



Patents

Trade Marks

Info Services

Designs

Legal Services

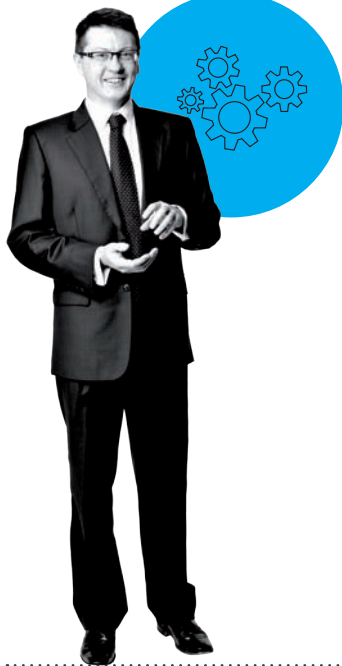
Issue 18 • Summer 2012

Season's Greetings

2012 has been a strong year for Phillips Ormonde Fitzpatrick with the growth of our anti-counterfeiting business and international recognition for our work in medical technology. Our partners have played major roles in local and international IP organisations including FICPI, IPTA and AIPPI and have travelled widely around the world.

Next year also promises to be a big one for Phillips Ormonde Fitzpatrick. In 2013 we will reach a significant milestone when the Firm turns 125. Back in 1888, William D Rollingson commenced practice as a registered Patent Agent in Melbourne. His practice encompassed the six original Australian colonies (now Australian States) with their separate legislation for the protection of inventions, trade marks, designs and copyrights.

Fast forward to 2012 and much has changed in the intellectual property arena. In our next edition of Inspire, we will be sharing some of the highlights of our journey from 1888 – none of which would be possible without you, our valued clients and associates. If you have a POF story you would like to share, please let us know.



On behalf of the partners and staff of Phillips Ormonde Fitzpatrick, I would like to wish all our clients and associates best wishes for the festive season and we look forward to working with you in our anniversary year, 2013.

**Chris Schlicht, Partner,
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Office closure

Phillips Ormonde Fitzpatrick will be closed from Tuesday 25 December 2012 to Tuesday 1 January 2013 (inclusive) due to a series of public holidays in Australia. The offices will open for business as usual from Wednesday 2 January 2013.

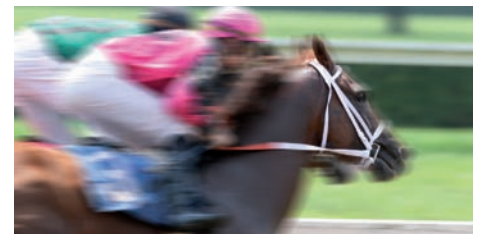
IP Australia, the Australian Patent, Trade Marks and Designs office, will also be closed during this time. Any deadlines which fall due within these days will automatically extend to the next business day. If you have any matters which you require to be handled during this period, please advise us as soon as possible.



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Beware of fraudulent IP protection services

Australian renewal scam alert

by Rodney Cruise

We all know the value of registering a trade mark. However, if you own a trade mark or have made an application, you may be targeted by scammers invoicing you for unsolicited services relating to your trade mark and/or domain name. Communications received from unfamiliar organisations, especially letters requesting payment for unsolicited services, should be treated with caution.

Scams of this type are becoming increasingly common on a global scale.

Both IP Australia and World Intellectual Property Organisation (WIPO) have issued warnings to look out for invoices for fees that do not come from the International Bureau of WIPO and are unrelated to the processing of international applications under the Madrid Agreement.

The notices are typically issued by organisations claiming to be trade mark bodies such as "Patent and Trademark Organisation LLC" (based in USA with a Melbourne street address). These companies are generally based overseas, and fraudulently offer protection of your intellectual property, such as through promotional and advertising services or registration and maintenance of your trade mark and/or domain name. They may offer trade mark monitoring services, registration or renewal services in another country, or services to oppose a third party's trade mark application on your behalf.



If POF has applied for trade mark protection in Australia on your behalf, our firm is recorded as your official Address for Service. This means we will receive all official correspondence from IP Australia in relation to your trade mark application and/or registration and will contact you when it is time to renew your trade mark.

