

# Trade Mark Tips for Practitioners

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# Overview

Simon Gallagher

Statistics/trends

New online services

Other activities

Trade Marks (International Treaties and Enforcement)  
Amendment Bill)

Comparative examination project with Australia

Simon Pope

Overview of examination systems

Confusingly similar marks

Evidence

Slogans

Maori Trade Marks Advisory Committee

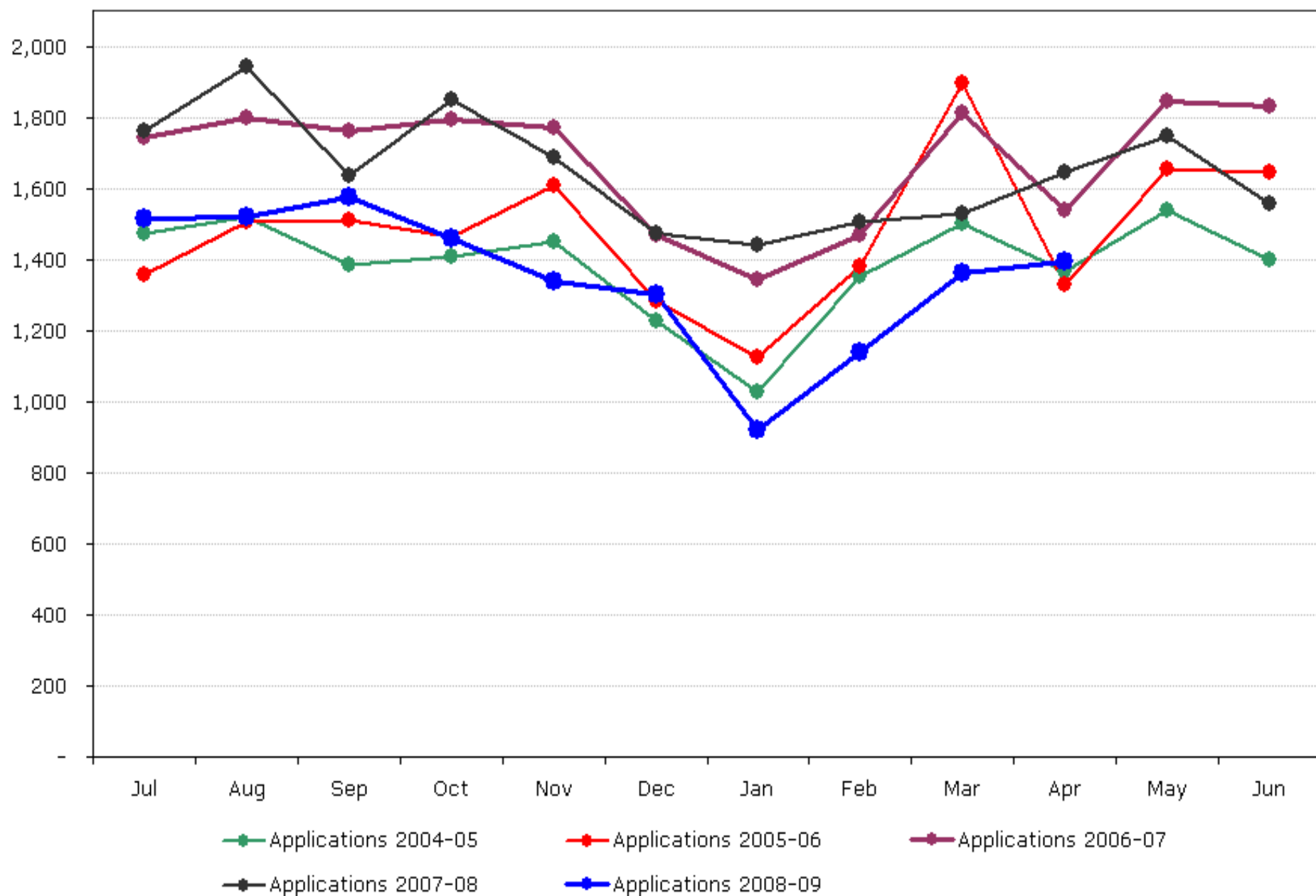
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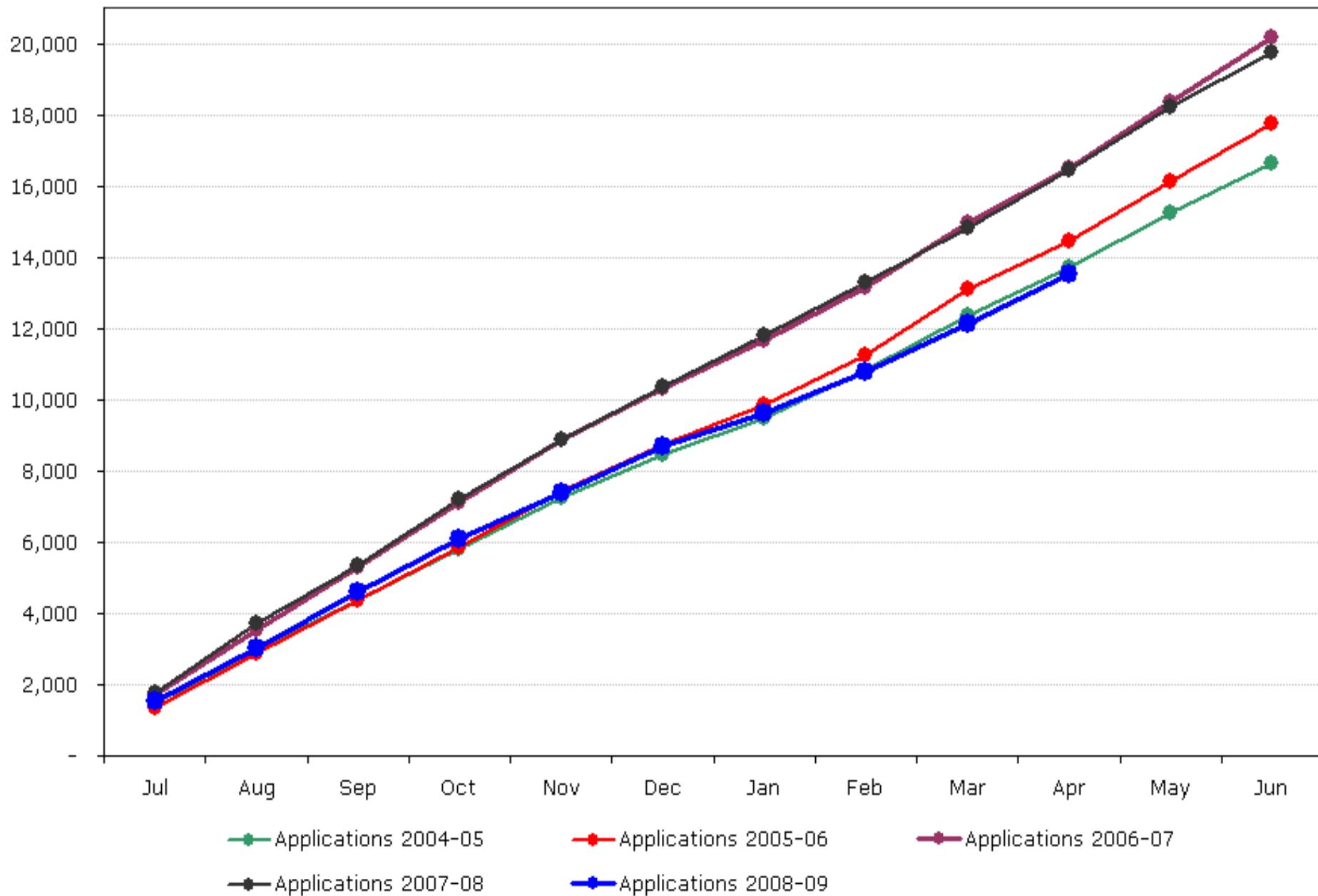
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# Annual Trade Mark Application Volumes

