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DAVIES COLLISON CAVE

IP Australia
15 JUN 2012
RECEIVED IPL

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Patent and Trade Mark Attorneys
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15 June 2012

The Registrar of Trade Marks
WODEN ACT 2606

Extension of Time to File a Notice of Opposition

Our Ref: 35108412/TKS

Re: Lituno Pty Ltd
Australian Trade Mark Application No. 1460218



In class 16

-and-

Proposed Opposition by 3M Company

We enclose:

1. Application for an Extension of Time to file Notice of Opposition;
2. Notification of Service;
3. Statutory Declaration of TREVOR STEVENS dated 7 June 2012;
4. Official fees: \$450.00

A copy of the Application has been sent to the attorneys acting for the Applicant.

Yours faithfully
DAVIES COLLISON CAVE

Trevor Stevens
TREVOR STEVENS

tstevens@davies.com.au

Extn Oppn Fee (TO): \$450.00

Sydney
Newcastle
Melbourne
Brisbane
Canberra

In association with:
Davies Collison Cave Solicitors
Intellectual Property Law

IP Australia Trade Marks Act 1995

PATENTS - TRADE MARKS - DESIGNS

Application for an Extension of Time to File a Notice of Opposition to the Registration of a Trade Mark

Trade Mark No 1460218

in the name of Lituno Pty Ltd

Details of person seeking Extension of Time

Name 3M Company

Address 3M Center, 2501 Hudson Road, St. Paul,
Minnesota 55144, United States of America

Address for Service in Australia Davies Collison Cave
Patent & Trade Mark Attorneys
Level 14, 255 Elizabeth Street
Sydney NSW 2000

Telephone: (02) 9293 1000
Facsimile: (02) 9262 1080

DCC Reference 35108412/TKS

We apply under Regulation 5.2 for an extension of time of 3 months within which to file a Notice of Opposition to the Registration of the abovementioned trade mark.

The ground for filing an application for an extension of time to file a notice of opposition as follows:

- the undertaking of genuine research to decide:
 - (a) whether opposition is justified; or
 - (b) on the grounds of opposition

A Declaration setting out the facts on which the above ground is based is enclosed.



Signature

Davies Collison Cave
Patent & Trade Mark
Attorneys

15 June 2012

COMMONWEALTH OF AUSTRALIA

TRADE MARKS ACT 1995

IN THE MATTER of Australian Trade
Mark Application No. 1460218 in the
name of Lituno Pty Ltd

-and-

IN THE MATTER of Opposition by 3M
Company

STATUTORY DECLARATION

I, TREVOR STEVENS of Level 14, 255 Elizabeth Street, Sydney, New South Wales, 2000, Australia, make the following declaration under the *Statutory Declarations Act of 1959*:

1. I am a solicitor in the employ of Davies Collison Cave of Level 14, 255 Elizabeth Street, Sydney, New South Wales and have conduct of this matter. I am authorised to make this Statutory Declaration on behalf of the prospective Opponent.
2. My firm acts for 3M Company of 3M Center, 2501 Hudson Road, St. Paul, Minnesota 55144, United States of America (the prospective Opponent) in relation to that company's trade marks in Australia.
3. On behalf of the prospective opponent enquiries are being undertaken in relation to any use of the trade mark STICKITS & device and the likelihood of confusion that might arise from such use.
4. In addition, the prospective opponent is taking steps to determine the extent of its reputation in Australia in the trade mark POST-IT and whether, based on that reputation, use of the applicant's trade mark is likely to cause deception.

5. A letter has been despatched to the applicant seeking a resolution to this matter without recourse to formal opposition.

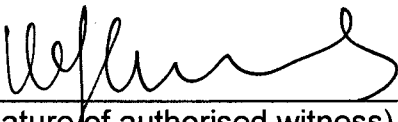
I understand that a person who intentionally makes a false statement in a Statutory Declaration is guilty of an offence under Section 11 of the *Statutory Declarations Act 1959*, and I believe that the statements in this Declaration are true in every particular.

DECLARED at Sydney this 7th day of June, 2012.



(Signature of Declarant)

Before me:



(Signature of authorised witness)

KIMBERLEY EVANS
A LEGAL PRACTITIONER HOLDING A CURRENT
PRACTISING CERTIFICATE UNDER THE
LEGAL PROFESSION ACT 1987
255 ELIZABETH STREET, SYDNEY 2000

IP Australia Trade Marks Act 1995


PATENTS - TRADE MARKS - DESIGNS

Notification of Service

We, 3M Company of 3M Center, 2501 Hudson Road, St. Paul, Minnesota 55144, United States of America

hereby give notice that on 15 June 2012 a copy of the Application for Extension of Time to file Notice of Opposition to the Registration of a Trade Mark and supporting Statutory Declaration in connection with Australian Trade Mark Application No. 1460218 in the name of Lituno Pty Ltd was served on Shamrock Design 28 Bell Avenue, Dubbo NSW 2830, the attorneys for the applicant, by registered mail.