Each of the scam invoices appear official and it is not obvious they are fraudulent. Unfortunately, in many businesses, these invoices are received by accounting departments, which may be unaware that the invoices are for unsolicited services with the result that the business can lose thousands of dollars. Scamming companies take advantage of those who are not fully informed. If you receive an unsolicited invoice in relation to your intellectual property, we ask that you keep vigilant and treat any letter and/or invoice, from unfamiliar organisations, with caution.

For WIPO's list of examples, visit: www.ipaustralia.gov.au/ip-infringement/unsolicited-ip-services/

Rodney Cruise is a Partner of Phillips Ormonde Fitzpatrick and the Manager of their associated Intellectual Property research company, IP Organisers Pty Ltd.

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Changes to Australian Patent Law

10 things to do before 15 April 2013

by Graham Cowin

The Intellectual Property Laws Amendment (Raising the Bar) Act 2012 has now been passed by the Australian parliament. Most provisions of the Act will come into effect on 15 April 2013 and there are (at least) 10 things to consider doing before this date:

1. Request examination or modified examination prior to commencement for all Australian complete patent applications.
2. Request deferment of acceptance of any pending complete applications prior to commencement.
3. Enter the National phase in Australia and request examination prior to commencement for all pending PCT applications.
4. File a Convention application and an examination request prior to commencement where a PCT application has not been filed.
5. File a complete application and an examination request prior to commencement for Australian provisional applications.
6. File any required divisional applications with an examination request prior to commencement.
7. Convert pending applications which are intended to claim divisional status prior to commencement if the deadline for filing a new divisional application has already passed.
8. If it is intended to withdraw an opposed application, file any required divisional applications (with an examination request) and withdraw the opposed application prior to commencement.
9. Include sufficient description to provide the necessary level of "support" for claims in Australian provisional applications intended for completion after commencement.
10. Amend the specifications of pending applications prior to commencement to clearly describe the utility of the invention and to provide the necessary level of "support" for the claims.

Please contact us at attorney@pof.com.au if you need further assistance in determining what action you should take in relation to any pending or proposed new Australian patent applications.

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The bad faith ground of trade mark opposition – some judicial insight¹

Registering a business name is not the same as having rights in a name.

by Margaret Ryan

Once a trade mark application is accepted for registration, anyone has the opportunity to oppose registration on any of the various grounds set out in the *Trade Marks Act 1995* (TMA). Introduced to the TMA in 2006 was the ground of opposition that the trade mark application was made in bad faith.

Dodds-Streeton J examined this issue in detail in *Fry Consulting Pty Ltd v Sports Warehouse Inc* (No.2)[2012] FCA 81.

The facts

Since 1994 Sports Warehouse sold tennis goods, principally online, under the trade mark TENNIS WAREHOUSE, recently using the domain name www.tenniswarehouse.com. Sales to customers in the United States accounted for 80 – 85 per cent of sales but, between 1995 and 2006, US\$1.14million worth of goods were sold to Australia.

In 2004 Mr Fry commenced selling tennis goods online. He visited the Sports Warehouse website and adopted the name TENNIS WAREHOUSE and the domain name www.tenniswarehouse.com.au even though he was aware Sports Warehouse sold into Australia. He was also aware there would be confusion between the domain names and chose the name specifically. Mr Fry even copied some images from the Sports Warehouse site.

In December 2004 Sports Warehouse emailed Mr Fry claiming it had a 'worldwide trade mark on the name Tennis Warehouse' and demanding all use cease. Mr Fry asked for evidence indicating that if it was provided, he would trade under a different name. He also stated he owned the business name 'Tennis Warehouse' in Australia and:

When applying for this the Australian Business Register does a search to make sure it is not conflicting or breaching any trade marks. This name passed all checks and I was able to obtain it.

After stating they would provide the requested documentation, Sports Warehouse did not communicate further with Mr Fry for two years. Meanwhile Fry Consulting built up its business and adopted the name TENNIS WAREHOUSE AUSTRALIA.