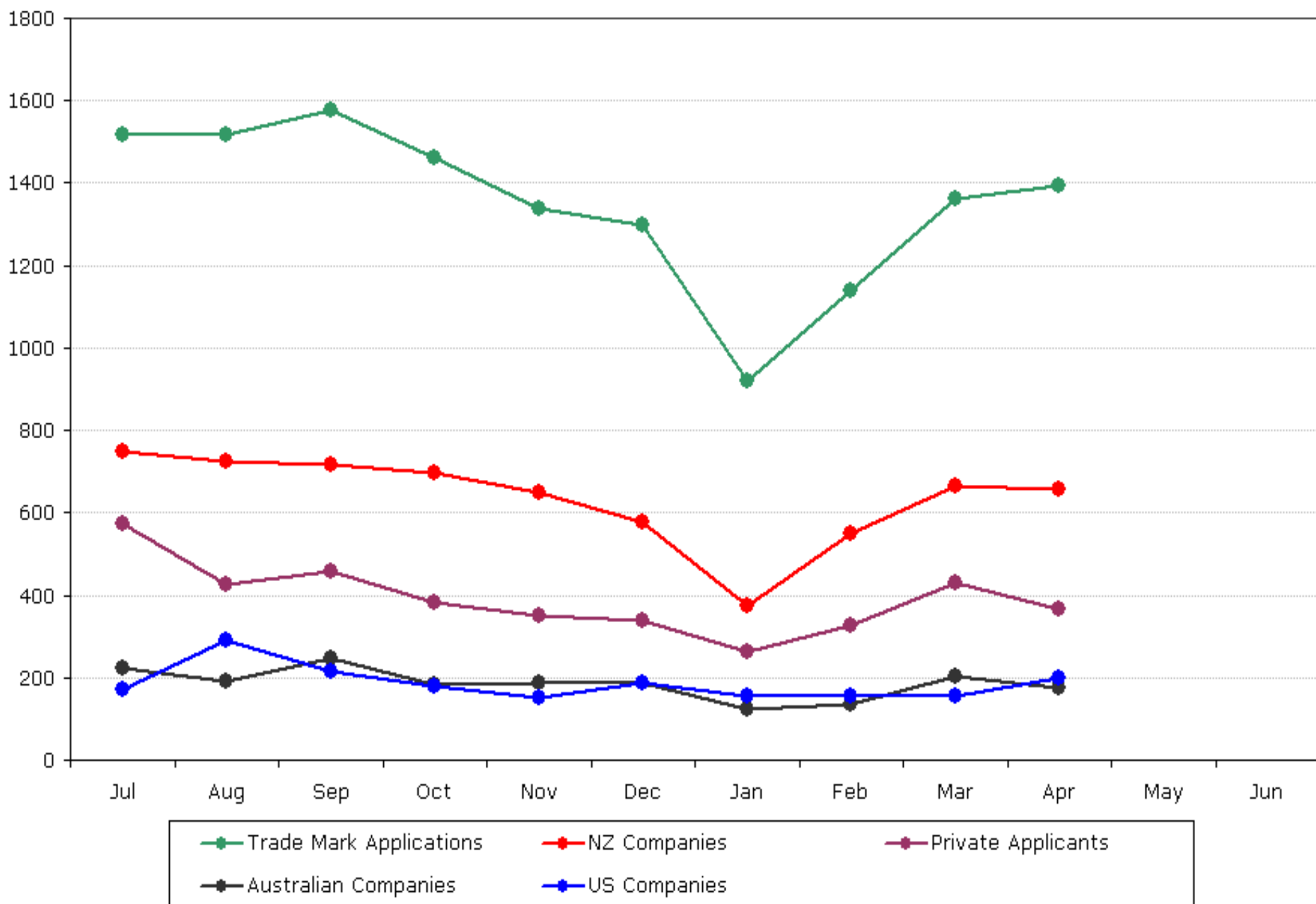


## Annual Trade Mark Application Volumes - Cumulative

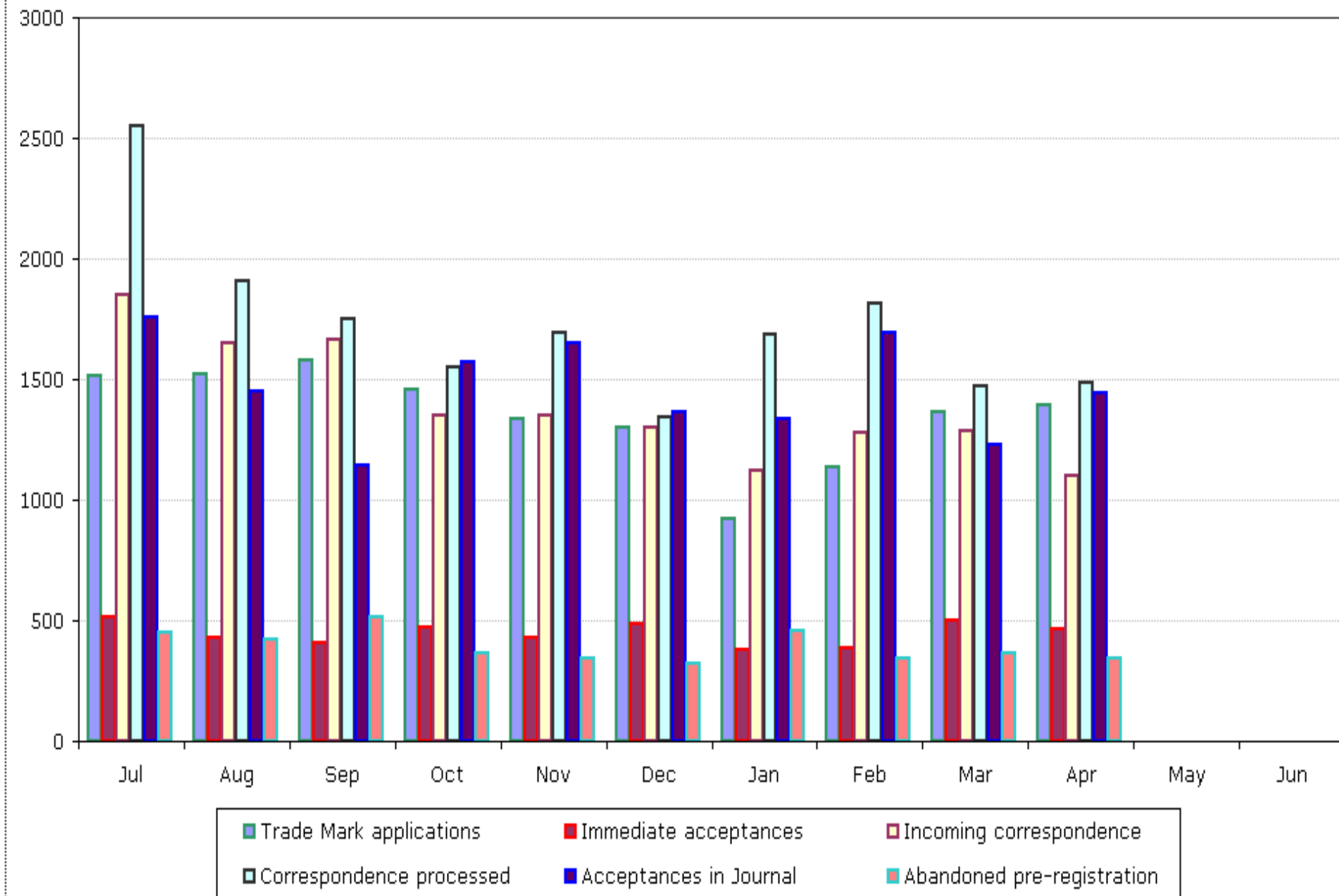
(Applications are down 22% on last year)



