


**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: 16 October 2018
3.	Number of the international registration: 1406563
4.	Our reference: NZ IP 1095484 - 4470
5.	 <p>Representation of the mark:</p>
6.	Name of the holder: LANDTOURER AUTOMOBILE CO., LTD
7.	Basis for refusal: Provisional refusal based on an opposition
8.	Name and address of the opponent: Ford Motor Company One American Road Dearborn Michigan 48126 United States of America
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:**

Responding to this refusal

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 **16 December 2018***, this refusal becomes final for the specified goods and/or services.

*Please note that due to possible notification issues this date may change, please see IPONZ case number 4470.

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: 16 Oct 2018 12:18:48 p.m.

www.iponz.govt.nz

INTERNATIONAL: +64 3 962 2607

NATIONAL: 0508 4 IPONZ

(0508 447 669)

Search Criteria:

IP Number: 702471
Client Reference: NJ142125
Status: Registered
Mark Nature: Trade Mark
Mark Type: Image
Series: No
Mark Name: Representation Only
Intended use: Proposed to be used by the proprietor(s), (being the applicant)

Submission Date: 01 Oct 2003
Filing Date: 01 Oct 2003
Registration Date: 09 Nov 2006
Renewal Due Date: 01 Oct 2023
Under Proceeding: No

Image:



Vienna Codes: 3.3.1, 3.3.17

Nice Classification Schedule: 8

Pre-approved goods/services: No

Classes and Specifications:

Class	Goods and Services Descriptions
12	motor vehicles, namely, automobiles, trucks, vans, sport-utility vehicles, and their structural parts and engines

Priority : None

Agent :

BALDWINS INTELLECTUAL PROPERTY	Service : Level 20, 157 Lambton Quay, Wellington 6011, NZ Postal : DX SP22044, Wellington 6011, NZ Physical : Level 20, 157 Lambton Quay, Wellington 6011, NZ Postal : PO Box 852, Wellington 6011, NZ Email Address: email@baldwins.com
-----------------------------------	--

Applicant(s) :

Number: 702471

Ford Motor Company	Physical : One American Road, Dearborn, 48126 Michigan, US Postal : One American Road, Dearborn, 48126 Michigan, US
--------------------	--

Contact Details : BALDWINS INTELLECTUAL PROPERTY, Level 20, 157 Lambton Quay, Wellington 6011, NZ

Linked Cases: None

History:

Type	Description	Journal	Creation Date
IP user in charge transferred	Case assigned from Jacqueline Sheppard to Kirsten Odell		26 Sep 2017
TM Renewed	Trade Mark Renewed for 10 years until 01 Oct 2023 by CPA Global	1610	05 Aug 2013
Renewal reminder sent	Renewal reminder sent		01 Jun 2013
Owner Address changed	Assignment Client Reference: DEK 308685NZAR01		04 Jun 2008
TM assigned to New Owner	Request for this change of interests is stored on IP 78299		04 Jun 2008
Agent changed	Assignment Client Reference: DEK 308685NZAR01		04 Jun 2008
Owner Address changed	Assignment Client Reference: DEK 308685NZAR01		08 Aug 2007
TM Registered	Registered	1529	09 Nov 2006
TM Accepted	Print Notice Of Acceptance		10 Jul 2006
TM Accepted	Application Accepted	1525	07 Jul 2006
Response to TM CR sent to IPONZ	Evidence		07 Jul 2006
Examination Completed without objections	Examination Completed		07 Jul 2006
Response to TM CR sent to IPONZ	Examination Correspondence		23 Jun 2006
Response to TM CR sent to IPONZ	Examination Correspondence		25 May 2006
Edit case details	Change IP Date		17 Jan 2006
Edit case details	Change IP Date		21 Nov 2005
Edit case details	Change IP Date		14 Sep 2005
Edit case details	Change IP Date		20 Jul 2005
Edit case details	Change IP Date		27 May 2005
Edit case details	Change IP Date		27 May 2005
Edit case details	Change IP Date		06 Apr 2005
Edit case details	Change IP Date		12 Jan 2005
Edit case details	Opposition failed		12 Jan 2005
Edit case details	as per letter dated 17 Dec 2003 BSWREF: NJ142125 - abeyance while opposition is determined.		09 Jan 2004
IP Corrected	Change IP Document		07 Oct 2003
IP App validated	Collation Completed		06 Oct 2003
TM App submitted	Filed		02 Oct 2003