¹ Di Trocchio L and Goldberg R, 2009, 'Trade mark registration – opposition on the ground of bad faith', *Keeping good companies*, Vol 61 No 9, pp 552 – 555

In 2006 Fry Consulting's solicitors wrote to solicitors for Sports Warehouse demanding that Sports Warehouse cease using the name TENNIS WAREHOUSE in Australia. This provoked a corresponding demand that Fry Consulting cease using TENNIS WAREHOUSE AUSTRALIA. This prompted Fry Consulting to apply to register the trade mark TENNIS WAREHOUSE AUSTRALIA in logo form (with a stylised tennis ball), which was opposed by Sports Warehouse.

Principles for cases of bad faith

Below are the principles of law which emerge from this case for determining whether the ground of bad faith is made out.

1. Whether there has been bad faith is tested at the date of the trade mark application.
2. Bad faith must relate to the making of the trade mark the subject of the application (which here was the logo rather than just the trade mark TENNIS WAREHOUSE AUSTRALIA).
3. The onus of proving bad faith lies with the trade mark opponent. It is a serious allegation that requires cogent evidence but the standard of proof is the normal civil standard of the balance of probabilities. It is not necessary to prove bad faith beyond reasonable doubt.
4. It is not necessary to establish dishonesty or fraud to prove bad faith although these will be sufficient. Bad faith is wider than these.
5. The test for bad faith is a combined test involving both subjective and objective elements. The court must decide whether the knowledge of the trade mark applicant was such that its decision to apply for registration would be regarded as in bad faith by persons adopting the proper standards – falling short of the standards of acceptable commercial behaviour observed by reasonable and experienced persons in this particular area.
6. However, Dodds-Streeton J warned against an overly literal application of the requirement of a 'falling short of the standards of acceptable commercial behaviour' – this may negate the importance of the applicant's mental state.

7. Mere negligence, incompetence or a lack of prudence to reasonable and experienced standards would not, of themselves, amount to bad faith. It requires conduct of an unscrupulous, underhand or unconscious character.
8. Dodds-Streeton J rejected the argument advanced by Sports Warehouse that mere awareness that an overseas company, which owns a trade mark, is already operating or intending to operate in Australia would amount to bad faith. The correct question is whether in all the circumstances, the applicant's knowledge was such that its decision to apply for registration at the relevant date would be regarded as in bad faith by persons adopting proper standards.

Application of these principles to the facts

The court noted Mr Fry adopted the name TENNIS WAREHOUSE knowing it operated overseas, had made sales to Australia and was aware consumers could be confused, at least in relation to the domain names. Dodds-Streeton J characterised his conduct as exploitative and designed to acquire a springboard or advantage for his fledgling business. The court considered, if Fry Consulting had attempted to register its mark in 2004 when it was first adopted, this may well have been in bad faith.

However, two years passed before Fry Consulting made its application and correspondence had passed between the parties. The court considered this correspondence changed everything. Mr Fry had been willing to cease using the trade mark if Sports Warehouse had proved its entitlement to it.

The TENNIS WAREHOUSE trade mark was not registered in Australia. (Sports Warehouse subsequently tried to register the mark and the application was opposed by Fry Consulting. In an appeal to the Federal Court, Sports Warehouse was not successful in achieving registration².)

² *Sports Warehouse Inc v Fry Consulting Pty Ltd* (2010) 87 IPR 300

In 2004 Sports Warehouse could have alleged that Fry Consulting was passing off its business as Sports Warehouse, based on Sports Warehouse's existing sales to Australia, and could have also alleged misleading and deceptive conduct. However, Sports Warehouse was silent for two years, during which time Fry Consulting built up its business.

Mr Fry's statement that 'the Australian Business Register does a search to make sure it is not conflicting or breaching any trade marks' is incorrect. Only a brief check is conducted to make sure the name or something virtually identical is not already registered. No search of trade marks is conducted. However, Mr Fry believed this and this was relevant to the subjective element of the test of bad faith.

The court held that, as at December 2006 when the logo trade mark was applied for by Fry Consulting, Sports Warehouse failed to prove Fry Consulting's trade mark application was in bad faith.

Lessons to be learnt

After two oppositions and two court cases, Fry Consulting was successful. But at what cost? A number of lessons can be learnt from the case.