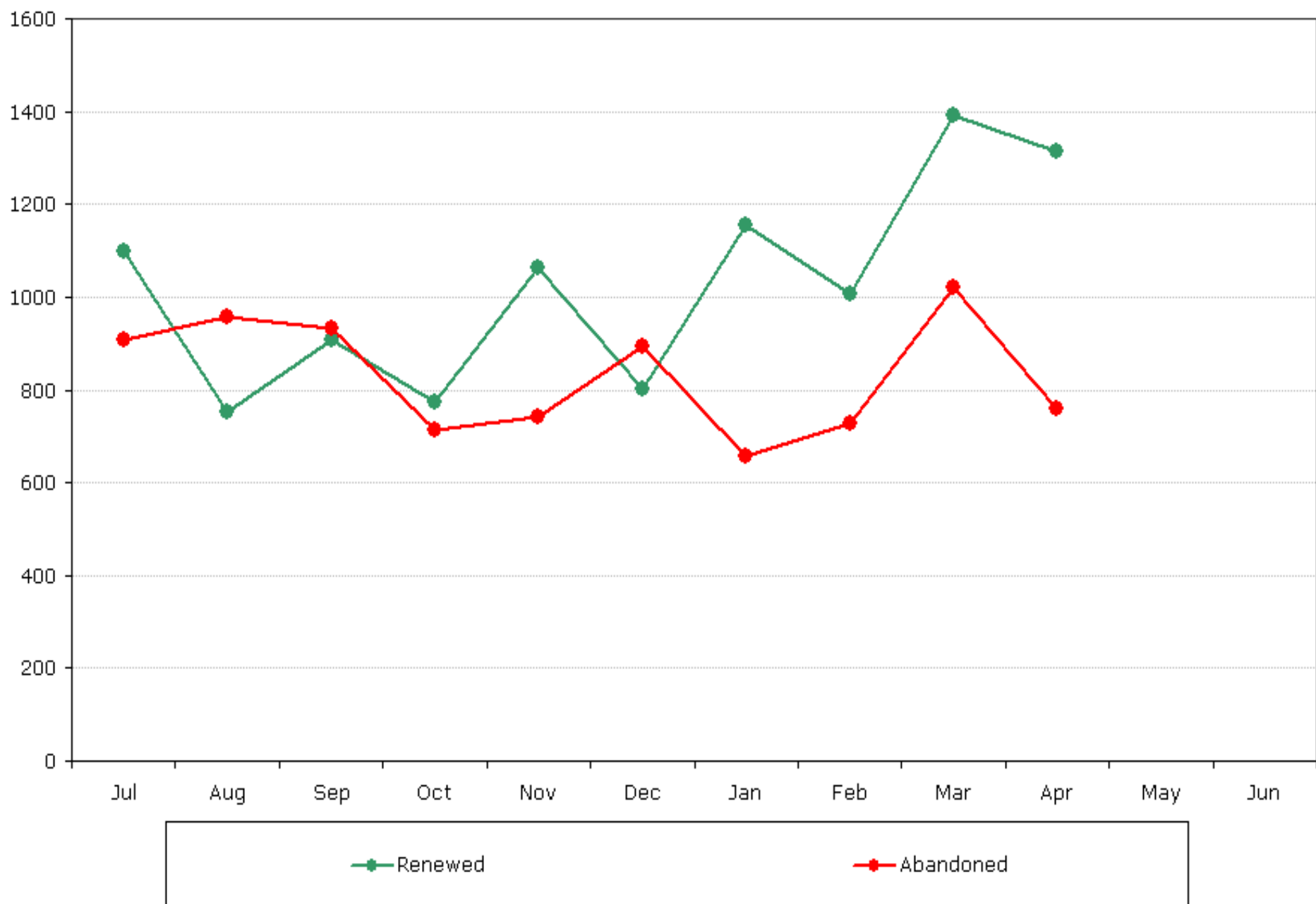
# Trade Mark Applications 08-09



## Trade Mark Examination 08-09



Trade Marks Post Registration 08-09



# Online services

View your own correspondence online

Email correspondence

Development of government to business XML interfaces for applications and renewal processes

Replacement of transactional system

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# Correspondence history

Home

What is IP?

