

**NOTIFICATION OF PROVISIONAL REFUSAL OF AN INTERNATIONAL REGISTRATION DESIGNATING
NEW ZEALAND
Rule 17(1)**

1.	Office making the notification: Intellectual Property Office of New Zealand
2.	Date of the notification of provisional refusal: 5 September 2018
3.	Number of the international registration: 1400443
4.	Our reference: NZ IP 1092558 - 4400
5.	Representation of the mark: PEPPER
6.	Name of the holder: SOFTBANK ROBOTICS EUROPE
7.	Basis for refusal: Provisional refusal based on an opposition
8.	Name and address of the opponent: Pepper Group Limited C/- James & Wells Private Bag 11907 Ellerslie Auckland 1542 New Zealand
9.	Scope of this refusal: Provisional refusal for all the goods and/or services specified in the New Zealand Designation for protection.
10.	Grounds for refusal: See attached Notice of Opposition.
11.	Information relating to an earlier mark: See attached print-out from the New Zealand trade marks register.
12.	Information relating to subsequent procedure: <u>Responding to this refusal</u> The Holder may respond in writing to this refusal by filing a counterstatement. To respond the Holder will need to provide an address for service in New Zealand and the response must be

filed using the Commissioner's website at www.iponz.govt.nz.

Timeframe for responding

If the Holder does not respond by filing a counterstatement by **5 November 2018**, this refusal becomes final for the specified goods and/or services.

13. Signature by the Office:

Intellectual Property Office of New Zealand

Pip Gray

+64 4 896 5523

For the Commissioner of Trade Marks

14. Corresponding provisions of relevant law:

Trade Marks Act 2002:

17 Absolute grounds for not registering trade mark: general

- (1) The Commissioner must not register as a trade mark or part of a trade mark any matter—
- (a) the use of which would be likely to deceive or cause confusion; or
 - (b) the use of which is contrary to New Zealand law or would otherwise be disentitled to protection in any court; or
 - (c) the use or registration of which would, in the opinion of the Commissioner, be likely to offend a significant section of the community, including Māori.
- (2) The Commissioner must not register a trade mark if the application is made in bad faith.
- (3) Despite subsection (1)(b), the Commissioner may register a trade mark even if use of the trade mark is restricted or prohibited under the Smoke-free Environments Act 1990

25 Registrability of identical or similar trade mark

- (1) The Commissioner must not register a trade mark (trade mark A) in respect of any goods or services if—
- (a) it is identical to a trade mark (trade mark B) belonging to a different owner and that is registered, or has priority under section 34 or section 36,—
 - (i) in respect of the same goods or services; or
 - (ii) in respect of goods or services that are similar to those goods and services, and its use is likely to deceive or confuse; or
 - (b) it is similar to a trade mark (trade mark C) that belongs to a different owner and that is registered, or has priority under section 34 or section 36, in respect of the same goods or services or goods or services that are similar to those goods or services, and its use is likely to deceive or confuse; or
 - (c) it is, or an essential element of it is, identical or similar to, or a translation of, a trade mark that is well known in New Zealand (trade mark D), whether through advertising or otherwise, in respect of those goods or services or similar goods or services or any other goods or services if the use of trade mark A would be taken as indicating a connection in the course of trade between those other goods or services and the owner of trade mark D, and would be likely to prejudice the interests of the owner.

(2) Section 26 overrides subsection (1).

26 Exceptions

The Commissioner must register trade mark A if—

- (a) the owner of trade mark B, trade mark C, or trade mark D (as the case may require) consents to the registration of trade mark A; or
- (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

Case Details Report

Date and Time: 05 Sep 2018 02:58:48 p.m.

Search Criteria:

IP Number: 965362
Client Reference: TO:EG 381815
Status: Registered
Mark Nature: Trade Mark
Mark Type: Combined
Series: No
Mark Name: pepper

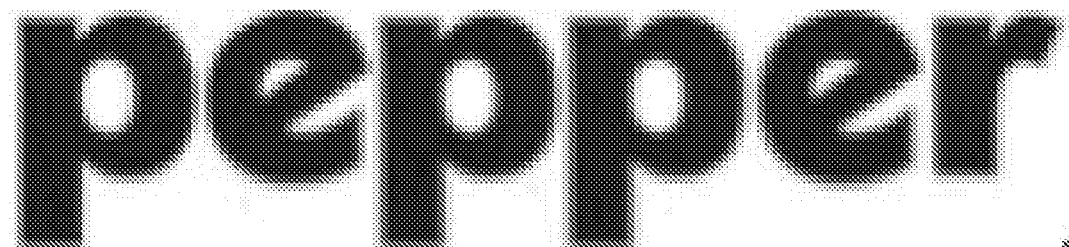
Submission Date: 12 Sep 2012
Filing Date: 12 Sep 2012
Registration Date: 04 Jun 2014
Renewal Due Date: 12 Sep 2022
Under Proceeding: No

Conditions, Explanations, Memoranda, Transliteration, English Translation:

- Consent has been given by the owner of 818810, 818808, 818860, 818862.