Copying an online trade mark

Copying an online trade mark, especially a site with online sales is fraught with danger. The traditional view is that copying an overseas trade mark that is not used in Australia is 'sharp practice' but is not prohibited by the TMA³. Nowadays, if goods are being sold over the internet under a trade mark, there may well already be sales to Australia.

If the copyist applies for trade mark registration and the online trader proves prior sales to Australia, the latter may be able to prove prior ownership in a trade mark opposition. If the online trader has a reputation in Australia, it may also be able to prove the copyist has passed off its goods and business as the online trader.

³ Re Registered Trade Mark "Yanx"; ex parte Amalgamated Tobacco Corporation Limited (1951) 82 CLR 199 at p 202

In this case, Fry Consulting was actually aware of sales by Sports Warehouse into Australia and sought to take advantage of confusion of their domain names. Had it been sued in 2004, depending on the strength of the evidence of reputation in the TENNIS WAREHOUSE trade mark, Sports Warehouse may have been able to prevent Fry Consulting from using its TENNIS WAREHOUSE AUSTRALIA logo trade mark. The motives of Mr Fry would have told against Fry Consulting. As the court considered, if Fry Consulting had applied for its trade mark at this point, an opposition would have succeeded on the grounds of bad faith.

Business Name Registration

Ownership of a business name gives no rights in the name. To gain rights in a name, one needs to register a trade mark.

Mr Fry made a very common mistake in thinking his business name registration gave him the all clear to use TENNIS WAREHOUSE in Australia. A full trade mark search is recommended when adopting a new name.

Asserting one's rights

Sports Warehouse made a fatal mistake in just letting the matter lie for two years. It had promised to justify its position and then failed to do so. To be effective, trade mark rights need to be policed.

Trade mark oppositions

Sports Warehouse and Fry Consulting engaged in oppositions of each other's trade marks. The opposition can serve as a mini trial of the issues in dispute between the two parties and the losing party may cease using its mark as a result (although this is not the legal purpose of a trade mark opposition).

To be able to oppose a trade mark application, a business must know of its acceptance. Watches are a good way of letting a business know what competitors are doing and enable it to oppose a trade mark when it is advertised for acceptance.

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IP Evaluation Panel at University of Western Sydney

Quality innovations bode well for the future of commercialism.

by Daniel McKinley

The University of Western Sydney (UWS) recently convened an Intellectual Property Evaluation Panel to assist the University to assess and commercialise innovations developed by research staff and students of the University. The Panel was assembled on 7 September 2012, at the Female Orphan School, Parramatta Campus.

Daniel McKinley, Patent Attorney and Lawyer, attended as an expert member of the Panel along with a number of senior university staff and external experts in innovation and commercialisation.

Innovations developed by research staff and students were presented to the Panel who in turn provided feedback regarding intellectual property protection and commercialisation potential.

Many of the innovations presented were well advanced and had potential for commercial application. For these inventions the panel feedback was directed towards fine

tuning the presentation of the innovations to potential commercial partners of the University. Other innovations had good potential and the feedback from the panel was that further development and experimental evidence was required before a decision on prospects of commercial success could be determined.

The quality of the innovations and their commercial potential was of a high standard and bodes well for the future of commercialisation of innovations by and from the University. The feedback provided by panel members to the researchers was well received and should assist them in their further efforts to innovate and convert their ideas into a commercial reality.

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UWS IP Evaluation Panel 7 September 2012, Dean's Boardroom, Parramatta, NSW.



Australian Clean Technologies Competition 2012

A diverse and exciting range of entries were received in this year's competition.

by Davin Merritt

Davin Merritt, Edwin Patterson and Andrew Massie recently played host to a number of the Firm's sustainability clients at the 2012 Australian Clean Technologies Competition Gala Dinner held at the Melbourne Aquarium on 4 October.

In Australia, the clean technologies industry is worth \$26 billion and employs over 45,000 people nationally. The aim of the Australian Clean Technologies Competition is to showcase Australian innovators and technology directed at the aims of reducing energy and resource consumption. This year, the competition received over 100 entries tackling a range of issues including pollution, energy efficiency, renewable energies, green buildings, smart electricity grids and new transportation systems.

Congratulations to POF's client, Advanced Plant Nutrition, who were finalists for 2012.