IP Number: 702472
Client Reference: NJ142126
Status: Registered
Mark Nature: Trade Mark
Mark Type: Word
Series: No
Mark Name: MUSTANG

Submission Date: 01 Oct 2003
Filing Date: 01 Oct 2003
Registration Date: 09 Nov 2006
Renewal Due Date: 01 Oct 2023
Under Proceeding: No

Intended use: Proposed to be used by the proprietor(s), (being the applicant)

Nice Classification Schedule: 8

Pre-approved goods/services: No

Classes and Specifications:

Class	Goods and Services Descriptions
12	motor vehicles, namely, automobiles, trucks, vans, sport-utility vehicles, and their structural parts and engines

Priority : None

Agent :

BALDWINS INTELLECTUAL PROPERTY	Service : Level 20, 157 Lambton Quay, Wellington 6011, NZ Postal : DX SP22044, Wellington 6011, NZ Physical : Level 20, 157 Lambton Quay, Wellington 6011, NZ Postal : PO Box 852, Wellington 6011, NZ Email Address: email@baldwins.com
--------------------------------	--

Applicant(s) :

Ford Motor Company	Physical : One American Road, Dearborn, 48126 Michigan, US Postal : One American Road, Dearborn, 48126 Michigan, US
--------------------	--

Contact Details : BALDWINS INTELLECTUAL PROPERTY, Level 20, 157 Lambton Quay, Wellington 6011, NZ

Linked Cases: None

History:

Type	Description	Journal	Creation Date
TM Renewed	Trade Mark Renewed for 10 years until 01 Oct 2023 by CPA Global	1610	05 Aug 2013
Renewal reminder sent	Renewal reminder sent		01 Jun 2013
TM assigned to New Owner	Request for this change of interests is stored on IP 78299		04 Jun 2008
Agent changed	Assignment Client Reference: DEK 308685NZAR01		04 Jun 2008
Owner Address changed	Assignment Client Reference: DEK 308685NZAR01		04 Jun 2008
Owner Address changed	Assignment Client Reference: DEK 308685NZAR01		08 Aug 2007
TM Registered	Registered	1529	09 Nov 2006
TM Accepted	Print Notice Of Acceptance		10 Jul 2006
TM Accepted	Application Accepted	1525	07 Jul 2006

Type	Description	Journal	Creation Date
Response to TM CR sent to IPONZ	Evidence		07 Jul 2006
Examination Completed without objections	Examination Completed		07 Jul 2006
Edit case details	Opposition withdrawn.		13 Jun 2006
Response to TM CR sent to IPONZ	Examination Correspondence		30 May 2006
Edit case details	Letter received from BSW, dated 17/12/03 - Ref NJ142126		12 Jan 2004
IP App validated	Collation Completed		06 Oct 2003
TM App submitted	Filed		02 Oct 2003

IP Number: 780451
Client Reference: DEK152739NZPR
Status: Registered
Mark Nature: Trade Mark
Mark Type: Word
Series: No
Mark Name: MUSTANG

Submission Date: 30 Nov 2007
Filing Date: 30 Nov 2007
Registration Date: 05 Jun 2008
Renewal Due Date: 30 Nov 2027
Under Proceeding: No

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

Nice Classification Schedule: 9

Pre-approved goods/services: No

Classes and Specifications:

Class	Goods and Services Descriptions
3	colognes, perfumes, after shaves, shampoos, hair conditioners, skin lotions, face lotions, hand lotions and soaps

Priority : None

Agent :

BALDWINS INTELLECTUAL PROPERTY	Service : Level 20, 157 Lambton Quay, Wellington 6011, NZ Postal : DX SP22044, Wellington 6011, NZ Physical : Level 20, 157 Lambton Quay, Wellington 6011, NZ Postal : PO Box 852, Wellington 6011, NZ Email Address: email@baldwins.com
--------------------------------	--