Intended use: The mark is being used or proposed to be used, by the applicant or with his/her consent, in relation to the goods/services

Image:



Vienna Codes: 27.5.1, 27.5.17, 27.5.25

Nice Classification Schedule: 10

Pre-approved goods/services: No

Classes and Specifications:

Class	Goods and Services Descriptions
16	Printed matter and publications, including magazines, books, newsletters, brochures and leaflets; promotional materials; stationery products
36	Insurance; financial affairs; monetary affairs; real estate services, namely advising and representing clients in relation to acquisitions, divestments, capital raising and commercial leases; financial consultancy, advisory, evaluation, information and management services including mortgage broking; mortgage services; mortgage banking; mortgage insurance; financial services including loan services; financial leasing; provision of investment management services

Priority : None

Agent :

Piper Alderman	Physical : 16/70 Franklin Street, Adelaide, SA 5000, AU Postal : GPO Box 65, Adelaide SA 5001, AU Service : GPO Box 65, Adelaide SA 5001, AU Email Address: paadeltm@piperalderman.com.au
----------------	--

Applicant(s) :

Pepper Group Limited	Service : C/- James & Wells, Private Bag 11907, Ellerslie, Auckland 1542, NZ Postal : Level 27, 177 Pacific Highway, NORTH SYDNEY 2060, AU Physical : Level 27, 177 Pacific Highway, NORTH SYDNEY 2060, AU
----------------------	--

Contact Details : Piper Alderman, GPO Box 65, Adelaide SA 5001, AU**Linked Cases:**

Case Number	Case Type	Case Title	Submission Date	Case Status	Under Proceeding	Linked Label
23574	GR - IP Extension of Time	Request on Trade Mark 965362	12 Aug 2013	Validated	N/A	Extension of Time Request
31054	GR - TM Change Classes	Request on Trade Mark 965362	21 Jan 2014	Validated	N/A	Case Maintenance
30229	GR - IP Extension of Time	Request on Trade Mark 965362	23 Dec 2013	Validated	N/A	Extension of Time Request
31053	GR - TM Change Classes	Request on Trade Mark 965362	21 Jan 2014	Validated	N/A	Case Maintenance

History:

Type	Description	Journal	Creation Date
Owner Name Changed	Owner name changed from PEPPER AUSTRALIA PTY LTD to Pepper Group Limited .		05 Nov 2015
TM Registered	Trade Mark Registered	1620	04 Jun 2014
TM Accepted	Trade Mark Accepted	1616	10 Feb 2014
TM Corrections of internal errors	Trade Mark Corrections of internal errors		10 Feb 2014
TM Classes Changed	Trade Mark Classes Changed		10 Feb 2014
TM Classes Changed	Trade Mark Classes Changed		10 Feb 2014
Task routed to new user	Task Re-Examine TM Application (Compliance Report) has been routed to Geoffrey Hobbs		22 Jan 2014
Response to TM CR sent to IPONZ	Response to Trade Mark Compliance Report sent to IPONZ.		22 Jan 2014
Extension of time request granted	Extension of time request granted		06 Jan 2014
Extension of time request granted	Extension of time request granted		28 Aug 2013
Task routed to new user	Task Respond to TM Compliance Report has been routed to CAROLE JACKSON		02 Oct 2012
QC approved TM Exam CR issued	QC approved Trade Mark Examination. Compliance report issued		02 Oct 2012