Advanced Plant Nutrition has developed an innovative product (MaxSil) from postconsumer waste glass which will reduce the amount of waste being taken to landfill and can be used to significantly increase

plant nutrient uptake and increase crop yields by up to 25%.

The product is based on research into the grinding of waste glass into fine particles which was found to provide an excellent source of plant available silica once the particle size distribution of the ground glass was within certain parameters. This innovative product has the potential to not only significantly reduce the amount of waste glass dumped into landfill, but also significantly increase crop yields in many soils that are deficient in plant available silica.

Submissions for the awards will open again in 2013. Ideas can be as diverse as technologies, services and policies to address pollution, waste treatment and energy storage, as well as new ways of looking at energy efficiency, building materials and transportation systems. For more information visit: www.cleantechopen.com.au

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Phillips Ormonde Fitzpatrick – Partner news

> Alyssa Grabb elected to FICPI Australia Council

On September 9, Alyssa Grabb was elected to the FICPI Australia Council at the 2012 Australian Special General Meeting. FICPI is an international organisation that represents IP professionals in private practice. It is involved extensively in IP law reform. In Australia it has recently been actively involved in discussions with IP Australia concerning changes in patent, design and trade mark laws and proposals concerning Trans-Tasman cooperation.

Alyssa has been practicing as a registered Patent and Trade Mark attorney since 2003. As a member of the Electronics, Physics and Information Technology team, Alyssa's technical speciality is in the area of medical devices and instrumentation.

Phillips Ormonde Fitzpatrick congratulates Alyssa on her election.



Alyssa Grabb

Phillips Ormonde Fitzpatrick ready for B2B

Phillips Ormonde Fitzpatrick's initial efforts to be B2B compliant have streamlined communications with IP Australia and our clients.

by Graham Cowin



Phillips Ormonde Fitzpatrick (POF) has recently completed extensive IT development work and in-house training to take advantage of business-to-business (B2B) transaction facilities being progressively introduced by IP Australia. These efforts will benefit you through more secure and reliable processing of instructions, as well as lower fees.

B2B technology has been developed by IP Australia to cater for the needs of high volume users of IP Australia's services, such as POF. The technology is based around a portal enabling direct exchange of transactions between IP Australia and our offices. Advantages to clients include the provision of immediate acknowledgement and validation reports on document filing, giving additional confidence that critical transactions have been completed properly and on time. B2B will also improve the accuracy of data captured in transactions allowing us to complete large volume transactions, such as renewals, more quickly and efficiently. Importantly, lower fees will apply to transactions handled through B2B.

We have a dedicated, in-house IT team focussed on developing IT systems and applications for our business operations. Our database and document management facilities, or 'POFDocs' (developed by POF), integrates leading edge technology, state-of-the-art infrastructure, and ongoing user training.

When POFDocs was introduced several years ago, we converted our paper based records and case files to electronic format, allowing the move to an exclusively electronic workplace. With this well established experience, we have now been able to move quickly and easily into the B2B environment. This will ensure we remain at the forefront of efficient and cost effective IP management, to the benefit of all our clients.

IP Australia has been working on B2B for several years, and our IT team has been a vital member of the user group assisting that development. Input from our team has provided a critical user perspective which will translate into long-term benefits, particularly for applicants and owners of Australian IP rights.

The B2B facilities are being released in stages to ease implementation difficulties. The first stage was patent, trade mark and design renewals which we have been successfully handling for several months. Real-time processing available through B2B means we are able to initiate and complete a renewal action in a single session. The previous need for multiple communications between IP Australia, the client and ourselves, including follow up reminders, over a time frame of weeks has been replaced with secure confirmed communications completed in a single action. This simplified communication with both IP Australia and our clients means renewal costs can be minimised.

The next stage to be introduced shortly will extend to more complex transactions, including new application filings and patent examination requests. Further stages, including trade mark and design amendments and design examination requests are scheduled to become available during 2013.

IP Australia has adopted a policy based on official fee incentives to encourage user migration toward electronic communications. In practical terms this means different fee regimes for traditional paper and emerging electronic based transactions.

As of October 1 2012, higher official fees apply to paper based transactions. We have been able to avoid those higher fees through implementation of B2B. The savings achieved are and will continue to be passed on to our clients.