Applicant(s) :

Ford Motor Company	Physical : One American Road, Dearborn, Michigan , 48126, US Postal : One American Road, Dearborn, Michigan , 48126, US
--------------------	--

Contact Details : BALDWINS INTELLECTUAL PROPERTY, Level 20, 157 Lambton Quay, Wellington 6011, NZ

Linked Cases: None

History:

Type	Description	Journal	Creation Date
IP user in charge transferred	Case assigned from Rebecca James to Howie Bruce		15 Oct 2018
TM Renewed	Trade Mark Renewed for 10 years until 30 Nov 2027 by CPA Global	1660	23 Oct 2017
Renewal reminder sent	Renewal reminder sent		30 Jul 2017
TM Registered	Registered	1548	05 Jun 2008
TM Accepted	Application Accepted	1542	06 Dec 2007
Examination Completed without objections	Examination Completed		06 Dec 2007
TM Accepted	Print Notice Of Acceptance		06 Dec 2007
IP Corrected	Change IP Product		05 Dec 2007
IP App validated	Collation Completed		03 Dec 2007

Type	Description	Journal	Creation Date
IP Corrected	Change IP Product		03 Dec 2007
TM App submitted	Filed		30 Nov 2007

IP Number: 979126
Client Reference: KGI 163983NZPR
Status: Registered
Mark Nature: Trade Mark
Mark Type: Word
Series: No
Mark Name: MUSTANG

Submission Date: 17 Jun 2013
Filing Date: 17 Jun 2013
Registration Date: 18 Dec 2013
Renewal Due Date: 17 Jun 2023
Under Proceeding: No

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

Nice Classification Schedule: 10

Pre-approved goods/services: No

Classes and Specifications:

Class	Goods and Services Descriptions
9	Eyeglass frames, eyeglasses, sunglasses, reading glasses, eyeglass cases, computer mice, computer mouse pads, computer keyboards, mobile phones, mobile phone cases, personal media players, telephones, tablet computers, headphones, televisions, stereos, loudspeakers.

Priority : None

Agent :

BALDWINS INTELLECTUAL PROPERTY	Service : Level 20, 157 Lambton Quay, Wellington 6011, NZ Postal : DX SP22044, Wellington 6011, NZ Physical : Level 20, 157 Lambton Quay, Wellington 6011, NZ Postal : PO Box 852, Wellington 6011, NZ Email Address: email@baldwins.com
--------------------------------	--

Applicant(s) :

Ford Motor Company	Physical : One American Road, Dearborn, Michigan 48126, US Postal : One American Road, Dearborn, Michigan 48126, US
--------------------	--

Contact Details : BALDWINS INTELLECTUAL PROPERTY, Level 20, 157 Lambton Quay, Wellington 6011, NZ

Linked Cases: None

History:

Type	Description	Journal	Creation Date
TM Registered	Trade Mark Registered	1614	18 Dec 2013
TM Accepted	Trade Mark Accepted	1609	03 Jul 2013
Task routed to new user	Task Examine TM Application has been routed to Jo Roberts		17 Jun 2013
Primary examiner modified	Case assigned to Jo Roberts		17 Jun 2013
TM App submitted	IP Application submitted		17 Jun 2013

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

The New Zealand Trade Marks Act 2002

AND

IN THE MATTER OF

New Zealand Trade Mark Application No. 1095484



in class 12 in the name of Landtourer
Automobile Co.

AND

IN THE MATTER OF

An Opposition by Ford Motor Company

NOTICE OF OPPOSITION

12 October 2018

BALDWINS INTELLECTUAL PROPERTY
Patent Attorneys & Solicitors

Person Acting: Kate Giddens
Phone: 04 472 1094
Fax: 04 473 6712
PO Box 852
WELLINGTON 6011
File Reference: 170447NZOP

NOTICE OF OPPOSITION

TAKE NOTICE that Ford Motor Company (the “**Opponent**”) of One American Road Dearborn 48126 Michigan, United States of America opposes the New Zealand



registration of trade mark application no. 1095484 (IR1406563) in class 12 (the “**Applicant’s Mark**”) in the name of Landtourer Automobile Co (“the **Applicant**”).

