

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

Acquired distinctiveness – Section 18(2)

Content within this checklist may contain confidential information. Please review in its entirety before releasing under the Official Information Act 1982

1. Trade mark details

IP Number	
Trade Mark	
Applicant/owner	
Specification	

2. Inherent distinctiveness

Goods and/or services that mark describes			
Reason(s) for objection			
Summary of initial examination			
Applicant's overseas applications/registrations			

3. Statutory declarations and affidavits

Correctly executed stat dec/affidavit/exhibits?	
Comply with s9 of Oaths/Declarations Act (for stat decs) or the High Court Rules (for affidavits)?	

5. Factors to consider when assessing evidence

Section 18(2) of the Act permits registration of a trade mark which has no distinctive character or otherwise ineligible for registration under section 18(1) if the Commissioner is satisfied that the mark as acquired distinctiveness through use.

Factors for assessing acquired distinctiveness

- 1) How intensive, geographically widespread and longstanding use of the mark has been;
- 2) The market share held by the mark as indicated by sales and volume figures;
- 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.

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

Duration	
Applicant's Relevant Date ¹	
Date of first use of Applicant's mark in NZ	
Has there been continuous use in the marketplace?	
Duration of use of the mark, up until Relevant Date	

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

5.2 Sales and volume

take a screenshot using the snipping tool and insert sales/volume tables here

Can the figures be attributed to the mark as filed, or is the evidence diluted by the presence of other features?	
What goods/services do the above figures relate to?	
Comment where sales or volume figures not relevant (e.g. information indicating market awareness and/or activity levels)	

5.3 Advertising

take a screenshot using the snipping tool and insert advertising expenditure tables here

Form(s) of advertising	
Can these figures be attributed to the mark as filed, or is the evidence diluted by the presence of other features?	
What goods/services do the above figures relate to?	

5.4 The market share held by the mark

N/A if no information regarding market share has been provided	
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¹ Relevant Date= Filing Date or Convention Priority or Designation Date, whichever is the earlier.

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(other than revenue/sales volume information)	
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6. Other forms of evidence

6.1 Statements from industry or professional associations (where provided)

Who are the declarants and how are they qualified to comment on the relevant industry?	
What relationship does the Applicant have with the declarant?	

Supporting trade declarations (where provided)²

Who are the declarants, 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 mark in a descriptive manner?	

Surveys (where provided)

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?	

² This is always useful, but only necessary for marks with little capacity to distinguish.

7. Examples of use

Take screen shots or reference the exhibits that demonstrate typical use of the mark in relation to the specified goods or services

7.1 Use of the mark

7.2 Diluted use (if any)

8. Analysis summary

Inherent distinctiveness of the mark	
How descriptive/non-distinctive is the mark? ³	
Use of the mark or diluted use	
Having assessed the exhibits, is there sufficient use of the mark as filed? Take into consideration how much use, if any, is potentially diluted by the presence of other trade marks.	
Goods/services	
If use of the mark is not in relation to <u>all</u> goods/services, can a specification limitation assist with the application proceeding to acceptance? <i>If yes, insert specification limitation</i>	
New Zealand marketplace	
Is the use of the mark solely in relation to the New Zealand marketplace?	
Duration of use	
Is there sufficient use of the mark before the Relevant Date?	
Sales/volume/advertising figures	
Are the figures sufficient in relation to the mark as filed?	
Additional comments	

³ Noting that no amount of use of a highly descriptive term as a brand name will make it registrable in relation to the goods it describes (e.g. SOAP as a mark in relation to SOAP).

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9. Conclusion

9.1 If the applicant has not proven acquired distinctiveness

Write a subsequent compliance report outlining the reasons why the evidence provided is not sufficient.

9.2 If the applicant has proven acquired distinctiveness:

Select Use Statement option: Use claimed

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