The original Application for an Extension of Time to file Notice of Opposition to the Registration of a Trade Mark, and the supporting Statutory Declaration is attached hereto, together with a copy of the covering letter to Shamrock Design



Signature

Davies Collison Cave
Patent & Trade Mark
Attorneys

15 June 2012



DAVIES COLLISON CAVE

COPY

15 June 2012

Shamrock Design
28 Bell Avenue
Dubbo NSW 2830

REGISTERED MAIL

Patent and Trade Mark Attorneys
Australia and New Zealand

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Sydney New South Wales
2000 Australia

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ABN 22 077 969 519

In association with:
Davies Collison Cave Law
Intellectual Property

Our Ref: 35108412/TKS

Re: Lituno Pty Ltd
Australian Trade Mark Application No. 1460218



In class 16

Proposed Opposition thereto by 3M Company

Dear Sirs,

Please find enclosed a copy of an Application for an Extension of Time to file Notice of Opposition in relation to the above trade mark application.

Yours faithfully

DAVIES COLLISON CAVE

TREVOR STEVENS

tstevens@davies.com.au

*Encl.

Sydney
Newcastle
Melbourne
Brisbane
Canberra

Evidence for Hearings

TOO
JDL



DAVIES COLLISON CAVE

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Patent and Trade Mark Attorneys
Australia and New Zealand**

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January 16, 2013

The Registrar of Trade Marks
WODEN ACT 2606

Complete Evidence in Support

Our Ref: 35108412:TKS:DLK

Re: Lituno Pty Ltd
Australian Trade Mark Application No. 1460218
STICKITS & device in Class 16
-and-
Opposition by 3M Company

Sir,

We forward* herewith the following documents, being the opponent's complete evidence in support of the above opposition proceedings:

1. Declaration of Bob Sprague dated 19 December 2012 together with Exhibits A to J;
2. Notification of Service.

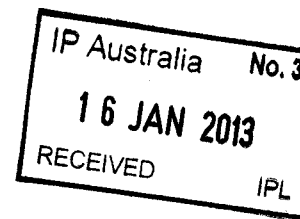
A copy of the evidence has been served on Shamrock Design, the applicant's address for service.

Yours faithfully,
DAVIES COLLISON CAVE

TREVOR STEVENS
Partner
tstevens@davies.com.au

DAWN LOGAN KEEFFE
Associate
dlogankeffe@davies.com.au

*Enc:



Sydney
Newcastle
Melbourne
Brisbane
Canberra

In association with:
Davies Collison Cave Solicitors
Intellectual Property Law

IP Australia Trade Marks Act 1995

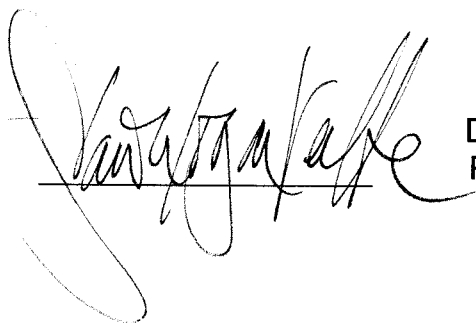
PATENTS - TRADE MARKS - DESIGNS

Notification of Service

We, 3M Company of 3M Center, 2501 Hudson Road, St. Paul, Minnesota 55144,
United States of America

hereby give notice that on 16th January 2013 a copy of the complete evidence in support of opposition to Australian Trade Mark Application No. 1460218 in the name of Lituno Pty Ltd was served on Shamrock Design, 28 Bell Avenue, Dubbo, NSW, 2830, the applicant's address for service, by Express Post.

The original evidence is attached hereto, together with a copy of the covering letter to Shamrock Design.



Davies Collison Cave
Patent & Trade Mark
Attorneys

16 January, 2013



DAVIES COLLISON CAVE

**Patent and Trade Mark Attorneys
Australia and New Zealand**

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ABN 22 077 969 519

In association with:
Davies Collison Cave Law
Intellectual Property

16 January, 2013

Shamrock Design
28 Bell Avenue
DUBBO NSW 2830

EXPRESS POST

Our Ref: 35108412:TKS:DLK
Re: Lituno Pty Ltd
Australian Trade Mark Application No. 1460218
STICKITS & device in Class 16
-and-
Opposition by 3M Company

Dear Sirs,

We forward* herewith copies of the following documents, being the opponent's complete evidence in support of the above opposition proceedings:

Declaration of Bob Sprague dated 19 December 2012 together with Exhibits A to J

The original evidence has been lodged with the Registrar of Trade Marks. Kindly advise the Registrar of the date of receipt.