The grounds on which the Opponent relies are:

1. Deception or Confusion: Section 17(1)(a) of the Trade Marks Act 2002

- 1.1. The Opponent owns, uses, and has a reputation in a number of trade marks internationally and in New Zealand, including the trade marks



MUSTANG, and the New Zealand trade marks listed in **Schedule A** (collectively, the “**Opponent’s Marks**”), all of which have priority over the Applicant’s Mark.

- 1.2. Use of the Applicant’s Mark would be likely to deceive or cause confusion pursuant to section 17(1)(a) of the Trade Marks Act 2002 (the “**Act**”) because:

- 1.2.1. The Opponent’s Marks have been used by the Opponent worldwide and in New Zealand since the 1960s in relation to a wide range of goods, including *inter alia* motor vehicles, motor vehicle parts, various motor vehicle components and accessories, and all of the goods specified by the registrations listed in Schedule A (collectively, “the **Opponent’s Goods**”);

- 1.2.2. By reason of the Opponent's ownership and use, there is an awareness, cognisance or knowledge of the Opponent's Marks in New Zealand, which are distinctive of the Opponent;
- 1.2.3. The Applicant's Mark so closely resembles the Opponent's Marks and reputation that any use by the Applicant of the Applicant's Mark will deceive consumers and/or will cause confusion in the market as to the kind, nature, source, and/or quality of goods provided under the Applicant's Mark;
- 1.2.4. Persons aware of the Opponent's Marks and reputation, and seeing the Applicant's Mark, would have cause to wonder whether or not the goods bearing the Applicant's Mark were connected in the course of trade with, approved by, endorsed by and/or affiliated with the Opponent.

2. Similar Trade Mark: Section 25(1)(b) of the Act

- 2.1. The Opponent repeats paragraph 1.
- 2.2. The Opponent owns the trade mark registrations listed in Schedule A (the "**Opponent's Registrations**").
- 2.3. The Applicant's Mark is not registrable pursuant to section 25(1)(b) of the Act because:
 - 2.3.1. The Opponent's Registrations have priority over the Applicant's Mark;
 - 2.3.2. The Applicant's Mark is similar to the Opponent's Registrations;
 - 2.3.3. The Applicant seeks to register the Applicant's Mark in respect of goods that are the same, similar, and/or closely related to those of the Opponent's Registrations; and

- 2.3.4. Use of the Applicant's Mark would be likely to deceive consumers and/or cause confusion in the market, for example as to the kind, quality, nature, source, and/or characteristics of goods provided under the Applicant's Mark.

3. Well Known Marks: Section 25(1)(c) of the Act

- 3.1. The Opponent repeats paragraph 1.
- 3.2. The Applicant's Mark is not registrable under section 25(1)(c) of the Act because:
 - 3.2.1. The Opponent's Marks have been used and are well known in New Zealand for the Opponent's Goods; and
 - 3.2.2. The Applicant's Mark or an essential element of it is identical and/or similar to the Opponent's Marks; and
 - 3.2.3. The Applicant's Mark is applied for in respect of goods which are similar to the Opponent's Goods; or
 - 3.2.4. The Applicant's Mark is applied for in respect of goods which are dissimilar to the Opponent's Goods; and
 - 3.2.5. Use of the Applicant's Mark would be taken as indicating a connection in the course of trade between the Applicant's goods and the Opponent and/or the Opponent's Goods, and such use is likely to prejudice the interests of the Opponent including dilution of the Opponent's Marks and damage to the Opponent's reputation.

4. Contrary to Law and Disentitled to Protection: Fair Trading Act 1986 and Passing Off

- 4.1. The Opponent repeats paragraph 1.
- 4.2. The Opponent's Marks have a goodwill and reputation in New Zealand, and are distinctive of the Opponent.
- 4.3. Use of the Applicant's Mark by the Applicant is contrary to New Zealand law within the meaning of section 17(1)(b) of the Act because such use is contrary to any or all of sections 9, 10, 13 and 16 of the Fair Trading Act 1986 and/or would constitute passing off at common law.

