *Credit card services*, and
Class 37 claim for *Vehicle road service*.

IDAK GOLD
IDAK SILVER
IDAK BRONZE



 Australian Government
IP Australia

Slide - 13


51(1)(b) statements or representations as to number, price, quality or names of places


Names of Places

Example 1
IDAK PERTH
IDAK SYDNEY

Example 2
IDAK
IDAK SYDNEY

Example 3
PERTH IDAK
SYDNEY IDAK




 Australian Government
IP Australia


Slide - 14

51(1)(b) statements or representations as to number, price, quality or names of places

Example 4
IDAK NSW
IDAK NEW SOUTH WALES

Example 5
IDAK
MELBOURNE IDAK




 Australian Government
IP Australia


Slide - 15

51(1)(c) the colour of any part of the trade mark

Example 1
IDAK
IDAK [note: entire representation is red in colour]

Example 2
IDAK
IDAK [note: the letter A is red in colour]




 Australian Government
IP Australia

Slide - 16

Trade marks differing only in respect of one or more of the ways specified in paragraphs 51(1)(a), (b) and (c)

Class 43 claim for Hotel accommodation.

IDAK SYDNEY STANDARD 1
IDAK MELBOURNE DELUXE 2



Australian Government
IP Australia


Slide - 17

Examples of trade marks that do not resemble each other in material particulars

Example 1
IDAK MELBOURNE
IDAK MELBOURNE

Example 2
IDAK MELBOURNE
IDAK GALAXY

Example 3
IDAK Television
IDAK 1
IDAK \$2.00
IDAK STANDARD
IDAK SYDNEY




Australian Government
IP Australia

Slide - 18

Examples of trade marks that do not resemble each other in material particulars


Example 4 Class 25 claim for Clothing
 SYDNEY CLOTHING
 MELBOURNE CLOTHING




Australian Government
IP Australia

Slide - 19

Examples of trade marks that do not meet the provisions of 51(1)(a),(b) or (c)

Example 1	 IDAK
Example 2	IDAKS IDAKZ
Example 3	IDAK VIEW IDAKVIEW
Example 4	IDAKS IDACS




Australian Government
IP Australia

Slide - 20

Examples of trade marks that do not meet the provisions of 51(1)(a),(b) or (c)

Example 5	IDAK I.D.A.K.
Example 6	IDAK <i>IDAK</i>
Example 7	IDAK I-DAK




Australian Government
IP Australia

Slide - 21

51(1) (a)

Example 1	Class 35 claim for <i>Accounting</i> IDAK ACCOUNTING IDAK MEDICAL
Example 2	Class 11 claim for <i>Refrigerators</i> IDAK REPAIRS IDAK REFRIGERATORS




Australian Government
IP Australia


Slide - 22

51(1) (a)

Example 3 Class 25 claim for *Clothing, footwear, headgear*
Class 36 claim for *Financial services*

IDAK SHIRTS
IDAK HATS
IDAK SLIPPERS
IDAK LOANS
IDAK HOME LOANS
IDAK MORTGAGES



 Australian Government
IP Australia

Slide - 23


51(1) (b)
Number


Example 1
IDAK 2
IDAK TWICE

[twice is not a direct reference to number]

Example 2
IDAK 6 pack
IDAK Unlimited

[unlimited is not a direct reference to number]



 Australian Government
IP Australia


Slide - 24


51(1) (b)

Price

Example 1
IDAK £
IDAK \$
IDAK ¥

[the symbols refer to currency rather than price]



 Australian Government
IP Australia

Slide - 25

51(1) (b)
Quality

Example 1
IDAK DELUXE
IDAK BEGINNING


[beginning is not a reference to quality]

Example 2
Goods/Services- Class 30: Tea/coffee

IDAK PREMIUM
IDAK WEATHER PROOF

[weather proof is not a reference to quality in relation to tea/coffee]



 Australian Government
IP Australia


Slide - 26


51(1) (b)
Quality

Example 3
Goods/services- Class 31: Alfalfa sprouts

IDAK GOLD
IDAK SILVER
IDAK BRONZE

[gold, silver and bronze are not references to quality in relation to alfalfa sprouts]