Patents

Trade Marks

Designs

PVR

Copyright

IPONZ

Contact

Logoff

Help

## Online Services

- User Administration
- Search the Register
- Applications
- Renewals
- Correspondence
  - Submit Correspondence
  - Correspondence History
  - View IP History
- Online Journal

## VIEW IP HISTORY

SEARCH | PRINT | EXIT

### Search Criteria

Division

IP Number \*

View

From Date

To Date

### IP History

Client Ref	MIKE 11284	Title	The Great Ideas Factory		
Date	Description	Document	Due Date	Journal	IP Status
08-Jan-2009	Renew		23-Jun-2018		
31-Jul-2008	Registered			<a href="#">1555</a>	Registered
02-Jul-2008	Published Date		31-Jul-2008	<a href="#">1549</a>	
02-Jul-2008	Application Accepted		02-Jul-2008	<a href="#">1549</a>	Accepted
23-Jun-2008	Mark	<a href="#">Text</a>			
23-Jun-2008	Filed		23-Jun-2008		

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# Trade mark activities 2009 and beyond

Trade Marks (International Treaties and Enforcement) Amendment Bill implementation

Comparative examination project with IP Australia

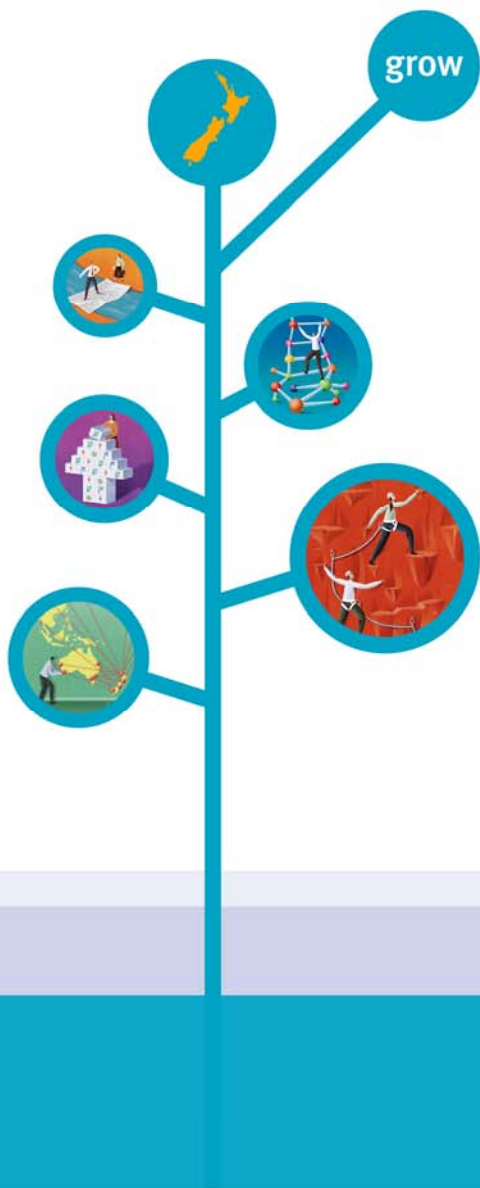
Review of guidelines

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# Trade Mark Examination

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# Our premises

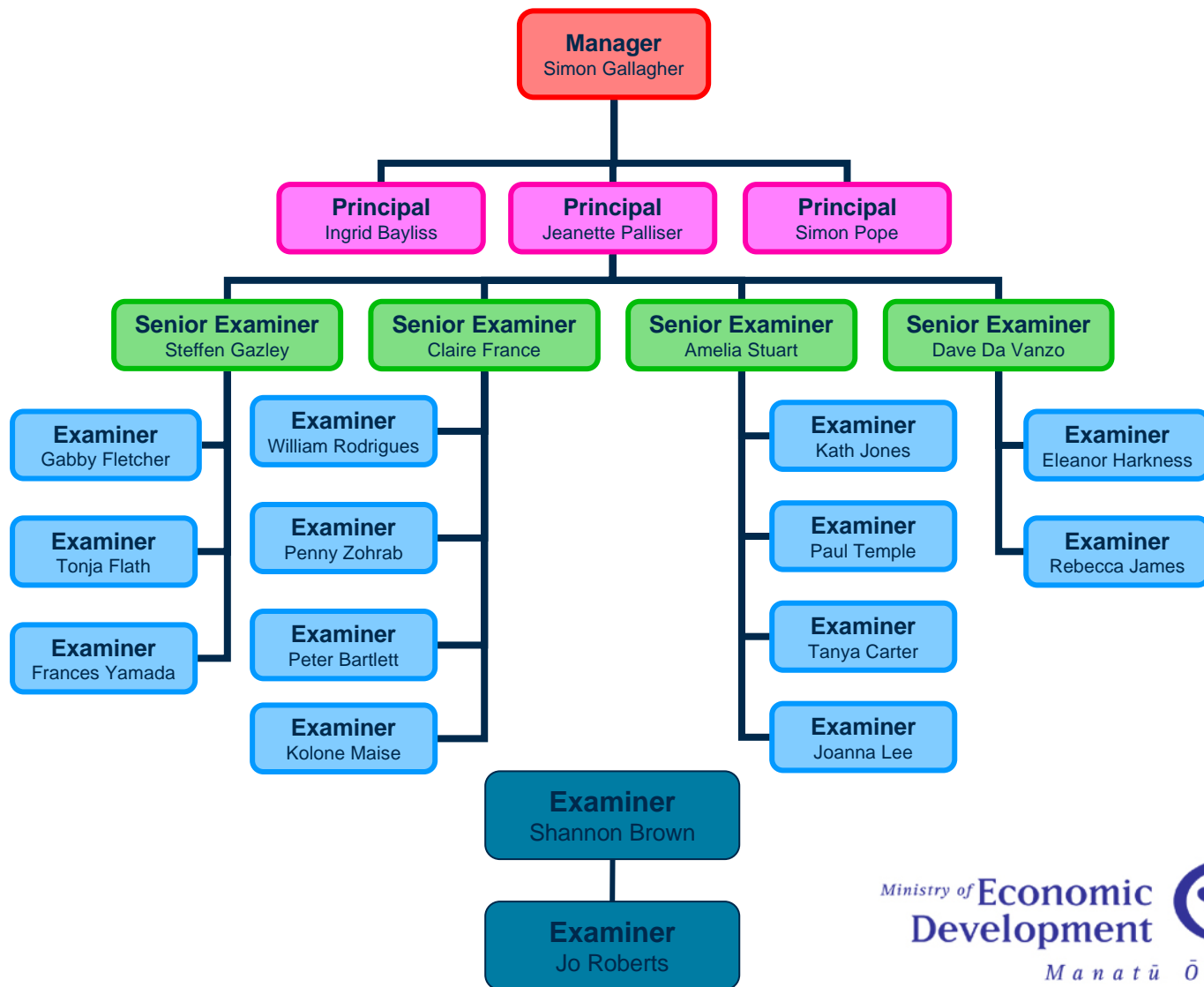


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# Correspondence Queues

1. Incoming correspondence (levels 1- 4)
2. Abeyance
3. Add class
4. Amendment
5. Certification marks
6. Amendments
7. Divisionals
8. Evidence of use
9. Extensions of time
10. Formal objections
11. Principals Queue
12. Reinstatements
13. Acceptance Queue
14. Projects

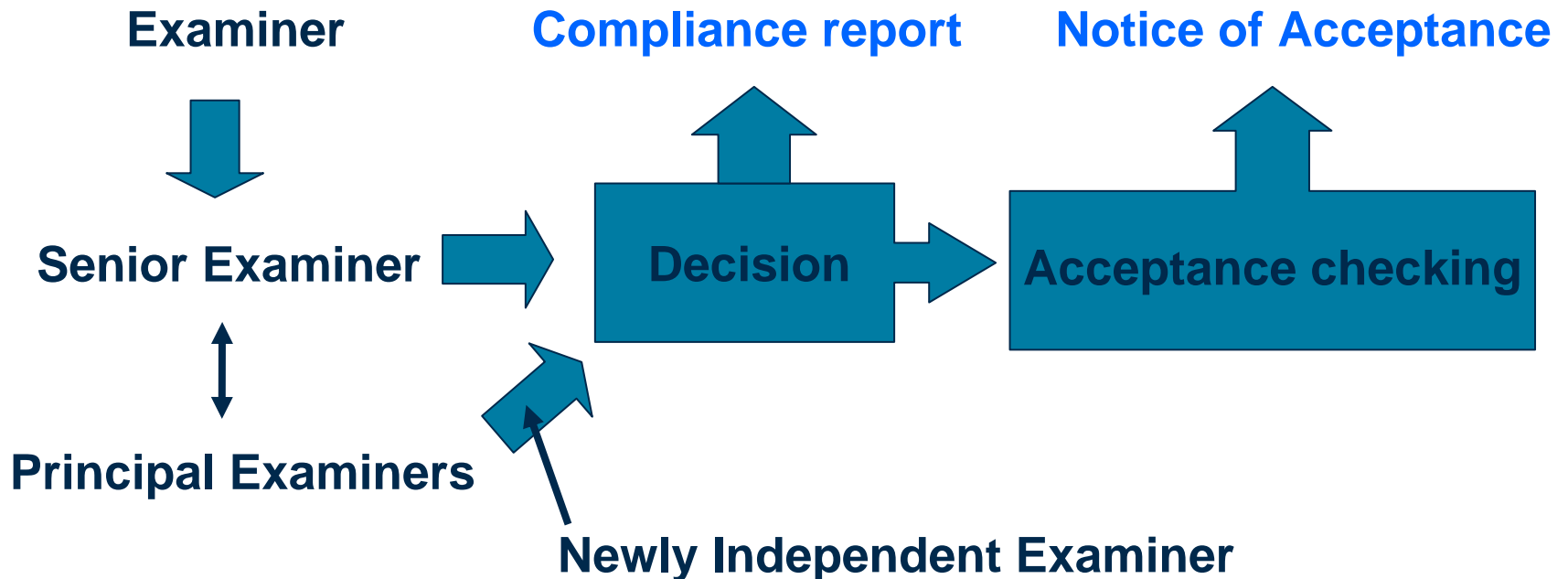
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# Quality Control



