

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

Honest Concurrent Use – Section 26(b)

	Applicant's TM	Cited TM
IP Number		
Trade Mark		
Similar/overlapping goods/services		

Statutory declaration and affidavit

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

Factors for assessing HCU¹

- 1) Extent of use in duration, area and volume.
- 2) Degree of confusion likely between the trade marks in question.
- 3) Whether any instances of confusion have in fact occurred.
- 4) Honesty or otherwise of the concurrent use.
- 5) Relative inconvenience that would be caused to the respective parties if the applicant's trade mark were registered (balance of probabilities).

It is important to keep in mind that the above 5 factors are a useful guide only. The discretion of the Commissioner is unfettered and each case has to be determined on its own merits.

When considering these factors the Commissioner must consider the Public Interest and whether it is just to register, even if there is some confusion².

Extent of use in duration, area and volume

<i>Duration of honest concurrent use</i>	
A. Applicant's filing date/convention priority	
B. Cited mark's filing date or first use	
C. Date of first use of applicant's mark in NZ	
Period of concurrent use (duration between A., and the later of B. or C. – note, prior use is irrelevant)	
Has use been continuous?	
Has use been recent?	

<i>Area</i>	
Area that applicant's mark services	
Area that cited mark services	

¹ *Re Pirie's Application* (1933) 50 RPC 147.

² *Budweiser Trade marks* (2000) RPC 906.

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Geographical exposure of applicant's mark(s)	
Geographical exposure of cited mark	
Duration of geographical exposure of applicant's mark	

<i>Sales, Volume, and Advertising</i>	
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	
Costs of NZ advertising in NZ, on a per annum basis. (nb, you may insert a table into the box)	
Form of advertising	
Comment where sales, volume or advertising figures not relevant (e.g. information indicating market awareness and/ or activity levels)	

Degree of similarity between the marks

<i>Compare the Marks – (applicant's as filed, with cited mark as registered)</i>	
How distinctive are the marks?	
What is the prima facie degree of similarity?	
Does the evidence show use of the mark as filed?	

<i>Compare the Goods and Services</i>	
Are the goods/services the same? Or only similar?	
Evidence show use of mark on the goods overlapping?	

<i>Conclude on the likelihood of confusion</i>	
Given the above, is a specification limitation required?	
If not required, will a specification limitation assist claim?	

Whether any instances of confusion have in fact occurred?

<u>Essential</u> – Stat Dec/affidavit must include a statement indicating whether they are aware of any actual instances of confusion	
Does Stat Dec/affidavit include a sufficient confusion statement?	
Have there been actual instances of confusion?	

Honesty of the concurrent use

Honesty in this sense refers to common honesty⁴

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

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Has applicant explained source of trade mark?	
Has use or source of mark been honest or surreptitious?	

Relative inconvenience to each party if applicant's mark is registered

Weigh relative the applicant's convenience with the cited mark's inconvenience	
Will owner of cited mark be unduly inconvenienced if application is registered? (balance of probabilities)	

Supporting trade declarations (where applicable)

Who are the declarants ⁵ – 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?	

Surveys⁶ (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

Analysis and Conclusion

Enter explanation:

Honest concurrent use with Registration No: 123456; or
Honest concurrent use with Registration Nos: 123456 and 123457.

⁴ *Parkington & Co Ltd's Application* (1946) 63 RPC 171, at p 182.

⁵ "It is the business of trade buyers to know the products of different manufactures in the market"- *Dualit* [1999] RPC 890 at 898.

⁶ *Imperial Group PLC Philip Morris Ltd* [1984] RPC 294.