Yours faithfully,
DAVIES COLLISON CAVE

COPY

TREVOR STEVENS
Partner
tstevens@davies.com.au

DAWN LOGAN KEEFFE
Associate
dlogankeeffe@davies.com.au

*Enc:

Sydney
Newcastle
Melbourne
Brisbane
Canberra

COMMONWEALTH OF AUSTRALIA

TRADE MARKS ACT 1995

IN THE MATTER of Australian
Trade Mark Application No.
1460218 (STICKITS & device)
in the name of Lituno Pty Ltd

AND

IN THE MATTER of
Opposition by 3M Company

DECLARATION

I, Bob Sprague of 2501 HUDSON ROAD, SAINT PAUL, MN 55144-1000, USA
make the following declaration:

1. I am Assistant Secretary
of
3M Company and I have been associated with my Company for 33
years. I have full access to the records of my Company and I am authorised to
make this Declaration on its behalf.
2. The following statements are made either on the basis of my own personal
knowledge or as a result of enquiries which I have made of other company
officers. My Company regards the information which is disclosed in this
Declaration, particularly insofar as it relates to sales figures and advertising
expenditure, as relating to the business affairs of the company within the
meaning of section 47 of the Freedom of Information Act 1982 (Cth) and to be
strictly confidential.

3. I am aware that my Company has opposed the trade mark STICKITS under application 1460218 and brief details of that trade mark are as follows:



Trade Mark:
Number: 1460218
Classes: 16
Date: 23 November 2011
Goods: Adhesive coated paper for stationery purposes;
adhesive pads (stationery); adhesive paper sheets
for stationery purposes; self-adhesive printed
matter

4. My Company is the owner of the trade mark POST-IT in Australia and attached hereto and marked **Exhibit A** is a schedule of my Company's registrations for the trade mark POST-IT in Australia.

HISTORY OF TRADE MARK POST-IT

5. My Company first used the trade mark POST-IT in the United States of America on or about 25 September 1974. This use of the trade mark related to paper and cardboard sheet material having adhesive coating on both sides thereof for attachment to walls or other vertical surfaces to hold displays or other messages in place. Attached hereto and marked **Exhibit B** is a copy of an extract from the USPTO records in respect of my Company's registration 1198694 for the trade mark POST-IT.

6. A summary of the background to – and history of – my Company's adoption and use of the trade mark POST-IT is included in **Exhibit C** attached to this declaration.
7. The trade mark POST-IT has been registered by my Company in numerous countries throughout the world and attached hereto as **Exhibit D** is a schedule of my Company's worldwide registrations for the trade mark POST-IT (word only).
8. **Annual sales worldwide**
 - 2005 - 563.19 million dollars
 - 2006 - 635.58 million dollars
 - 2007 - 649.14 million dollars
 - 2008 - 620.84 million dollars
 - 2009 - 541.03 million dollars
 - 2010 - 581.53 million dollars
 - 2011 - 598.31 million dollars
9. **Annual advertising expenditure worldwide**
 - 2005 - 35.86 million dollars
 - 2006 - 31.26 million dollars
 - 2007 - 40.38 million dollars
 - 2008 - 37.67 million dollars
 - 2009 - 28.24 million dollars
 - 2010 - 38.23 million dollars
 - 2011 - 35.87 million dollars

USE IN AUSTRALIA

10. To the best of my knowledge the trade mark POST-IT was first used in Australia in or around 1982.

11. Sales of products under the trade mark POST-IT in Australia have remained consistently high since the trade mark was first used in this country. Annual sales figures for POST-IT products in Australia since 2005 are as follows:

YEAR	VALUE (ex rebates)
2005	10,774,297
2006	10,294,784
2007	10,802,743
2008	11,702,775
2009	10,504,668
2010	11,215,547
2011	11,503,956

12. Advertising expenditure in Australia for goods under the trade mark POST-IT since 2008 are as follows:

YEAR	AMOUNT
2008	\$197K
2009	\$249K
2010	\$614K
2011	\$669K
2012 (plan)	\$573K

Sample advertisements showing the trade mark POST-IT are included with **Exhibit E** attached hereto.