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# Turnaround times

❖ **First Compliance report** 5 days

❖ **Subsequent reports:**

- **Easy** 20 days  
(Sections 5, 21-24, 31, 32)

- **Hard** 25 days  
(Sections 17, 18 and 25)

- **Evidence of use**  
3 months

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# Subsumed marks

## Case Law

*Reemark Gmbh v OHIM* – Bluenet Ltd T-22/04  
(WESTLIFE v WEST)

*Medion AG v Thompson Multimedia Sales Austria & Germany Gmbh* Case C-120/04  
(THOMPSON LIFE v LIFE)

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# Decisions before the Commissioner

- *PUREBABY v BABY* T19/2008
- *ULTRA v ULTRA LAMP* T10/2007
- *ARCHTREO v TREO* T26/2007
- *BALANCE v BODY BALANCE* 28/2007

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# The Test

## ***Re Pianotist Co's Application (1906)***

**23 RPC 774 at 777:**

*“You must take the two words. You must judge of them, both by their look and by their sound. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.”*

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# Marks must be compared as a whole

***Clarke v Sharp* (1898)**  
**15 RPC 141 at 146**

*“One must bear in mind the points of resemblance and the points of dissimilarity, attaching fair weight and importance to all, but remembering that the ultimate solution is to be arrived at, not by adding up and comparing the results of such matters, but by judging the **general effect of the respective wholes**.”*

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# Idea of the mark

## ***CPC (UK) Ltd v Keenan (1986) FSR 527***

*“It is relevant to have regard to what is known as the idea of the mark, that is to say the idea which is given by the mark to a person who sees it, and if the mark gives rise to a particular association, that association may be important in relation to the question of deception or confusion.”*

*(eg PURPLE PATCH v PATCH)*

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# General Principles

1. Marks are compared as a whole (*Clarke v Sharp*)
2. Imperfect recollection (*De Cordova v Vick Chemical Co*)
3. The idea of the mark (*CPC (UK) Ltd v Keenan*)
4. The look and sound of the mark (*Pianotist*)
5. Trade channels (*Pioneer Hi-Bred*)
6. Onus on applicant (*New Zealand Breweries*)

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# Section 25 – deception/confusion

***Stichting Lodestar v Austin, Nichols & Co Inc***  
**[2008] 2 NZLR 141 (SCNZ).**  
**(WILD GEESE and WILD TURKEY)**

*“It is not so much the differences that matter, although of course they are relevant, but rather the similarities, whatever their form may be, that might lead to deception or confusion. Deception or confusion may arise in marks that appear to be related so that it could be thought that they denoted related products from the same source.”*

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# Does it ‘hang together’?

## ***BULOVA ACCUTRON*** [1969] RPC 102.

(Applied in *The Goodyear Tire Rubber Company* [2002] T20/2002)

“Can the additional elements of the composite mark be seen as conditioning the subsumed mark such that the marks would appear related, or does the composite mark ‘hang together’ in its own right and create a different impression”

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# Illustrative examples

- NEXT GENERATION RANGEFINDER v NEXT (electric goods)
- PIRATES OF THE CARABEAN v PIRATES (clothing)
- DAZZLE PLUS v DAZZLE (cleaners)
- FRUIT EXPLOSION v EXPLOSION (food products)
- EASY BUST v BUST (insect sprays)
- SPEEDOX SUPERNOVA v SUPERNOVA (shoes)

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# Evidence of use

## ***Section 18 Non-distinctive trade mark not registrable***

(2) The Commissioner must not refuse to register a trade mark under subsection (1)(b), (c), or (d) if, **before the date of application for registration**, as a result of either the use made of it or of any other circumstances, the trade mark has acquired a distinctive character.

## ***Section 26 Exceptions***

The Commissioner must register trade mark A if—

(b) the Commissioner or the Court, as the case may be, considers that a case of honest concurrent use exists, or other special circumstances exist, that, in the opinion of the Court or the Commissioner, makes it proper for the trade mark to be registered subject to any conditions that the Court or the Commissioner may impose.

