

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

1.	<b>Office making the notification:</b> Intellectual Property Office of New Zealand
2.	<b>Date of the notification of provisional refusal:</b> 21 August 2019
3.	<b>Number of the international registration:</b> 1459845
4.	<b>Our reference:</b> 1117775-4998
5.	<p align="center"><b>sama GLAS</b></p> <p><b>Representation of the mark:</b></p>
6.	<b>Name of the holder:</b> GUANGDONG SHANGMING INDUSTRIAL CO., LTD.
7.	<b>Basis for refusal:</b> Provisional refusal based on an opposition
8.	<p><b>Name and address of the opponent:</b></p> <p>SAHM GM BH &amp; Co KG Westerwaldstrasse 13 Höhr-Grenzhausen 56203 Germany</p>
9.	<b>Scope of this refusal:</b> Provisional refusal for all the goods
10.	<p><b>Grounds for refusal:</b></p> <p>See attached Notice of Opposition.</p>
11.	<p><b>Information relating to an earlier mark:</b></p> <p>See attached print-out from the New Zealand trade marks register.</p>
12.	<p><b>Information relating to subsequent procedure:</b></p> <p><u><b>Responding to this refusal</b></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 filed using the Commissioner's website at <a href="http://www.iponz.govt.nz">www.iponz.govt.nz</a>.</p> <p><b><u>Timeframe for responding</u></b></p> <p>If the Holder does not respond by filing a counterstatement by <b>21 October 2019</b>, this refusal becomes final for the specified goods and/or services.</p>
13.	<p><b>Signature by the Office:</b></p> <p>Intellectual Property Office of New Zealand</p> <p>Nigel Robb +64 4 897 6412 For the Commissioner of Trade Marks</p>
14.	<p><b>Corresponding provisions of relevant law:</b></p> <p><b><u>Trade Marks Act 2002:</u></b></p> <p><b>17 Absolute grounds for not registering trade mark: general</b></p> <p>(1) The Commissioner must not register as a trade mark or part of a trade mark any matter—</p> <ul style="list-style-type: none"> <li>(a) the use of which would be likely to deceive or cause confusion; or</li> <li>(b) the use of which is contrary to New Zealand law or would otherwise be disentitled to protection in any court; or</li> <li>(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.</li> </ul> <p>(2) The Commissioner must not register a trade mark if the application is made in bad faith.</p> <p>(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</p> <p><b>25 Registrability of identical or similar trade mark</b></p> <p>(1) The Commissioner must not register a trade mark (trade mark A) in respect of any goods or services if—</p> <ul style="list-style-type: none"> <li>(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,— <ul style="list-style-type: none"> <li>(i) in respect of the same goods or services; or</li> <li>(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</li> </ul> </li> <li>(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</li> <li>(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,</li> </ul>

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: 21 Aug 2019 09:12:13 a.m.



[www.iponz.govt.nz](http://www.iponz.govt.nz)

INTERNATIONAL: +64 3 962 2607

NATIONAL: 0508 4 IPONZ

{0508 447 669}

**IP Number:** 980345

**Client Reference:**

**Status:** Protected

**Mark Nature:** Trade Mark

**Mark Type:** Word

**International number:** 0545507

**Mark Name:** sahm

**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

**Standard Characters:** No

**Consists of Colour:** No

**Submission Date:** 04 Jul 2013

**Filing Date:** 22 May 2013

**Registration Date:** 26 Nov 2013

**Under Proceeding:** No

**Basic Mark:**

**Designated countries:**

**Nice Classification Schedule:** 0

## Classes and Specifications:

Class	Goods and Services Descriptions	Countries
21	Utility and decorative objects made of earthenware, ceramic, porcelain, glass and tin for household and industrial use (for gastronomy), especially drinking vessels such as glasses, jugs, beer mugs, tankards, tumblers, beakers, goblets, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses.	
34	Ashtrays.	
40	Services for perfecting glassware, porcelain and earthenware, especially engraving, cutting, etching, printing, inscribing, painting.	
42	Silkscreen printing.	

**Priority :** None

**Seniority :** None

## Applicant(s) :

SAHM GMBH & Co KG	Postal : Westerwaldstrasse 13, 56203 HÖHR-GRENZHAUSEN, DE
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**Contact Details :** SCHIEDERMAIR RECHTSANWÄLTE Partnerschaftsgesellschaft, Eschersheimer Landstraße 60, 60322 Frankfurt am Main, DE

**Linked Cases:** None

**History:**

Type	Description	Journal	Creation Date
IP user in charge transferred	Case assigned from Tonja Flath to Jo Roberts		19 Nov 2018
NZD Protected	International Registration Designating NZ protected.	1613	26 Nov 2013
NZD accepted	International Registration Designating NZ accepted.	1609	25 Jul 2013
Task routed to new user	Task Examine NZD Application (First Examination) has been routed to Tonja Flath		05 Jul 2013
Primary examiner modified	Case assigned to Tonja Flath		05 Jul 2013
Subsequent designation Received	Notification of Subsequent Designation received from WIPO on 4/07/2013. Notification recorded in the International Register on 19/06/2013, effective in the International Register on 22/05/2013, and officially received from WIPO on 4/07/2013.		05 Jul 2013

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**IN THE MATTER OF**      The New Zealand Trade Marks Act 2002

**AND**

**IN THE MATTER OF**      Trade Mark Application No. 1117775 in class/classes in the  
name of GUANGDONG SHANGMING INDUSTRIAL CO.,  
LTD.

