


**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 May 2019
3.	Number of the international registration: 1453355
4.	Our reference: 1114976-4840
5.	<div style="display: flex; align-items: center;"> <div style="flex: 1;"> <p>Representation of the mark:</p> </div> <div style="flex: 1; text-align: center;">  </div> </div>
6.	Name of the holder: Shantou Chenghai Longjun Toy Factory
7.	Basis for refusal: Provisional refusal based on an opposition
8.	<p>Name and address of the opponent:</p> <p>LEGO Juris A/S 7190 Billund Denmark</p>
9.	Scope of this refusal: Provisional refusal for all the goods and/or services.
10.	<p>Grounds for refusal:</p> <p><i>See attached Notice of Opposition.</i></p>
11.	<p>Information relating to an earlier mark:</p> <p><i>See attached print-out from the New Zealand trade marks register.</i></p>
12.	<p>Information relating to subsequent procedure:</p> <p><u>Responding to this refusal</u></p> <p>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</p>

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 July 2019***, this refusal becomes final for the specified goods and/or services.

** Due to possible notification issues, this date may change. Please see IPONZ proceeding no. 4840 for more information.*

13. Signature by the Office:

Intellectual Property Office of New Zealand

Matthew Currie

+64 4 897 7682

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

32 Application: how made

(1) A person claiming to be the owner of a trade mark or series of trade marks may, on payment of the prescribed fee (if any), apply in the prescribed manner (if any) for the registration of the trade mark or series of trade marks used or proposed to be used in respect of the following:

- (a) particular goods or services within 1 or more classes:
- (b) particular goods and services within 1 or more classes.

(2) The Commissioner must not register a trade mark in respect of all of the goods and services included in a class, or a large variety of goods or services, unless the specification is justified by the use or intended use of the sign.

Case Details Report

Date and Time: 16 May 2019 08:53:54 a.m.

www.iponz.govt.nz

INTERNATIONAL: +64 3 962 2607

NATIONAL: 0508 4 IPONZ

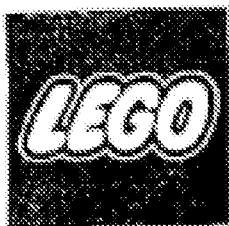
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Search Criteria:

IP Number: 106870
Client Reference:
Status: Registered
Mark Nature: Trade Mark
Mark Type: Combined
Series: No
Mark Name: LEGO
Intended use: Being used by the proprietor(s), (being the applicant)

Submission Date: 07 Jan 1974
Filing Date: 07 Jan 1974
Registration Date: 05 May 1975
Renewal Due Date: 07 Jan 2029
Under Proceeding: No

Image:



Vienna Codes: 26.4.22

Nice Classification Schedule: 4

Pre-approved goods/services: No

Classes and Specifications:

Class	Goods and Services Descriptions
28	games and playthings

Priority : None

Agent :

Andrew Brown QC	Physical : Level 22, Bankside Chambers, 88 Shortland Street, Auckland, NZ Postal : PO Box 2815, Shortland Street, Auckland 1140, NZ Email Address: andrew@andrewbrown.co.nz
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Applicant(s) :

LEGO Juris A/S	Physical : 7190 Billund, DK Postal : 7190 Billund, DK
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Contact Details : Andrew Brown QC, PO Box 2815, Shortland Street, Auckland 1140, NZ

Linked Cases: None

History:

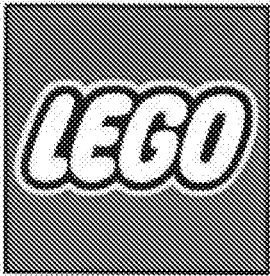
Type	Description	Journal	Creation Date
TM Renewed	Trade Mark Renewed for 10 years until 07 Jan 2029 by Andrew Brown QC	1674	14 Dec 2018
Renewal reminder sent	Renewal reminder sent		07 Sep 2018
IP Corrected	Change IP Document		30 Mar 2009
IP Renewed	Renewed by Andrew Brown QC	1554	08 Dec 2008
TM assigned to New Owner	Assignment Client Reference: Andrew Brown	1553	14 Oct 2008
TM assigned to New Owner	Request for this change of interests is stored on IP 636385		14 Oct 2008
Renewal reminder sent	Renewal Notice		08 Sep 2008
IP Corrected	Change IP Document		28 Sep 2007
TM assigned to New Owner	Assignment Client Reference: system fix		23 Sep 2002
Agent changed	Assignment Client Reference: system fix		23 Sep 2002
IP Corrected	Change IP Document		14 Mar 2002
Owner Address changed	ARev request: Proprietor, service address change		22 Jul 1999
Owner Address changed	ARev request: Proprietor, service address change		09 Sep 1997
TM assigned to New Owner	ARev request: Registered user, name change		06 Jun 1997
Owner Address changed	ARev request: Proprietor, change of address		06 Jun 1997
IP Renewed	Renewed by Andrew Brown QC		22 Dec 1994
IP Renewed	Renewed by Andrew Brown QC		07 Jan 1981
IP Renewed	Change Control Request 12		07 Jan 1981
TM Registered	Registered	1149	05 May 1975
TM App submitted	ARev conversion		07 Jan 1974