Type	Description	Journal	Creation Date
Task transferred to new user	Task Control TM Examination Quality has been routed from Geoffrey Hobbs to Anna Wakefield		02 Oct 2012
Examination Completed with objections	Examination Complete, Objections raised during examination.		02 Oct 2012
Task transferred to new user	Task Re-Examine TM Application (QC) has been routed from Anna Wakefield to Geoffrey Hobbs		02 Oct 2012
QC requested re-exam of app	QC requested re-examination of application		02 Oct 2012
Task transferred to new user	Task Control TM Examination Quality has been routed from Geoffrey Hobbs to Anna Wakefield		02 Oct 2012
Examination Completed with objections	Examination Complete, Objections raised during examination.		02 Oct 2012
TM Corrections of internal errors	Trade Mark Corrections of internal errors		14 Sep 2012
Task routed to new user	Task Examine TM Application has been routed to Geoffrey Hobbs		12 Sep 2012
Primary examiner modified	Case assigned to Geoffrey Hobbs		12 Sep 2012
TM App submitted	IP Application submitted		12 Sep 2012

IP Number: 965363
Client Reference: TO:EG 381816
Status: Registered
Mark Nature: Trade Mark
Mark Type: Combined
Series: No
Mark Name: pepper

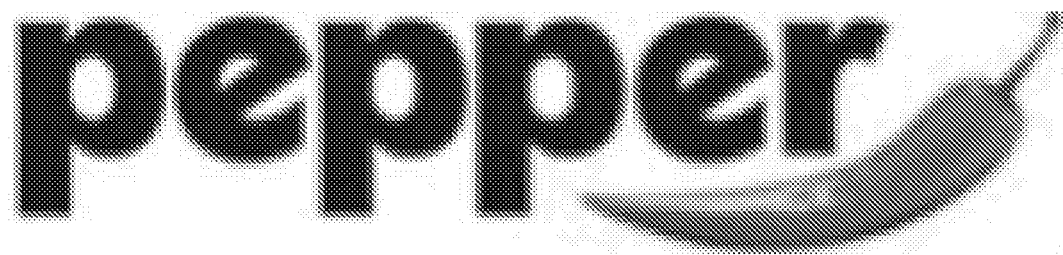
Submission Date: 12 Sep 2012
Filing Date: 12 Sep 2012
Registration Date: 04 Jun 2014
Renewal Due Date: 12 Sep 2022
Under Proceeding: No

Conditions, Explanations, Memoranda, Transliteration, English Translation:

- Consent has been given by the owner of 818810, 818808, 818860, 818862.

Intended use: The mark is being used or proposed to be used, by the applicant or with his/her consent, in relation to the goods/services

Image:



Vienna Codes: 5.9.15, 27.5.1, 27.5.17, 27.5.25

Nice Classification Schedule: 10

Pre-approved goods/services: No

Classes and Specifications:

Class	Goods and Services Descriptions
16	Printed matter and publications, including magazines, books, newsletters, brochures and leaflets; promotional materials; stationery products
36	Insurance; financial affairs; monetary affairs; real estate services, namely advising and representing clients in relation to acquisitions, divestments, capital raising and commercial leases; financial consultancy, advisory, evaluation, information and management services including mortgage broking; mortgage services; mortgage banking; mortgage insurance; financial services including loan services; financial leasing; provision of investment management services

Priority : None

Agent :

Piper Alderman	Physical : 16/70 Franklin Street, Adelaide, SA 5000, AU Postal : GPO Box 65, Adelaide SA 5001, AU Service : GPO Box 65, Adelaide SA 5001, AU Email Address: paadeltm@piperalderman.com.au
----------------	--

Applicant(s) :

Pepper Group Limited	Service : C/- James & Wells, Private Bag 11907, Ellerslie, Auckland 1542, NZ Postal : Level 27, 177 Pacific Highway, NORTH SYDNEY 2060, AU Physical : Level 27, 177 Pacific Highway, NORTH SYDNEY 2060, AU
----------------------	--

Contact Details : Piper Alderman, GPO Box 65, Adelaide SA 5001, AU

Linked Cases:

Case Number	Case Type	Case Title	Submission Date	Case Status	Under Proceeding	Linked Label
30230	GR - IP Extension of Time	Request on Trade Mark 965363	23 Dec 2013	Validated	N/A	Extension of Time Request
23575	GR - IP Extension of Time	Request on Trade Mark 965363	12 Aug 2013	Validated	N/A	Extension of Time Request
31055	GR - TM Change Classes	Request on Trade Mark 965363	21 Jan 2014	Validated	N/A	Case Maintenance

History:

