

Acquired Distinctiveness – Section 18(2)

	IP Number	Trade Mark
Applicant's TM		
Goods and services that TM describes		
Reason(s) for objection		
Assess TM's capacity to distinguish		

Statutory Declarations and affidavits

Correctly executed exhibits, stat dec/affidavit?	
Does evidence relate to NZ use?	
Does evidence predate NZ filing date?	
Evidence post filing date?	
Comply with s9 of Oaths/Declarations Act (for stat decs) or the High Court Rules (for affidavits)?	

Test for acquired Distinctiveness

After consideration of all the relevant factors below, the test for distinctiveness is whether:

the relevant class of persons, or at least a significant proportion thereof, identifies the goods or services as originating from a particular undertaking because of the trade mark¹

Factors for assessing acquired distinctiveness²

- 1) The market share held by the mark;
- 2) How intensive, geographically widespread and longstanding use of the mark has been;
- 3) The amount invested by the undertaking in promoting the mark;
- 4) The proportion of the relevant class of persons who, because of the mark, identify the goods as originating from a particular undertaking; and
- 5) Statements from chambers of commerce and industry or other trade and professional associations.

The market share held by the mark

Though useful, this isn't necessary, and is seldom provided	
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¹ *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehör Walter Huber and Franz Attenberger* [1999] ECR I-2779, paragraph 52.

² *Fredco Trading Ltd v Miller* (2006) 8 NZBLC 101,761 (CA), at paras 67-68.

How intensive, geographically widespread and longstanding use of the mark has been

Duration	
Applicant's filing date/convention priority	
Date of first use of applicant's mark in NZ	
Has there been continuous use in the market place?	
Duration of use of the mark, up until filing date	

Geographical extent of use in NZ	
Area that applicant's mark services	
Geographical exposure of mark, including relevant timelines	

Sales and Volume	
Revenue derived from NZ sales, on a per annum basis, Number of units sold may also be relevant. (nb, you may insert a table into the box)	
Can these figures be attributed to the mark as filed, or is the evidence diluted by the presence of other features? ³ <i>Please copy and paste relevant examples into this table.</i>	
What goods/services do the above figures relate to?	
Is a specification limitation required?	
Comment where sales or volume figures not relevant (e.g. information indicting market awareness and/or activity levels)	

Advertising	
Advertising expenditure in NZ, on a per annum basis. <i>Where appropriate, please insert a table.</i>	
Form of advertising	
Can these figures be attributed to the mark as filed, or is the evidence diluted by the presence of other features? ² <i>Please copy and paste relevant examples into this table.</i>	
Mark is promoted in relation to which goods/services?	
Is a specification limitation required?	

³ *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281, at 286.

This summary may not explicitly refer to every matter that has been considered by the Examiner.

The proportion of the relevant class of persons who, because of the mark, identify the goods as originating from a particular undertaking

Discuss proportion of relevant persons who identify goods/services as coming from a particular undertaking. Consider all information, including evidence provided:

Is declarant aware of any others using the mark for the goods/services?	
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Statements from industry, trade or professional associations (where applicable)

This is always useful, but only necessary for marks with little capacity to distinguish.	
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Supporting Trade Declarations (where applicable)

Who are the declarants, ⁴ what is their relevance and location?	
Length of time aware of mark	
Aware of the mark in relation to what goods/services?	
Declarants aware of other traders using similar mark?	

Surveys⁵ (where applicable)

Are the interviewees a relevant cross-section of the public?	
Is the size of the sample statistically significant?	
Has the survey been conducted fairly?	
Have all the surveys been disclosed?	
Have all the answers been disclosed?	
Are the questions leading ones?	
Have the exact answers been recorded, not some abbreviated form?	
Have the instructions to the interviewers been disclosed?	
If the answers are coded for computer input, have the coding instructions been disclosed?	

Additional comments

⁴ "It is the business of trade buyers to know the products of different manufactures in the market"- *Dualit* [1999] RPC 890 at 898.

⁵ *Imperial Group PLC Philip Morris Ltd* [1984] RPC 294.

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Analysis and Conclusion

Enter Use statement:

Use claimed.

Enter explanation:

Section 18(2) of the Trade Marks Act 2002 applies.