



26 August 2022



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Adverse Examination Further Report

Ashurst Australia

GPO Box 9938
SYDNEY NSW 2001
Australia

Trade mark number: 2275899
Your reference: LMR MSUN BETSTOP
Trade mark: BETSTOP
Applicant name: The Commonwealth of Australia as represented by the Australian Communications and Media Authority

Dear Applicant,

Your application does not meet the requirements of the *Trade Marks Act 1995*. The issues currently preventing acceptance of your application are explained in the attached Adverse Examination Report number 2.

You have until **14 September 2023** to overcome all the issues otherwise your application will lapse.

Please reply to the report in writing, no later than 20 business days prior to 14 September 2023. For assistance with our online lodgement services please contact **1300 65 10 10**.

The trade mark examiner who produced this report is **Ida Pereira** and their direct line is **+61 2 6283 2623**. If you have been unable to reach your examiner directly, another examiner who may be able to assist you can be reached on +61 2 6283 2211.

Things to be aware of

For information on how to respond to the Adverse Examination Report refer to [our website](#).

Details of your trade mark can be viewed using our [Australian trade mark search](#) on our website.

Yours sincerely,
IP Australia

Your progress

- ☒ **Lodgement**
Application is lodged
(response within 5 working days)
- ☒ **Examination**
Application is examined
- Acceptance**
Application is accepted
(enters an opposition period lasting 2 months)
- Registration**
Trade mark is registered
(certificate of registration is issued)
- Renewal**
Trade mark is due for renewal
(renewal due every 10 years)

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Make an enquiry or provide feedback on our [website](#).

Adverse examination report

The following issues have been raised under the Trade Marks Act 1995 and will need to be addressed before your trade mark can be accepted.

- Issues raised under Section 41 of the Trade Marks Act 1995.

Issues raised under Section 41 of the Trade Marks Act 1995.

Thank you for your letter of 20 July 2022 in response to the first report of 14 June 2022.

With regard to the s41 ground for rejection raised in respect of the trade mark BETSTOP, I note that your client has submitted arguments to overcome the ground for rejection. I have considered your arguments and discussed the application with a Team Leader, but I am maintaining the ground for rejection and my reasons are set out below.

You have submitted arguments that the trade mark BET STOP is an unusual word invented by your client and has no immediately obvious or direct meaning. I do not find this a persuasive argument to overcome the Section 41 grounds for rejection. This is because the words BET and STOP both have ordinary dictionary meanings, of which a person of average intelligence would be aware. Combined, the words form an expression that results in the two words a whole conveying a meaning that is not inherently suggestive of a trade source.

Further, I note your reference to the recent assessment in *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* [2014] HCA. I cannot agree that the section 41 considerations of the 'Cantarella' decision are entirely analogous or relevant to the examination at hand. In this case the section 41 considerations were made regarding the inherent adaption to distinguish of Italian words within an Australian market place. I agree with your submissions that the High Court has correctly placed the focus on the ordinary meaning of the relevant words when assessing distinctiveness. As outlined above, the ordinary signification of the individual words BET and STOP, and the phrase as a whole BETSTOP, have been considered, and it is this ordinary significance on which the grounds for rejection have been raised.

The fact that the combined words BETSTOP may not directly describe the relevant goods and/or services, nor are they the only or natural words applicable to the goods indicates that the phrase possesses some limited inherent adaptation to distinguish. However, this does not mean that it is *prima facie* capable of distinguishing your client's goods and services from those of their competitors, but rather that grounds for rejection under subsection 41(4) of the Trade Marks Act 1995 are warranted rather than under subsection 41(3).

You have argued that other traders are not currently using the term BETSTOP to describe their own goods and/or services. Actual use is not the test of inherent adaptation to distinguish; "Inherent adaptability is something which depends on the nature of the trade mark itself - see *Clark Equipment Co v Registrar of Trade Marks* [(1964) 111 CLR 511 at 515 - the Michigan case] - and therefore is not something that can be acquired; the inherent nature of the trade mark itself cannot be changed by use or otherwise." (*Burger King Corporation v Registrar of Trade Marks* (1973) 128 CLR 417 at 424 ('The Whopper Case') per Gibbs J).

You have also highlighted that your client the Australian Communications and Media Authority (ACMA) is responsible for regulating interactive gambling activities under the Interactive Gambling Act 2001 (IGA) and that your client chose BETSTOP as the public facing brand. You also state that your client is the only statutory body that is authorised to operate the BETSTOP branded scheme and to provide goods and services in Australia.

Being named in a piece of legislation is not sufficient to apply the provisions of other circumstance under 41(4) – the reason being is the legislation does not prevent other traders of similar goods/services from using the word/s BETSTOP – for example, if someone wished to publish a self-help book about how to

stop betting, they may honestly wish to make use of BET STOP. Similarly, if a trader wished to sell software that blocked betting websites from the user's devices, they also may wish to make honest use of BETSTOP. These examples aren't exhaustive of the ways that other traders are going to desire to make use of the mark.

If the legislative instrument said that no one who provides those services could use the words BETSTOP in Australia, that would be more persuasive, however the legislation you have provided does not say that. Your client has also claimed a very broad range of goods and services that include many things that appear to be different to the services the legislation implies they provide under the BETSTOP trade mark.

Finally, regarding the presumption of registrability, French J in Kenman Kandy states as follows:

The application must be accepted unless the Court is satisfied that it has not been made in accordance with the Act or that there are grounds for rejecting it. If the matter is in doubt then the application should be accepted. The possibility of refusal after a contested opposition with evidence and closer scrutiny remains open. The acceptance stage is not the time for detailed adversarial examination of the application that might be involved in an opposition - Registrar of Trade Marks v Woolworths at 377.

In other words, if the Registrar is not satisfied that the mark is registrable then a ground for rejection is warranted. Only if the Registrar is unsure on this particular issue and cannot decide either way does the presumption of registrability apply. That is not the case here. I am satisfied, on the balance of probabilities, that the ground for rejection I have raised does apply and accordingly I am maintaining it.

Accordingly, the s41 ground for rejection is maintained for the reasons set out above. I will reconsider the s41 ground for rejection if your client provides evidence of use of the trade mark.