 Australian Government
IP Australia

Slide - 27


51(1) (b)
Names of Places


Example 1
IDAK MELBOURNE
IDAK EAST

[east is not the name of a place]

Example 2
IDAK GOLD COAST
IDAK REGIONAL

[regional is not the name of a place]



 Australian Government
IP Australia


Slide - 28

51(1) (b)

51(1)(c)- the colour of any part of the trade mark

Example
Class 12 claim for *Clutches for vehicles*
IDAK BLUE
IDAK RED

[red and blue here are not *the colour of any part of the trade mark*. They are also not statement as to the goods, which are not ordinarily described in terms of colour]




Australian Government
IP Australia


Slide - 29

Trade marks which resemble each other in material particulars, differ in one or more of the ways specified in paragraphs 51(1)(a),(b) or (c) but incorporate a further change that render them invalid series.

Example 1
IDAK TV
IDAK TELEVISION
[made invalid by enlarged script]

Example 2
IDAK 1
IDAKS 2
[made invalid by differences in spelling]



 Australian Government
IP Australia

Slide - 30


Trade marks which resemble each other in material particulars, differ in one or more of the ways specified in paragraphs 51(1)(a),(b) or (c) but incorporate a further change that render them invalid series.

Example 3
IDAK CLOTHING
idak FOOTWEAR

[made invalid by use of upper and lower case letters]

Example 4
IDAK PERTH
PERTH IDAK

[made invalid by different order of words]




Australian Government
IP Australia


Slide - 31

Trade marks which resemble each other in material particulars, differ in one or more of the ways specified in paragraphs 51(1)(a),(b) or (c) but incorporate a further change that render them invalid series.

Example 5
IDAK 1
IDAK 2
[made invalid by underline]

Example 6
IDAK \$2.00
IDAC \$10.00
[made invalid by differences in spelling]




 Australian Government
IP Australia


Slide - 32

Trade marks which resemble each other in material particulars, differ in one or more of the ways specified in paragraphs 51(1)(a),(b) or (c) but incorporate a further change that render them invalid series.

Example 7
IDAK STANDARD
I DAK DELUXE

[made invalid by separation of word]






Australian Government
IP Australia

Slide - 33

Divisional Applications from Series

Where the series on the parent application is a valid series, divisional applications may be made in respect of the goods and/or services claimed in accordance with the general divisional provisions.



 Australian Government
IP Australia


Slide - 34

Linking of Series Applications

If prior to 27 March 2007:

- an owner had more than one application for a series filed on the same day for different classes of goods and/or services and
- the series are identical (not what was filed, but what is now on the register/database), then

the owner may apply to have the applications linked and be treated as one trade mark application.



Australian Government
IP Australia


Slide - 35

Colour Endorsements

For series applications that differ in respect of colour, the Trade Marks Office had previously required the applicant to provide an endorsement describing the various colours that have been used on each trade mark representation. Colour endorsements written in acceptable format were provided as follows:

The (first/second/coloured etc.) trade mark in the series of trade marks is depicted in the colour(s) as shown in the representation attached to the application form.

This requirement is no longer applicable to series applications.




Australian Government
IP Australia

Slide - 36

Colour Endorsements

Where a series application is filed for trade marks which differ in respect of colour, a colour endorsement will not be required. Where a colour endorsement has been included, and the endorsement is unclear as to the nature of the trade marks being claimed and is not in a format that has been previously accepted, clarification will be sought by the examiner. If the colour endorsement does not restrict or limit the use of the trade mark to particular colours, deletion or amendment may be available. If however the colour endorsement does restrict or limit the use of the trade mark to particular colours, deletion of the endorsement is not available as the removal of such an endorsement would expand the scope of the applicant's trade mark rights (s65(7)).




Australian Government
IP Australia

Slide - 37

Colour Endorsements

Where a colour endorsement is present and does serve to restrict or limit the use of the trade mark to a particular colour or colours, an acceptable format is as follows:

The trade mark registration is limited to the colours and as shown in the representation of the trade mark attached to the application form.