IP Number: 801499
Client Reference: LEGOAS:026
Status: Registered
Mark Nature: Trade Mark
Mark Type: Combined
Series: No
Mark Name: LEGO

Submission Date: 20 Jan 2009
Filing Date: 20 Jan 2009
Registration Date: 22 Jul 2009
Renewal Due Date: 20 Jan 2029
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

Image:



Vienna Codes: 26.4.1, 26.4.18, 27.5.1, 27.5.11, 27.5.24, 29.1.1, 29.1.2, 29.1.8

Nice Classification Schedule: 9

Pre-approved goods/services: No

Classes and Specifications:

Class	Goods and Services Descriptions
9	scientific, nautical, surveying, electric and electronic, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments (included in this class); apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; software
16	paper, cardboard and goods made from these materials (included in this class); printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (included in this class); printers' type; printing blocks
25	clothing, footwear, headgear
28	games and playthings; gymnastic and sporting articles (included in this class); decorations for Christmas trees
41	education; providing of training; entertainment; sporting and cultural activities

Priority : None

Agent :

Andrew Brown QC	Physical : Level 22, Bankside Chambers, 88 Shortland Street, Auckland, NZ Postal : PO Box 2815, Shortland Street, Auckland 1140, NZ Email Address: andrew@andrewbrown.co.nz
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Applicant(s) :

LEGO Juris A/S	Physical : 7190 Billund, DK Postal : 7190 Billund, DK
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Contact Details : Andrew Brown QC, PO Box 2815, Shortland Street, Auckland 1140, NZ

Linked Cases: None

History:

Type	Description	Journal	Creation Date
TM Renewed	Trade Mark Renewed for 10 years until 20 Jan 2029 by Zacco Denmark A/S	1673	21 Nov 2018
Renewal reminder sent	Renewal reminder sent		20 Sep 2018
TM Registered	Registered	1562	22 Jul 2009
TM Accepted	Print Notice Of Acceptance		26 Jan 2009
TM Accepted	Application Accepted	1556	23 Jan 2009
Examination Completed without objections	Examination Completed		23 Jan 2009
IP Corrected	Change IP Product		22 Jan 2009
IP Corrected	Change IP Document		22 Jan 2009
IP App validated	Collation Completed		21 Jan 2009
IP Corrected	Change IP Data		21 Jan 2009
IP Corrected	Change IP Product		21 Jan 2009
IP Corrected	Change IP Document		21 Jan 2009
TM App submitted	Filed		20 Jan 2009

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NOTICE OF OPPOSITION

Trade Mark Application No:

1114976

Mark:



("the opposed mark")

Class:

28

Applicant:

Shantou Chenghai Longjun Toy Factory

Name of Opponent:

Lego Juris A/S

Address for Service of Opponent:

Andrew Brown QC
Level 22
88 Shortland Street
Auckland 1140
New Zealand

Name of Opponent's Authorised Agent:

Andrew Brown QC

Counsel

ANDREW BROWN QC
Telephone: 09-366-6139
Facsimile: 09-366-6140
PO Box 2815
Shortland Street
AUCKLAND 1140