Our experience has been that attorney firm systems require significant additional development, testing and maintenance to establish a B2B link with IP Australia. There are also other obligations, including the requirement for a digital certificate which is used to secure the transfer of communications between IP Australia and the user. As a result of these complex implementation requirements, and

associated development costs, those B2B facilities are not likely to be attractive or readily accessible to the occasional or smaller direct user of IP Australia's services. However, we consider our early efforts to become B2B compliant justified because of the opportunities for more secure, responsive and streamlined communications with IP Australia and our clients.

We look forward to sharing these new and exciting opportunities with you.

Graham Cowin is Managing Partner of Phillips Ormonde Fitzpatrick.

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The Melbourne Cup + who owns racehorse trade marks?

Racehorse owners can no longer file their own trade marks.

by Mark Williams

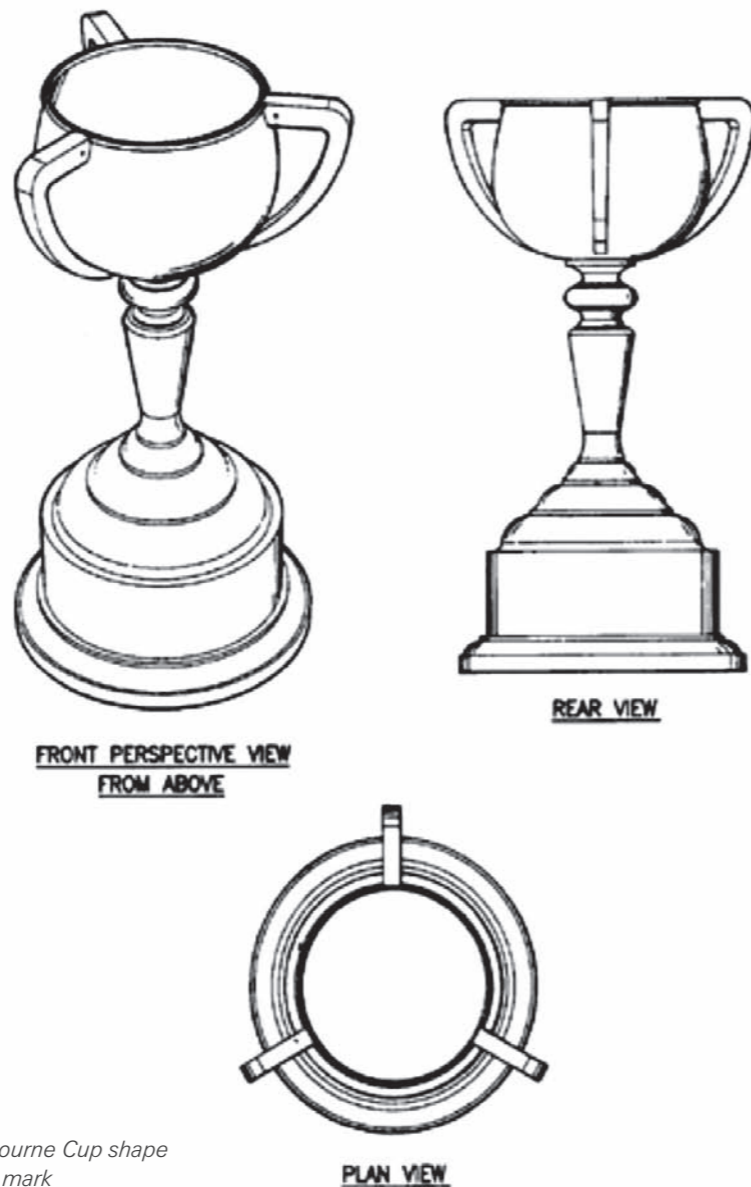
In Australia, the first Tuesday in November is synonymous with The Melbourne Cup. Run by the Victoria Racing Club, the Melbourne Cup has been held since 1861 and is witnessed by over 100,000 spectators at Flemington racecourse and millions of viewers around the world.

Not surprisingly, 'the race that stops a nation'TM has a number of trade marks associated with it including the cup itself (in the form of a shape trade mark) as well as name of the overall carnival being the 'Spring Racing Carnival'TM.