Australian Government
IP Australia

Slide - 38

Colour Endorsements

Example 1	Trade Mark : 1749951
Example 2	Trade Mark : 1763656
Example 3	Trade Mark : 1750992



The footer banner features a series of icons: a blue 'R' in a circle with 'TM' next to it, a gear, a green leaf, a red apple, a yellow lightbulb, a blue DNA helix, and a blue circuit board.

Australian Government
IP Australia

Slide - 39


Clarification as to s51(1)(a) statements or representations as to the goods or services in relation to which the trade marks are to be used


In Part 13.6 and 13.7 of the Manual, it provides examples of what does and does not constitute a statement or representation as to the goods or services in relation to which the marks are to be used. One of the "valid" examples provided is as follows:

Example 1
Class 25 claim for Clothing, footwear, headgear.

IDAK CLOTHING
IDAK FOOTWEAR
IDAK HEADGEAR

In this example, you will notice that the Class 25 goods are *clothing, footwear, headgear* and not *clothing; footwear; headgear*.



 Australian Government
IP Australia


Slide - 40

One of the "invalid" examples provided in the Manual is as follows:


Example 3
Class 25 claim for Clothing, footwear, headgear
Class 36 claim for Financial services

IDAK SHIRTS
IDAK HATS
IDAK SLIPPERS
IDAK LOANS
IDAK HOME LOANS
IDAK MORTGAGES

This example is an invalid series on the basis that the words SHIRTS, HATS and SLIPPERS are not considered to resemble each other in material particulars when applied to the services in Class 36, and vice versa with the words LOANS, HOME LOANS and MORTGAGES in Class 25.



Slide 41

 Australian Government
IP Australia

Slide - 41

From this, a question was raised as to whether the following hypotheticals would also constitute valid/invalid series applications:


IDAK FOOTWEAR
IDAK HEADGEAR

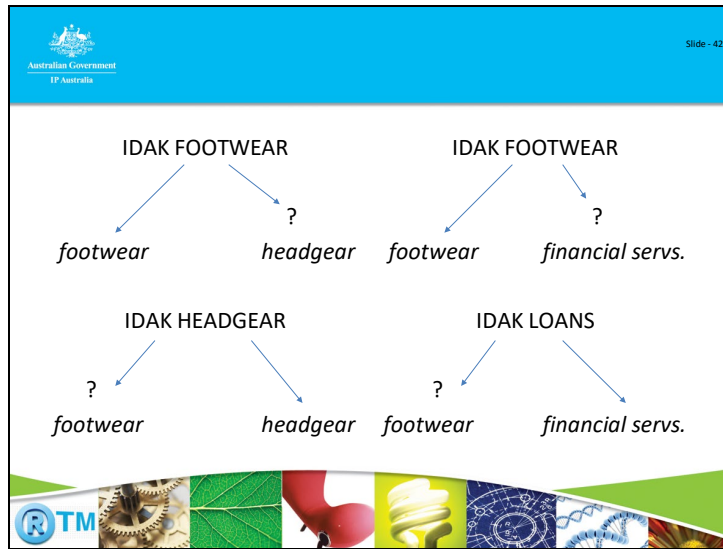
Class 25: Footwear; headgear

and

IDAK FOOTWEAR
IDAK LOANS

Class 25: *Footwear*
Class 36: *Financial services*





Australian Government
IP Australia

Slide - 43

This question was raised to ascertain whether each individual item is considered when determining whether the differences are mere statements or representations for the purposes of s51(1)(a) – ie. do we assess whether the words FOOTWEAR and HEADGEAR are both statements or representations as it relates to *footwear* and *headgear* as separate claims, or do we assess on the basis of the entire Class 25 claim as a whole?

After some back and forth discussion, it was established that (i) does constitute a valid series and (ii) does not – this is because in (i), the applicant has claimed both footwear and headgear, and these goods are **related and in the same class**. This is not the case with (ii), with footwear and financial services being too different for the trade mark IDAK FOOTWEAR to be considered a statement of services for financial services and vice versa. The use of commas or semi-colons does not change the question. If an applicant claims *clothing, footwear, headgear* they may still choose to only use IDAK footwear or headgear in practical use.