**AND**

**IN THE MATTER OF**      An Opposition by SAHM GMBH & Co KG

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**NOTICE OF OPPOSITION**

**19 August 2019**

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**BALDWINS INTELLECTUAL PROPERTY**  
Patent Attorneys & Solicitors

Person Acting: Penny Catley  
Phone 04 471 6885  
Fax 04 473 6712  
PO Box 852  
WELLINGTON 6011  
File Reference: 171328NZOP

## NOTICE OF OPPOSITION

**TAKE NOTICE** that SAHM GMBH & Co KG (“the Opponent”) of Westerwaldstrasse 13, 56203 Höhr-Grenzhausen, Germany, opposes registration of application no. 1117775 in Class 21 (“the Applicant’s mark”) in the name of GUANGDONG SHANGMING INDUSTRIAL CO., LTD. (“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 the trade mark “SAHM” internationally and in New Zealand, as shown in **Schedule A** (the “**Opponent’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 Mark has been used by the Opponent worldwide and in New Zealand for many years in relation to a range of goods, including *inter alia* glasses for drinking and all of the goods listed in **Schedule A** (collectively, the “**Opponent’s Goods**”);
  - 1.2.2. By reason of ownership and use of the Opponent’s Mark internationally and in New Zealand, the Opponent’s Mark is distinctive of the Opponent, has acquired a reputation and goodwill, and have become known to a large number of consumers in New Zealand;
  - 1.2.3. The Opponent’s reputation for the Opponent’s Mark predates the application date of the Applicant’s Mark;
  - 1.2.4. The Applicant’s Mark is similar to the Opponent’s Mark;

- 1.2.5. The Applicant seeks to register the Applicant's Mark in respect of goods that are similar and/or closely related to the Opponent's Goods for which the Opponent's Marks have acquired a goodwill and reputation in New Zealand; and
- 1.2.6. The Applicant's Mark so closely resembles the Opponent's Marks that any use by the Applicant of the Applicant's Mark will deceive and/or confuse consumers, for example, into thinking 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, endorsement, license, and/or is 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 Applicant's Mark is not registrable pursuant to section 25(1)(b) of the Act because:
  - 2.2.1 The Opponent owns the Opponent's Mark as listed in **Schedule A**;
  - 2.2.2 The Opponent's Mark have priority over the Applicant's Mark;
  - 2.2.3 The Applicant's Mark is similar to the Opponent's Mark;
  - 2.2.4 The Applicant seeks to register the Applicant's Mark in respect of goods that are the same, similar, and/or closely related to the Opponent's Goods; and
  - 2.2.5 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. Relief**

3.1. In view of the foregoing facts and further facts to be adduced in evidence (notice of the Opponent's intention to file evidence is hereby given), in the discretion of the Commissioner and in the public interest, registration of the Applicant's Mark should be refused.

3.2. Accordingly, the Opponent seeks:

3.2.1. Refusal of the Applicant's Mark in class 21;

3.2.2. Costs;

3.2.3. Such further relief as the Commissioner may deem appropriate.

This Notice of Opposition is filed by Penny Catley whose address for service is at the offices of Baldwins Intellectual Property, Level 20, 157 Lambton Quay, WELLINGTON 6011. All correspondence should be addressed for the attention of Niklas Fels

**DATED 21 August 2019**

SAHM GMBH & Co KG by its  
Authorised Agent  
**BALDWINS INTELLECTUAL PROPERTY**  
Per:



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Penny Catley

To: The Intellectual Property Office of New Zealand, Wellington

**SCHEDULE A  
THE OPPONENT'S MARK**

Trade Mark	No.	Class - Goods	Date
sahm	980345	<p>21 - Utility and decorative objects made of earthenware, ceramic, porcelain, glass and tin for household and industrial use (for gastronomy), especially drinking vessels such as glasses, jugs, beer mugs, tankards, tumblers, beakers, goblets, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses.</p> <p>34 - Ashtrays.</p> <p>40 - Services for perfecting glassware, porcelain and earthenware, especially engraving, cutting, etching, printing, inscribing, painting.</p> <p>42 - Silkscreen printing.</p>	22/05/2013