Type	Description	Journal	Creation Date
TM Corrections of internal errors	Trade Mark Corrections of internal errors		17 Jul 2017
Owner Name Changed	Owner name changed from Pepper Australia Pty Ltd to Pepper Group Limited .		05 Nov 2015
TM Registered	Trade Mark Registered	1620	04 Jun 2014
TM Accepted	Trade Mark Accepted	1616	10 Feb 2014
TM Corrections of internal errors	Trade Mark Corrections of internal errors		10 Feb 2014
TM Classes Changed	Trade Mark Classes Changed		10 Feb 2014
Task routed to new user	Task Re-Examine TM Application (Compliance Report) has been routed to Geoffrey Hobbs		22 Jan 2014
Response to TM CR sent to IPONZ	Response to Trade Mark Compliance Report sent to IPONZ.		22 Jan 2014
Extension of time request granted	Extension of time request granted		06 Jan 2014
Extension of time request granted	Extension of time request granted		28 Aug 2013
Task routed to new user	Task Respond to TM Compliance Report has been routed to CAROLE JACKSON		02 Oct 2012
QC approved TM Exam CR issued	QC approved Trade Mark Examination. Compliance report issued		02 Oct 2012
Task transferred to new user	Task Control TM Examination Quality has been routed from Geoffrey Hobbs to Anna Wakefield		02 Oct 2012
Examination Completed with objections	Examination Complete, Objections raised during examination.		02 Oct 2012
Task transferred to new user	Task Re-Examine TM Application (QC) has been routed from Anna Wakefield to Geoffrey Hobbs		02 Oct 2012
QC requested re-exam of app	QC requested re-examination of application		02 Oct 2012
Task transferred to new user	Task Control TM Examination Quality has been routed from Geoffrey Hobbs to Anna Wakefield		02 Oct 2012
Examination Completed with objections	Examination Complete, Objections raised during examination.		02 Oct 2012
TM Corrections of internal errors	Trade Mark Corrections of internal errors		14 Sep 2012

Type	Description	Journal	Creation Date
Task routed to new user	Task Examine TM Application has been routed to Geoffrey Hobbs		12 Sep 2012
Primary examiner modified	Case assigned to Geoffrey Hobbs		12 Sep 2012
TM App submitted	IP Application submitted		12 Sep 2012

IP Number: 965364
Client Reference: TO:EG 381818
Status: Registered
Mark Nature: Trade Mark
Mark Type: Combined
Series: No
Mark Name: pepper CAN DO

Submission Date: 12 Sep 2012
Filing Date: 12 Sep 2012
Registration Date: 04 Jun 2014
Renewal Due Date: 12 Sep 2022
Under Proceeding: No

Conditions, Explanations, Memoranda, Transliteration, English Translation:

- Consent has been given by the owner of 818810, 818808, 818860, 818862.

Intended use: The mark is being used or proposed to be used, by the applicant or with his/her consent, in relation to the goods/services

Image:



Vienna Codes: 5.9.15, 27.5.1, 27.5.17, 27.5.25

Nice Classification Schedule: 10

Pre-approved goods/services: No

Classes and Specifications:

Class	Goods and Services Descriptions
16	Printed matter and publications, including magazines, books, newsletters, brochures and leaflets; promotional materials; stationery products
36	Insurance; financial affairs; monetary affairs; real estate services, namely advising and representing clients in relation to acquisitions, divestments, capital raising and commercial leases; financial consultancy, advisory, evaluation, information and management services including mortgage broking; mortgage services; mortgage banking; mortgage insurance; financial services including loan services; financial leasing; provision of investment management services

Priority : None

Agent :

Piper Alderman	Physical : 16/70 Franklin Street, Adelaide, SA 5000, AU Postal : GPO Box 65, Adelaide SA 5001, AU Service : GPO Box 65, Adelaide SA 5001, AU Email Address: paadeltm@piperalderman.com.au
----------------	--

Applicant(s) :

Pepper Group Limited	Service : C/- James & Wells, Private Bag 11907, Ellerslie, Auckland 1542, NZ Postal : Level 27, 177 Pacific Highway, NORTH SYDNEY 2060, AU Physical : Level 27, 177 Pacific Highway, NORTH SYDNEY 2060, AU
----------------------	--

Contact Details : Piper Alderman, GPO Box 65, Adelaide SA 5001, AU

Linked Cases:

Case Number	Case Type	Case Title	Submission Date	Case Status	Under Proceeding	Linked Label
23576	GR - IP Extension of Time	Request on Trade Mark 965364	12 Aug 2013	Validated	N/A	Extension of Time Request
31057	GR - TM Change Classes	Request on Trade Mark 965364	21 Jan 2014	Validated	N/A	Case Maintenance
30231	GR - IP Extension of Time	Request on Trade Mark 965364	23 Dec 2013	Validated	N/A	Extension of Time Request

History:

Type	Description	Journal	Creation Date
TM Corrections of internal errors	Trade Mark Corrections of internal errors		17 Jul 2017
Owner Name Changed	Owner name changed from Pepper Australia Pty Ltd to Pepper Group Limited .		05 Nov 2015
TM Registered	Trade Mark Registered	1620	04 Jun 2014
TM Accepted	Trade Mark Accepted	1616	10 Feb 2014
TM Corrections of internal errors	Trade Mark Corrections of internal errors		10 Feb 2014
TM Classes Changed	Trade Mark Classes Changed		10 Feb 2014
Task routed to new user	Task Re-Examine TM Application (Compliance Report) has been routed to Geoffrey Hobbs		22 Jan 2014
Response to TM CR sent to IPONZ	Response to Trade Mark Compliance Report sent to IPONZ.		22 Jan 2014
Extension of time request granted	Extension of time request granted		06 Jan 2014
Extension of time request granted	Extension of time request granted		28 Aug 2013
Task routed to new user	Task Respond to TM Compliance Report has been routed to CAROLE JACKSON		02 Oct 2012
QC approved TM Exam CR issued	QC approved Trade Mark Examination. Compliance report issued		02 Oct 2012
Task transferred to new user	Task Control TM Examination Quality has been routed from Geoffrey Hobbs to Anna Wakefield		02 Oct 2012
Examination Completed with objections	Examination Complete, Objections raised during examination.		02 Oct 2012
Task transferred to new user	Task Re-Examine TM Application (QC) has been routed from Anna Wakefield to Geoffrey Hobbs		02 Oct 2012
QC requested re-exam of app	QC requested re-examination of application		02 Oct 2012
Task transferred to new user	Task Control TM Examination Quality has been routed from Geoffrey Hobbs to Anna Wakefield		02 Oct 2012
Examination Completed with objections	Examination Complete, Objections raised during examination.		02 Oct 2012
TM Corrections of internal errors	Trade Mark Corrections of internal errors		14 Sep 2012

Type	Description	Journal	Creation Date
Task routed to new user	Task Examine TM Application has been routed to Geoffrey Hobbs		12 Sep 2012
Primary examiner modified	Case assigned to Geoffrey Hobbs		12 Sep 2012
TM App submitted	IP Application submitted		12 Sep 2012

IP Number: 1082297
Client Reference: TOC:EG:408037
Status: Under Opposition
Mark Nature: Trade Mark
Mark Type: Combined
Series: Yes

Submission Date: 06 Dec 2017
Filing Date: 06 Dec 2017

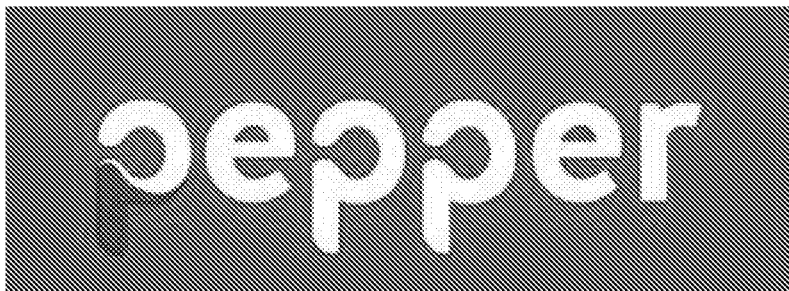
Under Proceeding: Yes

Mark Name: pepper ; pepper ; pepper ; pepper

Intended use: The mark is being used or proposed to be used, by the applicant or with his/her consent, in relation to the goods/services

Image:

pepper



pepper

Vienna Codes: 5.9.15, 5.9.21, 27.5.1, 27.5.25, 5.9.15, 5.9.21, 27.5.1, 27.5.25, 5.9.15, 5.9.21, 27.5.1, 27.5.25, 5.9.15, 5.9.21, 27.5.1, 27.5.25

Nice Classification Schedule: 11

Pre-approved goods/services: No

Classes and Specifications:

Class	Goods and Services Descriptions
9	Application software; computer software applications (downloadable); downloadable software applications (apps); computer software for financial management.
16	Printed matter and publications, including magazines, books, newsletters, brochures and leaflets; promotional materials; stationery products.
36	Financial affairs; monetary affairs; financial consultancy, advisory, evaluation, information and management services; mortgage broking; mortgage services; mortgage banking; mortgage insurance; financial services including loan services; financial leasing; online banking; providing information, including online, concerning insurance, financial and monetary affairs and real estate affairs; providing financial information via an online calculator; providing online currency exchange conversion information; providing online financial calculations; providing online mortgage repayment calculators; providing financial services by means of the internet.