13. My Company has undertaken various promotional and sponsorship activities in Australia under the trade mark POST-IT. These activities include the following:

- i. IGUAZU FALLS (Brazil) competition in December, 2008
- ii. POST-IT flags promotion, 2004
- ii. POST-IT and promotions – promotion products.com.au

Copies of advertisements in respect of these promotional activities are attached hereto and marked **Exhibit F**.

14. In Australia the 3M Australia Network webpage was launched in 1996 with information related to my Company's POST-IT products. Attached hereto and marked **Exhibit G** is an extract from http://www.wayback.archive.org/web/19960801000000*/http://www.3m.com.au.
15. Since the date of first use of the trade mark POST-IT in Australia, my Company's trade mark has been featured regularly in the Australian media. Selected examples of such media coverage are detailed below:
- i. Sydney Morning Herald 11 July 2002: "POST-IT NOTE ADVERTISING: *Coming to a newspaper near you*".
 - ii. B & T publication 7 March 2003: CASE STUDY: *Market notes campaign*.
 - iii. SBS World News 26 April 2010: "POST-IT NOTES celebrates 30th Birthday".
 - iv. WHAT NEXT? *Post-it Services the Postal System* 27 July 2010.
 - v. The Australian: "From Church Choir to iTunes for 3M's POST-IT" 30 August 2011.

Copies of each example of media coverage are attached hereto and marked **Exhibit H**.

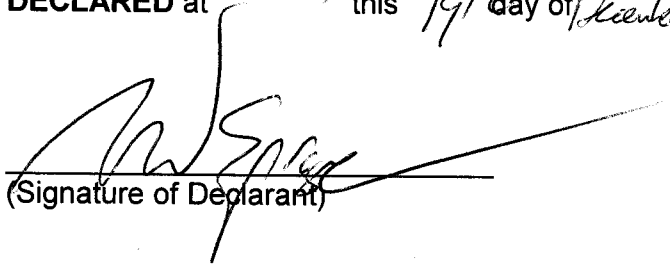
OPPOSED TRADE MARK

16. The priority date in respect of the opposed trade mark is 23 November 2011.
17. The goods specified under application 1460218 are "adhesive coated paper for stationery purposes; adhesive pads (stationery); adhesive paper sheets for stationery purposes; self-adhesive printed matter". These goods are identical to the goods under my Company's registrations for the trade mark POST-IT – in particular, registration 661954.

18. I consider that the trade mark STICKITS is deceptively similar to my Company's trade mark POST-IT for the following reasons:
- (i) The idea behind the words POST-IT and STICKITS is the same;
 - (ii) The construction of the word STICKITS – especially the use of the word "ITS" – is very similar to that of the word POST-IT;
 - (iii) From time to time my Company's POST-IT products are referred to as "sticky notes" and/or adhesive stickers;
 - (iv) The words adhesive stickers are specifically included in my Company's goods specification under registration 661954;
 - (v) The meaning of the word POST and the meaning of the word STICK is very similar – see attached extracts from the Macquarie Dictionary at **Exhibit I**.
19. Given that the respective goods are identical and given that the words POST-IT and STICKITS are closely similar, I consider that it cannot but be the case that confusion between the trade marks is likely.
20. From enquiries conducted on my behalf I believe that the Applicant has no intention to use the trade mark STICKITS and that there has been no use of that trade mark by the Applicant. Attached hereto and marked **Exhibit J** are copies of extracts from <http://www.shamrockdesign.com.au>.
21. It is unclear from these enquiries whether Lituno Pty Ltd actively trades in the relevant goods. However, application 1460218 includes a reference to SHAMROCK DESIGNS and it seems likely that the applicant conducts its business under that name.

I believe that the statements in this Declaration are true in every particular.

DECLARED at *st. Paul, Minnesota* this *19th* day of *December*, 2012


(Signature of Declarant)



ABN 38 113 072 755

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PO Box 200, Woden, ACT, 2606, Australia
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Davies Collison Cave
GPO Box 3876
SYDNEY NSW 2001

ADVICE REGARDING EXHIBITS

Re: Trade Mark Application No. 1460218 in the name of LITUNO PTY LTD and
opposition by 3M COMPANY.

Your Ref: 35108412/TKS

Dear Attorneys,

The accompanying exhibits were filed by you on behalf of the Opponent on 16 January 2013
in respect to the above mentioned proceedings.

As the proceedings have been finalised, the material is returned to you for appropriate
disposal.

Yours faithfully,

Kirsty Bailey
Hearings Support Officer
Trade Mark and Design Hearings
Direct Dial: (02) 6283 2057
06 February 2013