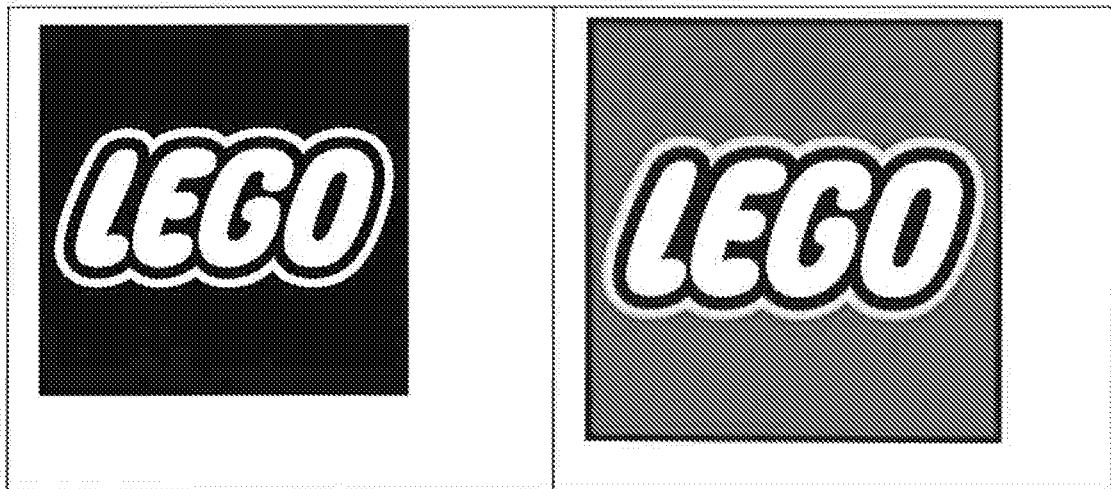
GROUNDS OF OPPOSITION

A. ABSOLUTE GROUNDS FOR NOT REGISTERING TRADE MARK

(1) Section 17(1)(a) – use of the mark likely to deceive or cause confusion

(a) The Opponent's reputation and goodwill in the Opponent's Trade Marks

1. The opponent has extensively used and promoted in New Zealand and internationally the registered trade marks set out in **Schedule A (the Opponent's Trade Marks)**.
2. The Opponent's Trade Marks include LEGO as a word mark and also as a logo mark in stylised form. The LEGO logo marks are depicted below:



3. The opponent has extensively used and promoted the Opponent's Trade Marks in New Zealand over many decades in relation to goods and services including but not limited to toys comprising colourful interlocking plastic bricks, parts, mini figures and figurines and associated merchandise, board games, video games, films, books and educational products and services (**the Opponent's Goods and Services**).
4. The opponent has also extensively used and promoted the Opponent's Trade Marks in New Zealand in relation to the Opponent's Goods and Services in association with other well-known trade marks owned by the third parties including but not limited to STAR WARS, BATMAN, PORSCHE 911 and BUGATTI CHIRON (**the Associated Trade Marks**).
5. By virtue of the opponent's extensive use and promotion of the Opponent's Trade Marks either on their own or in association with the Associated Trade Marks in relation to the Opponent's Goods and Services in New Zealand, the opponent has significant awareness, cognisance, knowledge and reputation in the Opponent's Trade Marks, including the word mark LEGO on its own and the LEGO logo marks (**the Opponent's Reputation**).
6. The Opponent's Reputation existed prior to 23 November 2018 (**the relevant date**), being the date of application for application 1114976.

(b) Use of the opposed mark is likely to deceive or cause confusion

7. The applicant has applied for registration of the combined word and logo mark in application 1114976 depicted below:



(the opposed mark).

8. The opposed mark is applied for with respect to goods in class 28, being:

"Intelligent toys; toys started by laser; toy models; toy vehicles; controllers for toys; scale model kits [toys]; toys; building blocks [toys]; scale model vehicles; radio-controlled toy vehicles."

(the applicant's goods).

9. By virtue of the Opponent's Reputation in the Opponent's Trade Marks (on their own and in association with the Associated Trade marks), use of the opposed mark with respect to the applicant's goods would be likely to deceive or cause confusion, and in particular members of the public will be confused or deceived into believing that there is a connection in the course of trade between the opposed mark and the opponent and the Opponent's Trade Marks, and/or that the opposed mark has been approved, licensed or endorsed by the opponent.
10. The registration of the opposed mark by the applicant would be contrary to s 17(1)(a) of the Trade Marks Act 2002.
- (2) Section 17(1)(b) – Fair Trading Act 1986**
11. Use of the opposed mark in relation to the applicant's goods by the applicant would be misleading or deceptive or is likely to mislead or deceive and would be contrary to s 9 of the Fair Trading Act 1986.
12. Use of the opposed mark in relation to the applicant's goods by the applicant (being a mark so similar to the Opponent's Trade Marks as to be likely to mislead or deceive) would be contrary to ss 13(e) and 16 of the Fair Trading Act 1986.
13. The registration of the opposed mark by the applicant would be contrary to s 17(1)(b) of the Trade Marks Act 2002.

(3) Section 17(1)(b) – Passing Off

14. Use of the opposed mark in relation to the applicant's goods by the applicant will result in the trade and public being confused or deceived into the belief that such goods are the goods of, or otherwise connected in the course of trade with, or approved, licensed

or endorsed by the opponent and such use is likely to cause damage to the opponent's goodwill and reputation.

15. The use of the opposed mark by the applicant would constitute passing off, and registration of the opposed mark would be contrary to s 17(1)(b) of the Trade Marks Act 2002.