Priority : None

Agent :

Duncan Cotterill Lawyers	Physical : Level 2, 50 Customhouse Quay, Wellington 6011, NZ Postal : PO Box 10376, The Terrace, Wellington 6143, NZ Email Address: ip@duncancotterill.com
Piper Alderman Management Pty. Ltd.	Physical : Piper Alderman, Level 16, 70 Franklin Street, Adelaide 5000, AU Postal : Piper Alderman, GPO Box 65, Adelaide 5001, AU Service : GPO Box 65, Adelaide SA 5001, AU Email Address: paadeltm@piperalderman.com.au

Applicant(s) :

Pepper Group Limited	Service : C/- James & Wells, Private Bag 11907, Ellerslie, Auckland 1542, NZ Postal : Level 27, 177 Pacific Highway, NORTH SYDNEY 2060, AU Physical : Level 27, 177 Pacific Highway, NORTH SYDNEY 2060, AU
----------------------	--

Contact Details : Duncan Cotterill Lawyers, PO Box 10376, The Terrace, Wellington 6143, NZ

Linked Cases:

Case Number	Case Type	Case Title	Submission Date	Case Status	Under Proceeding	Linked Label
109564	GR - IP Add / Change Agent	Request on Trade Mark 1082297	11 May 2018	Validated	N/A	Case Maintenance
4130	Proceedings - TM Opposition	Request on Trade Mark 1082297	22 Mar 2018	In Progress	N/A	Proceedings - TM Opposition

History:

Type	Description	Journal	Creation Date
Agent changed	Agent changed from Piper Alderman Management Pty. Ltd. to Piper Alderman Management Pty. Ltd. , Duncan Cotterill Lawyers		11 May 2018
Opposition proceeding commenced	Opposition proceeding commenced by Softbank Robotics Europe		22 Mar 2018
TM Accepted QC	Trade Mark Accepted	1662	21 Dec 2017

Type	Description	Journal	Creation Date
Task transferred to new user	Task QC TM has been routed from Briar Leader to Eleanor Harkness		18 Dec 2017
Examination Completed without objections	Examination Complete, No Objections raised.		18 Dec 2017
TM Corrections of internal errors	Trade Mark Corrections of internal errors		12 Dec 2017
Task routed to new user	Task Examine TM has been routed to Briar Leader		07 Dec 2017
Primary examiner modified	Case assigned to Briar Leader		07 Dec 2017
TM App submitted	IP Application submitted		06 Dec 2017

This search facility provides information from the intellectual property registers administered and maintained by IPONZ. Whilst IPONZ takes all reasonable care in the provision of its services, IPONZ and the Ministry of Business, Innovation & Employment do not accept any responsibility or liability for any action taken in reliance on this information or for any error, inadequacy, deficiency or flaw in or omission from the information provided. This site is not intended to be a comprehensive or complete source of intellectual property information. To obtain further assistance on the use of this Internet site please contact us.

IN THE MATTER OF
AND

The New Zealand Trade Marks Act 2002

IN THE MATTER OF

Trade mark application no. 1092558 (IR 1400443)
PEPPER in class 9 in the name of Softbank Robotics
Europe

AND

IN THE MATTER OF

Opposition by Pepper Group Limited

NOTICE OF OPPOSITION

Dated: 4 September 2018

DUNCAN COTTERILL

Person Acting:

Daniel Winfield

p: 04 471 9411

f: 04 499 3308

PO Box 10376

The Terrace

Wellington 6143







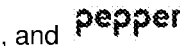

Our reference: PIP105-0006

NOTICE OF OPPOSITION

TAKE NOTICE that Pepper Group Limited of Level 27, 177 Pacific Highway, North Sydney, 2060, Australia (the **Opponent**) opposes registration of trade mark application no. 1092558 (IR 1400443) (the **Application**) in class 9 for the mark PEPPER (the **Applicant's Mark**) in the name of Softbank Robotics Europe (the **Applicant**).