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# Evidence content

- Must be a Statutory Declaration or Affidavit
- Exhibits
- Annexure list in accordance with the practice guidelines

Do not put the evidence as part of your submissions

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# Section 18

**Fredco** (Affirmed **Windsurfing Chiemsee** in NZ).

- ❖ The market share held by the mark;
- ❖ How intensive, geographically widespread and long-standing the use of the mark has been;
- ❖ The amount invested by the applicant in promoting the mark;
- ❖ The proportion of the relevant class of persons who, because of the mark, identify goods or services as originating from a particular undertaking;
- ❖ Statements from chambers of commerce and industry or other trade and professional associations (*Dualit*)

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# Key evidence

1. Date of first use in New Zealand
2. Geographical extent
3. Sales/turnover figures
4. Advertising or promotional expenditure
5. Support for goods/services

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# Underpinning considerations

- ❖ Does evidence show use of the mark as filed?
- ❖ Is the mark viewed as a trade mark?
- ❖ Exhibits supporting use as filed (dilution).
- ❖ Sales and advertising figures for mark as filed.

Please indicate usage in exhibits.

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# Tips

- ❖ Spill over reputation is rarely sufficient
- ❖ Make sure evidence is in the appropriate form
- ❖ Only provide evidence prior to the filing date
- ❖ Keep the evidence specific

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# Section 18 - 'Other Circumstances'

## The following may be considered:

- use of the mark as a company name
- use of the mark in a composite mark
- use of the mark in respect of other goods and services

These points above will be given due weight. They are *not* conclusive grounds for registration.

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# Section 26 – Honest Concurrent Use & Special Circumstances

## *Alex Pirie and Son's Application*

The extent of use in duration, area and volume;

- The degree of confusion likely between the trade marks in question;
- Whether any instances of confusion have in fact occurred;
- The honesty or otherwise of the concurrent use;
- The relative inconvenience that would be caused to the respective parties if the applicant's trade mark were registered.

These factors are used to measure the public inconvenience.

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# Honest Concurrent Use

## Evidence should include:

1. Statement of non-confusion
2. Statement that the applicant adopted its mark honestly
3. Reasons why confusion is unlikely
4. Reasons going to relative inconvenience to the parties
5. Normal section 18 evidence

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# Evidence must be prior to the filing date

***VB Distributors Ltd v Matsushita Electric Industrial Co Ltd (1999) 9 TCLR 349 (HC) - (PALSONIC v PANASONIC)***

“Mr Upton said that, whilst it is undoubtedly correct that the rights of the competing parties are generally determined as at the date of the application... **that does not prevent the Court from looking at conduct and events after that date in dealing with the issues before it**”.

## **New Zealand cases:**

- *Telecom IP Ltd v Beta Telecom Ltd* 27/9/06 CIV-2004-485-2789
- *Goodyear Tire and Rubber Company* (T20/2002)

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# Section 26 - Other Special Circumstances

Covers circumstances **prior** to the filing date such as:

- mark used and/or registered by the applicant in other markets
- use of the same mark for different goods and/or services
- other relevant circumstances peculiar to the applicant
- prior use by the applicant
- the “sandwich mark” scenario.

“Things that minimise the risk of confusion or show hardship to the applicant”- Shanahan’s law of trade marks

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# Slogans

## Criteria is no stricter than for standard marks

The NZ/AU comparative examination project revealed that IPONZ takes a more restrictive approach. However, the two practices are coming closer.

*DISCOVER A NEW DRIVING EXPERIENCE* T10/2004

Registered in AU for tyres but refused in NZ.

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# Examples:

ADVANCING VACCINE RESEARCH

(class 5- refused)

LEADING NEW ZEALAND ONLINE

(classes 9 and 38- refused)

FROM THOUGHT TO FINISH

(classes 9, 16, 35, 36, 41 and 42 accepted)

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# Maori Advisory Committee

- **Ms Karen Te O Kahurangi Waaka (Chair)**
- **Mr Mauriora Kingi**
- **Ms Tui Te Hau**
- **Associate Professor Pare Keiha**
- **Dr Deidre Brown**

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# Maori Trade Marks

- Quarterly meetings
- Maori marks are sent to the committee unless they are covered by existing policy – e.g. KIWI marks
- “Offence not mild distaste”
- Meaning of word in another language does not avoid offence
- Principles of “Tapu”, “Mana” and “Noa”.

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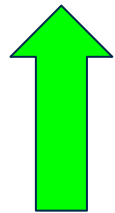
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# Scale of offence

**TAPU**



May be offensive	Offensive
Not offensive	May be offensive

**NOA**



**MANA**

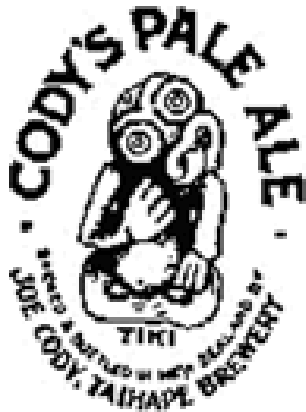
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# Examples



KAIMATE (fertilisers)

MAORI BOY (glass plates & bowls)

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