(4) Section 17(2) – the application is made in bad faith

16. The opponent repeats paragraphs 1-6.
17. As at the date of application, the applicant was well aware of the extensive use and reputation of the opponent in the Opponent's Trade Marks and in particular the LEGO logo marks and of the Opponents Reputation.
18. By filing the application for the opposed mark in respect of the applicant's goods, the applicant:
 - (a) Seeks to obtain exclusive rights to a mark closely resembling the LEGO logo marks and in respect of goods which are the same or as closely similar to the Opponent's Goods and Services; and
 - (b) Intends or will be able to use the opposed mark on the opponent's goods so as to mislead or deceive consumers into believing that there is a connection between such trade marked goods and the opponent and the Opponent's Trade Marks, and/or that such trade marked goods have been approved, licensed or endorsed by the opponent.
19. Such conduct falls short of reasonable standards of acceptable commercial behaviour observed by reasonable and experienced persons.
20. The registration of the opposed mark would be contrary to s 17(2) of the Trade Marks Act 2002.

B. RELATIVE GROUNDS FOR NOT REGISTERING TRADE MARK

(1) Section 25(1)(b) – use of the mark likely to cause deception or confusion with registered trade mark

21. The opponent is the registered owner of the registered trade marks 106870 and 801499 for LEGO logo marks (as set out in **Schedule A**).
22. The opposed mark relates to goods identical with or similar to the goods covered by the registered trade marks 106870 and 801499.
23. The opposed mark is similar to registered trade marks 106870 and 801499.
24. Use of the opposed mark by the applicant in relation to the applicant's goods is likely to deceive or cause confusion amongst the relevant public and the trade.
25. The registration of the opposed mark would be contrary to s 25(1)(b) of the Trade Marks Act 2002.

(2) Section 25(1)(c) – use of the mark likely to cause deception or confusion with well-known trade mark

26. The opposed mark or an essential element of it is, similar to the Opponent's Trade Marks.

27. The Opponent's Trade Marks are well-known in New Zealand in respect of:

- (a) The applicant's goods;
- (b) Any similar goods and services; or
- (c) Other goods and services where the use of the opposed mark would be taken as indicating a connection in the course of trade between those other goods and services and the opponent, and would be likely to prejudice the interests of the opponent.

28. The registration of the opposed mark would be contrary to s 25(1)(c) of the Trade Marks Act 2002.

C. RELIEF SOUGHT

29. In view of the foregoing facts, and further facts to be adduced in evidence (notice of the opponent's intention to file and serve evidence is hereby given), at the discretion of the Commissioner and in the public interest, registration of the opposed mark as applied for by the applicant should be refused.

30. The relief sought by the opponent is:

- (a) Refusal of the application for the opposed mark;
- (b) Such further and other relief that may be just; and
- (c) Costs.

Dated 14th May 2019

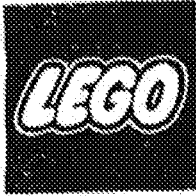
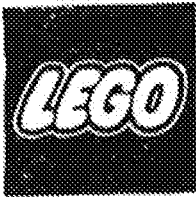
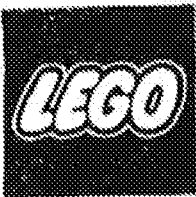
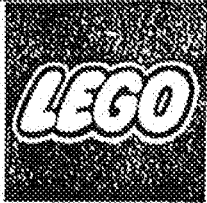
Lego Juris A/S by its duly authorised agent

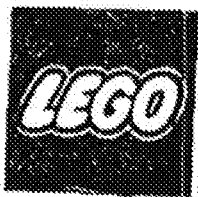
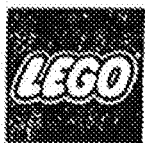
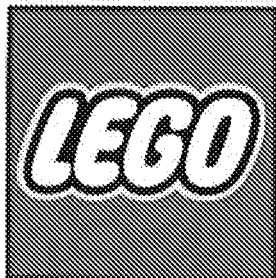
Andrew Brown QC



Andrew Brown QC

SCHEDULE A: the Opponent's Trade Marks

Trade mark	Registration number	Class
LEGO	66479	28
	106868	16
	106869	20
	106870	28
LEGO	126964	16
LEGO	126965	20
LEGO	126966	24
LEGO	126967	25
LEGO	146517	9, 11, 19, 22
	180085	35

Trade mark	Registration number	Class
	180086	41
	180087	42
LEGO	297768	3
LEGO	297769	9
LEGO	297771	14
LEGO	297772	16
LEGO	297773	18
LEGO	297775	21
LEGO	297776	24
LEGO	297777	25
LEGO	297778	27
LEGO	297779	28
LEGO	297780	41
LEGO	297781	42
LEGO	314095	35
	801499	9, 16, 25, 28, 41