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Request to consider revocation of registration - trade marks 2044953 and 2044957.

Marshall Marks

PO Box 4046
SHELLHARBOUR NSW 2529
Australia



Trade mark number: 2044957
Your reference: LSA0011438
Owner name: TurfBreed Pty Ltd

Dear Mr Marshall,

I have discussed the matters relating to your request for revocation of registration of trade marks 2044953 and 2044957 with Deputy Registrar John Braybrooks.

Following the issuing of a Notice of Intention to Revoke Registration in relation to trade marks 2044953 and 2044957, dated 7th July 2022, I have considered submissions in response from the owner of the trade marks, as well as those you have submitted. We believe it is not appropriate to go through with the revocation of registration of these trade marks. The reasons are set out below.

Both the UPOV Convention and the International Code of Nomenclature for Cultivated Plants (ICNCP) allow for the use of a trade reference (also trade name or trade designation), although they are not bound or regulated by those documents. Given that under the UPOV Convention there is an obligation to use the denomination (which continues after expiry of the Plant Breeders Right), and that both the Convention and the Code stipulate that the denomination should be used in conjunction with any such trade reference, it follows that the intent is for a trade reference to function as an indicator of trade source and not as merely another denomination or synonym. I have also confirmed with colleagues in Plant Breeders Rights that it would not be appropriate to consider a trade reference as a synonym for the purposes of the Plant Breeders Rights Act 1994.

While acknowledging that trade references run the risk of becoming generic if not used correctly, in conjunction with and clearly differentiated from the denomination, we are satisfied that the owner of the registrations has demonstrated sufficient efforts to differentiate the trade marks from the variety name SS-500, even if some of their material and third parties referring to the variety do not always do so. The use of other trade names in the industry in relation to the same variety (SS-500) has also been taken into account.

The Sir Walter case, while confirming that denominations are the name of the plant and are not capable of distinguishing trade source, is not automatically applicable to trade references, which can be used in a

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manner where they do indicate trade source. I also acknowledge the Seadwarf Paspalum SDX-1 decision, but am not of the view that this single decision on the particular circumstances and evidence of that Hearing should override the principles already outlined.

The quoted passage of the Trade Mark Examiners Manual is intended to acknowledge that a trade reference is not automatically equivalent to a trade mark, but is dependent on other factors, which are articulated as they are above. Although trade references are usually applied to a single variety, this fact alone does not preclude operation as an indicator of trade source, in the same way as any other trade mark for a single product.

In relation to section 84A(1)(a) it is not clear that the trade marks should not have been registered, as the trade reference had been identified and considered, and the use in the examination research assessed as use in conjunction with the denomination. It is also not clear that it is reasonable to revoke, taking into account all the circumstances, under section 84A(1)(b), given that we can't say with certainty that the trade marks have become the generic name of the variety.

Yours sincerely,

Graham Brown
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