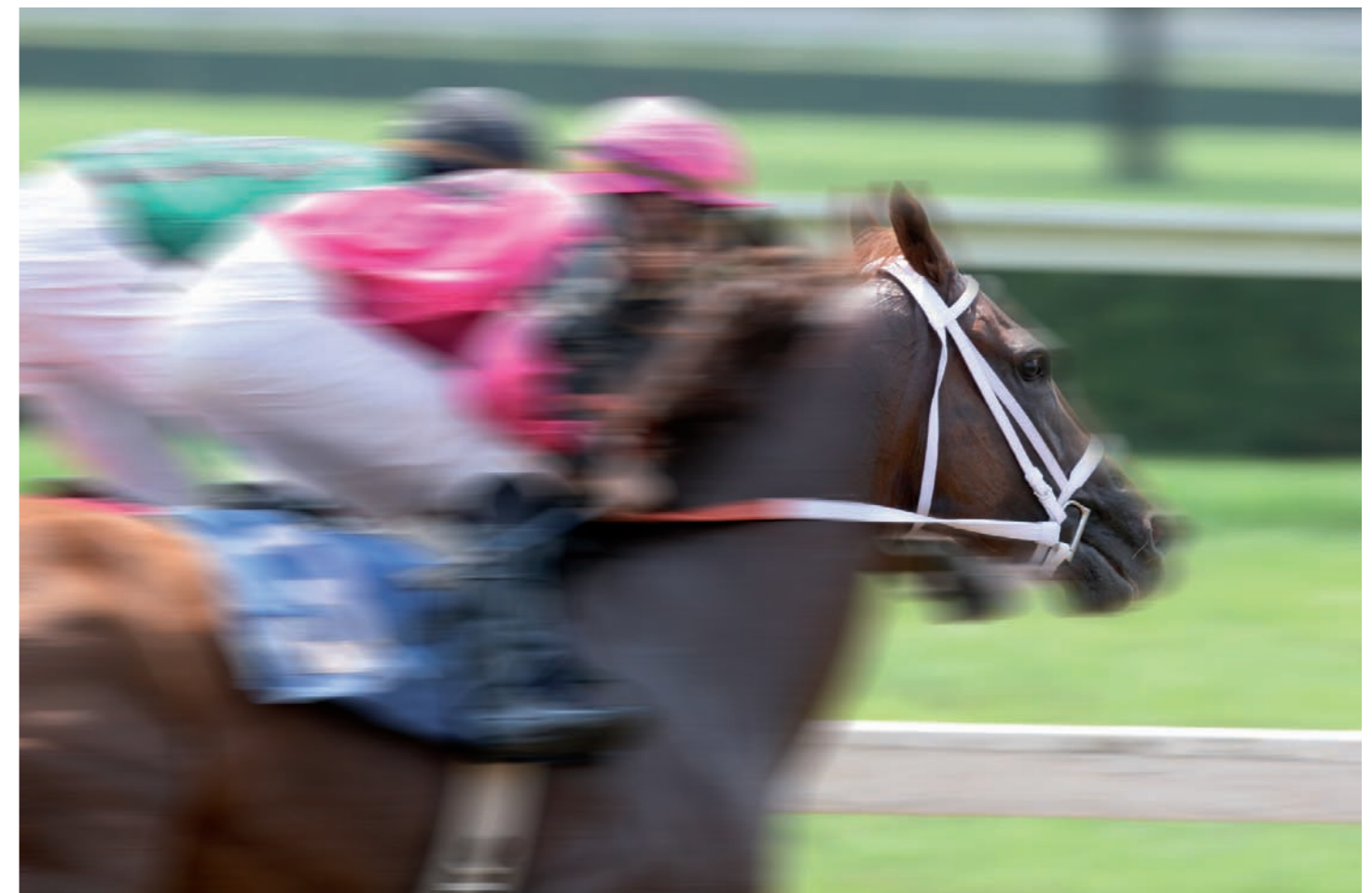
Changes to Intellectual Property Ownership of Racehorses

As you might expect, many of the racehorses racing in the Spring Racing Carnival have themselves become well known, and in the past some owners have sought to protect the intellectual property associated with the racehorse (typically in the form of trade marks).