Slide 44

Australian Government
IP Australia

Slide - 44

As such, the determination requires individual assessment of each application as there is no definitive rule identifying the line between related goods/services in the same area and unrelated goods/services.

If the relation is somewhat obvious as in (i), it would be a safe bet that the series application is valid. Likewise, if the relation is completely unrelated as in (ii), it would not constitute a valid series for the purposes of s51(1)(a). For the ones that are not so obvious, it may be wise to consult with your fellow series examiners to get some consensus on the matter.



Australian Government
IP Australia

Slide - 45

51(1)(c) the colour of any part of the trade mark

Submissions were raised in respect of 1645066, which consists of four trade mark representations as follows:



After extensive deliberations and consultations, it was agreed that the Office would allow for the first three marks to constitute a valid series.


Accordingly, the main outline or border of a black and white representation in a series application which differs in respect of colour will be allowable – this is to cater for the fact that, without the outline or border, the main identifying feature of the mark would not be visible. However, minor outlines as featured in the fourth mark will not be considered as differences in respect of colour only. Again, you will need to use some discretion when making a decision on these types of applications.



Australian Government
IP Australia

Slide - 46

EXAMPLES




The slide features a blue header with the Australian Government logo and 'IP Australia' text on the left, and 'Slide - 46' on the right. The main content area is white with the word 'EXAMPLES' in large, bold, black capital letters. At the bottom, there is a decorative banner with a green and white background, containing several icons: a blue circle with 'RTM', a gear, a green leaf, a red apple, a yellow lightbulb, a blue DNA helix, and a microscope.




Australian Government
IP Australia

Slide - 48



property development building
construction of real estate
ty development (building and
velopment (building and




Australian Government
IP Australia

Slide - 49

bubalishes

buba lishes




The slide features a blue header with the Australian Government and IP Australia logos. The main content area displays two variations of the 'bubalishes' brand name. The first variation, 'bubalishes', has a stork carrying a bundle in its beak, positioned over the 'u' and 'a' of 'bubalishes'. The second variation, 'buba lishes', has a stork carrying a bundle in its beak, positioned over the 'u' and 'a' of 'buba'. The footer contains a series of icons: a blue 'R' in a circle followed by 'TM', a gear, a green leaf, a red apple, a yellow lightbulb, a blue DNA helix, and a blue gear.

Australian Government
IP Australia

Slide - 50

BULLETPROOF MY BUSINESS

Class 35: Business consultancy services relating to both corporations and individuals including advisory services as to business management matters and related matters including the provision business documentation




Australian Government
IP Australia

Slide - 51

KOREAN AIR

KOREAN AIR

KOREAN AIR




The slide features a blue header with the Australian Government and IP Australia logos. The main content area displays three variations of the 'KOREAN AIR' logo: a white logo on a blue background, a blue logo on a white background, and a black logo on a white background. The footer is a decorative banner with icons representing intellectual property and science, including a trademark symbol, gears, a green leaf, a red lightbulb, a yellow lightbulb, a DNA helix, and a microscope.

Australian Government
IP Australia

Slide - 52

acr **INVALID** ballet^{fit}
piratessm

Health club services (health and fitness)
Physical fitness training services






The slide features a blue header with the Australian Government and IP Australia logos. The main content area displays three instances of the 'events URBAN EVENTS' logo. The footer is a decorative banner with icons representing various fields: a gear, a green leaf, a red apple, a yellow lightbulb, a blue DNA helix, and a blue gear.

Australian Government
IP Australia

Slide - 55

EATNOW; EAT NOW; Eat Now; EatNow; Eatnow

Class 43: Provision of online ordering services for the supply of food and beverages via restaurants and fast food outlets and restaurant information services




Australian Government
IP Australia

Any Questions?

Please feel free to contact us if you would like to discuss anything further, or as questions arise over time, pertaining to our presentation.

THANK YOU

  IP Australia has achieved certification for its quality and environmental management systems.



www.ipaustralia.gov.au