Particulars: Breach of the Fair Trading Act 1986

- 4.4. Use of the Applicant's Mark by the Applicant would amount to engaging in conduct in the course of trade that is misleading or deceptive or likely to mislead or deceive.
- 4.5. Use of the Applicant's Mark by the Applicant would amount to engaging in conduct that is liable to mislead the public as to the kind, quality, nature, source, and/or characteristics of goods provided under the Applicant's Mark.
- 4.6. Use of the Applicant's Mark by the Applicant would also result in false and/or misleading representations in connection with the supply and/or promotion of goods. In particular, such conduct would falsely and/or misleadingly represent that:
 - 4.6.1. The Applicant's goods are of the same kind, quality, nature, source, and/or characteristics as the Opponent's Goods;
 - 4.6.2. The Applicant's goods are suitable for use with the Opponent's Goods;

- 4.6.3. The Applicant's goods have the Opponent's sponsorship, approval, license, and/or endorsement;
- 4.6.4. There is some form of business association or connection between the Applicant and the Opponent, and/or that the Applicant has the Opponent's sponsorship, approval, license, endorsement and/or is affiliated with the Opponent; and/or
- 4.6.5. The Applicant has been licensed by the Opponent to use the Applicant's Mark.

Particulars: Passing off

- 4.7. Use of the Applicant's Mark by the Applicant would constitute a misrepresentation made in the course of trade to prospective or actual customers. In particular, such conduct would constitute a misrepresentation by the Applicant in the course of trade that:
 - 4.7.1. The Applicant's goods are of the same kind, quality, nature, source, and/or characteristics as the Opponent's Goods;
 - 4.7.2. The Applicant's goods have the Opponent's sponsorship, approval, license, and/or endorsement;
 - 4.7.3. There is some form of business association or connection between the Applicant and the Opponent, and/or that the Applicant has the Opponent's sponsorship, approval, license, endorsement and/or is affiliated with the Opponent; and/or
 - 4.7.4. The Applicant has been licensed by the Opponent to use the Applicant's Mark.

Particulars: Damage for passing off and/or breach of the Fair Trading Act 1986

- 4.8. Use of the Applicant's Mark by the Applicant would be likely to cause damage to the business and goodwill of the Opponent in New Zealand, including:
 - 4.8.1. Diversion of trade from the Opponent;
 - 4.8.2. Damage to the Opponent's goodwill and reputation through mistaken associations; and
 - 4.8.3. Erosion of the distinctiveness of the Opponent's Marks through dilution of goodwill.

5. RELIEF SOUGHT

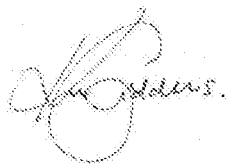
- 5.1. In view of the foregoing facts and further facts to be adduced in evidence (notice of the Opponent's intention to file such evidence is hereby given), in the discretion of the Commissioner and in the public interest, registration of the Applicant's Mark should be refused.
- 5.2. Accordingly, the Opponent seeks:
 - 5.2.1. Refusal of the Applicant's Mark;
 - 5.2.2. Costs;
 - 5.2.3. Such further relief as the Commissioner may deem appropriate.

This notice of opposition is filed by Ford Motor Company, whose address for service in these proceedings is at the offices of Baldwins Intellectual Property, Level 20, 157 Lambton Quay, WELLINGTON 6011. All correspondence should be addressed for the attention of Kate Giddens.

DATED: 12 OCTOBER 2018

FORD MOTOR COMPANY by its Authorised Agents


BALDWINS INTELLECTUAL PROPERTY



Per:

Kate Giddens

SCHEDULE A
THE OPPONENT'S REGISTRATIONS

No.	Trade mark	Class
702471		12
702472	MUSTANG	12
780451	MUSTANG	3
979126	MUSTANG	9