The grounds on which the Opponent relies are:

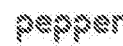



The Applicant's Mark is confusingly similar to the Opponent's Marks – section 17(1)(a)

- 1 Use of the Applicant's Mark by the Applicant in respect of the goods in the Application is likely to deceive or cause confusion and therefore the Application must not be registered pursuant to section 17(1)(a) of the Trade Marks Act 2002 (the **Act**) because:
 - 1.1 on the date the Application was filed, the Opponent had, and continues to have, a reputation in the marks PEPPER, PEPPER MONEY, PEPPER GROUP, , , , , , , , and  (the **Opponent's Marks**) such that the Opponent's Marks are distinctive of the Opponent in New Zealand;
 - 1.2 the Applicant's Mark is identical and similar to the Opponent's Marks; and
 - 1.3 the Applicant's use of the Applicant's Mark in respect of the goods in the Application is likely to confuse or deceive the relevant public as to whether the Applicant is part of, associated with, or endorsed by the Opponent.

Use of the Applicant's Mark would be contrary to law – section 17(1)(b)

- 2 The Opponent repeats paragraphs 1.1-1.3 above and states that use of the Applicant's Mark by the Applicant for the goods in the Application would be contrary to New Zealand law, or would otherwise be disentitled to protection in any court (as per section 17(1)(b) of the Act), in that such use would:
 - 2.1 breach sections 9, 10, 13(e) and 16(1)(c) of the Fair Trading Act 1986; and
 - 2.2 constitute passing off at common law.


The Applicant's Mark is identical to the Opponent's Registered Marks – s25(1)(a)

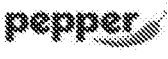
- 3 The Application must be refused pursuant to section 25(1)(a) of the Act because:
 - 3.1 the Opponent is the owner of New Zealand Trade Mark Application 1082297 , , ,  (series) (the **Opponent's Application**) which has an earlier priority date to the Application;
 - 3.2 the Applicant's Mark is identical to the mark covered by the Opponent's Application;
 - 3.3 the Application covers the same goods as goods covered by the Opponent's Application, or covers goods similar to the goods and services covered by the Opponent's Application and use of the Applicant's Mark would be likely to deceive or confuse; and
 - 3.4 section 25(2) of the Act does not apply.

The Applicant's Mark is similar to the Opponent's Registered Marks – s25(1)(b)

4 The Application must be refused pursuant to section 25(1)(b) of the Act because:

4.1 the Opponent is the owner of New Zealand Trade Mark Registrations:

4.1.1 965362  ;

4.1.2 965363  ; and

4.1.3 965364  ,

(the **Opponent's Registrations**);

4.2 the Opponent is the owner of New Zealand Trade Mark Application 1082297

    (series) (the **Opponent's Application**) which has an earlier priority date to the Application;

4.3 the Applicant's Mark is similar to the Opponent's Marks as covered by the Opponent's Registrations and Opponent's Application;

4.4 the Application is in respect of goods that are the same as or similar to the goods and services covered in the Opponent's Registrations and Opponent's Application;

4.5 the Applicant's use of the Applicant's Mark for the goods in the Application is likely to deceive or confuse; and

4.6 section 25(2) of the Act does not apply.

The Applicant's Mark is confusingly similar to the Opponent's well-known marks – s25(1)(c)

5 The Application must be refused pursuant to section 25(1)(c) of the Act because:

5.1 some or all of the Opponent's Marks are well known in New Zealand for the same goods as, or similar goods and services to, the goods in the Application, or any other goods or services;

5.2 the Applicant's Mark, or an essential element of the Applicant's Mark, is identical or similar to the Opponent's Marks;

5.3 the use of the Applicant's Mark for the goods in the Application would be taken as indicating a connection in the course of trade between the Applicant's goods and the Opponent;

5.4 such use would be likely to prejudice the interests of the Opponent; and

5.5 section 25(2) does not apply.

Relief sought

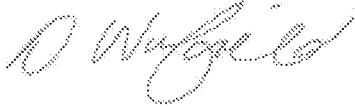
6 The Opponent seeks:

6.1 the refusal of Trade Mark Application no. 1092558 (IR 1400443);

6.2 costs in accordance with section 166 of the Act; and

6.3 such other or further relief as may be justified and is within the discretion of the Commissioner.

Dated: 4 September 2018



D Winfield, on behalf of the Opponent
Solicitor