For example, the owners of three time consecutive Melbourne Cup winner



Melbourne Cup shape trade mark



Makybe Diva have registered a trade mark in respect of 20 odd classes of goods/ services. Other Aussie thoroughbreds associated with registered trade marks include Weekend Hussler and Black Caviar (and even the pattern of the silks worn by jockey Luke Nolen – salmon colour with black dots (right)).

However, the days of racehorse owners filing for their own trade marks for racehorses are over. As of 1 October 2012, as a condition of registering a racehorse under AR18.1A(1) of the Australian Rules of Racing, RISA requires that owners agree not to apply to register any of the "the racehorse indicia" as a trade mark; and not to bring any claim of ownership of any intellectual property rights in the "the racehorse indicia".

In return, under AR.18A.(2) the Registrar of Racehorses grants the owners a non-

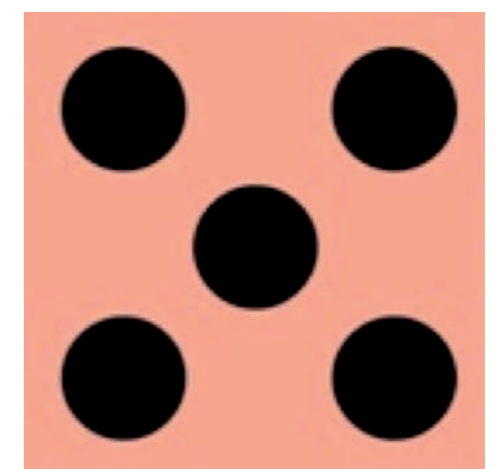
exclusive, royalty-free and non-transferable licence (which can be sub-licensed to any person) to use "the racehorse indicia" for any purpose related to dealing with the horse (including merchandising).

Effectively this stops owners from filing their own trade marks – rather, the trade marks may be filed (and owned) by the Registrar of Racehorses who may grant permission to license the trade mark to the racehorse owner.

This situation is not unusual in sport – for example in Australia, trade mark ownership in the sports of Australian Rules Football and Australian Rugby League are all controlled by the body that runs the sport.

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Black Caviar's racing colours of salmon with black dots has been trade marked.

Patent Prosecution Highway between US and AU extended indefinitely

**Continuation of the Pilot
program between the
US and Australia.**

by Daniel McKinley

The Patent Prosecution Highway (PPH) pilot program and the PCT Patent Prosecution Highway (PPH) pilot program between the US Patent Office (USPTO) and the Australian Patent Office (IP Australia) was due to expire on 13 April 2012. However, the USPTO and IP Australia agreed, with effect from 15 July 2012, the programs be extended indefinitely.

Under the PPH pilot programs between the US and Australia, an applicant in one country may request accelerated examination of a Patent Application in the other country, based on a positive ruling from either the USPTO or IP Australia on novelty and inventive step/obviousness in relation to one or more claims of a Patent Application. This includes National Patent Applications or International Patent Applications where the USPTO or IP Australia are acting in their capacity as an International Searching Authority. This means if an applicant has received a positive opinion on the novelty or inventiveness of one or more claims of a US or Australian or an International Patent Application from either the USPTO or IP Australia then the applicant can seek to have examination of a corresponding Patent Application in the other jurisdiction accelerated.

There is no official fee for entering the PCT PPH program in the US or Australia. To be eligible for accelerated examination under the PCT PPH program, the corresponding Patent Application must include claims that are of the same, similar or narrower scope to the claims of the Patent Application the subject to the positive opinion. The most notable drawback to the program is if the Examiner does not concur with the previous positive opinion and new objections are raised then it is not possible to amend the claims of the corresponding Patent Application to include limitations not already present in the claims at the time the PPH request is filed.

Nonetheless, there can be many advantages to accelerating the processing of patent applications through to grant, such as bringing forward the patentee's ability to take action for Patent Infringement.

If you would like to hear more about the Patent Prosecution Highway pilot program and the PCT Patent Prosecution Highway pilot program between the USPTO and IP Australia and how these programs can benefit you, contact Daniel McKinley.

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