

NOTIFICATION OF PROVISIONAL REFUSAL OF AN INTERNATIONAL REGISTRATION DESIGNATING NEW ZEALAND

1.	Office making the notification: Intellectual Property Office of New Zealand						
2.	Date of the notification of provisional refusal: 6 June 2020						
3.	Number of the international registration: 1515221 Our reference: 1141215						
4.	 Representation of the mark: 长白山人参 CBM GINSENG						
5.	Name of the holder: JILIN GINSENG ASSOCIATION						
6.	Basis for refusal: Provisional refusal based on an <i>ex officio</i> examination.						
7.	Scope of refusal: Provisional refusal for all the goods and/or services.						
8.	Grounds for refusal: <u>Type and nature of trade mark</u> Unclear as to whether mark is a collective mark or certification mark <table border="1"> <tr> <td>Objection</td> <td> You need to provide an indication whether your mark is for a collective mark or a certification mark before we can examine your mark any further. Please note that if your mark is a certification mark, draft regulations need to be submitted to us within 6 months from the date we were notified of the designation. </td> </tr> <tr> <td>Goods and/or services</td> <td>This objection relates to all goods/ services claimed.</td> </tr> <tr> <td>Relevant law</td> <td>The relevant provisions of New Zealand law are listed below at 11.</td> </tr> </table>	Objection	You need to provide an indication whether your mark is for a collective mark or a certification mark before we can examine your mark any further. Please note that if your mark is a certification mark, draft regulations need to be submitted to us within 6 months from the date we were notified of the designation.	Goods and/or services	This objection relates to all goods/ services claimed.	Relevant law	The relevant provisions of New Zealand law are listed below at 11.
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Goods and/or services	This objection relates to all goods/ services claimed.						
Relevant law	The relevant provisions of New Zealand law are listed below at 11.						

Collective mark

Regulation 59 – Collective Mark

Objection	An application for registration of a collective trade mark must contain a declaration that the applicant is a collective association as defined in section 5(1) of the Act. Section 5(1) of the Act states that: Collective association means a body (whether incorporated or not) that has or is able to have members, and is – (a) constituted for the benefit of its members for the time being; and (b) so constituted that its membership at any time can be ascertained. Please provide a statutory declaration that your organisation is a collective association as defined above. Include this in your <i>Objection Response</i>. The declaration should include the following additional information: 1. Whether the association has a list of members; 2. Where the list of members list is held; 3. How often the list of members is updated; 4. If there are any conditions for use of the mark; and 5. Whether any such conditions for the use of the mark are the same as conditions for membership of the collective association.
Goods and/or services	This objection relates to all goods/ services claimed.
Relevant law	The relevant provisions of New Zealand law are listed below at 11.

Certification mark

Section 54 – Certification mark draft regulations

Objection	We require draft regulations that govern the use of your certification mark before we can fully examine your application. In accordance with Regulation 57 of the Regulations, you must file
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		the draft regulations in a form acceptable to the Commissioner by 20 August 2020. Please file appropriate draft regulations. Include these in your <i>Objection Response</i>. The Regulations should include: 1. Provisions regarding the character of goods being certified; 2. The objective standard that is to be achieved before the use of the certification mark is permitted; 3. The means by which the applicant will control the use of the mark including – - the procedure whereby use of the mark will be granted in the first instance; - procedures to ensure that the standards are maintained; and - details regarding the surveillance and supervision that users of the mark will be subject to; 4. The right of appeal to an independent person or body in the event an application to seek licence is refused or if the license is revoked. An appropriate form of recourse is to use the Commissioner of Trade Marks as an independent authority; 5. A statement as to any fee structure; and 6. A statement as to the process involved in termination of licenses. We will assess your draft regulations to determine whether they are acceptable. If the regulations are vague, or indicate that registration of your mark may result in restrictive trade practices, we may refuse registration of your mark or require amendments to your regulations.
	Goods and/ or services	This objection relates to all goods/ services claimed.
	Relevant law	The relevant provisions of New Zealand law are listed below at 11.
9. Information relating to subsequent procedure: <u>Responding to this refusal</u> The Holder may respond in writing to this refusal. Any response made to the Office must be		

filed using the Commissioner's website at www.iponz.govt.nz. You will also need to provide an address for service in New Zealand or Australia.

Timeframe for responding

If the Holder does not respond by **20 February 2021**, this refusal becomes final for the specified goods and/or services.

Refusal still possible following opposition

If we subsequently accept the designation in New Zealand refusal may still result from an opposition. The opposition period runs for 3 months from the publication of the mark. It is possible that an opposition may be filed more than 18 months from the date we were notified of the International Registration.

10. Signature by the Office:

Intellectual Property Office of New Zealand

David Da Vanzo

Senior Trade Mark Examiner

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For the Commissioner of Trade Marks

11. Provisions of relevant law:

Trade Marks Act 2002

5 Interpretation

(1) In this Act, unless the context otherwise requires,—

collective association means a body (whether incorporated or not) that has or is able to have members, and is—

(a) constituted for the joint benefit of its members for the time being; and

(b) so constituted that its membership at any time can be ascertained

5 Interpretation

(1) In this Act, unless the context otherwise requires,—

trade mark—

(a) means any sign capable of—

(i) being represented graphically; and

(ii) distinguishing the goods or services of one person from those of another person; and

(b) includes,—

(i) except in section 85, a certification trade mark; and

(ii) except in section 85, a collective trade mark

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.

18 Non-distinctive trade mark not registrable

- (1) The Commissioner must not register—
- (a) a sign that is not a trade mark:
 - (b) a trade mark that has no distinctive character:
 - (c) a trade mark that consists only of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services:
 - (d) a trade mark that consists only of signs or indications that have become customary in the current language or in the bona fide and established practices of trade.
- (2) The Commissioner must not refuse to register a trade mark under subsection (1)(b), (c), or (d) if, before the date of application for registration, as a result of either the use made of it or of any other circumstances, the trade mark has acquired a distinctive character.

19 Relevance of colour to distinctive character of trade mark

- (1) In determining the distinctive character of a trade mark, the Commissioner or the court, as the case may be, must consider whether or not the trade mark is, or is to be, limited in whole or in part to 1 or more specified colours.
- (2) A trade mark that is, or is to be, registered without limitation of colour is, or will be, registered for all colours.

20 Trade mark that contains protected geographical indication must not be registered

The Commissioner must not register a trade mark that—

- (a) contains a protected geographical indication in respect of specified goods; and
- (b) relates to specified goods that do not originate from the place indicated in the protected geographical indication.

21 Trade mark that contains commonly used chemical names must not be registered

- (1) The Commissioner must not register, in respect of a chemical substance or preparation, a trade mark that contains the commonly used and accepted name of any single chemical element or single chemical compound.
- (2) Subsection (1) does not apply to a word that is used to denote only a brand or make of the element or compound made by the owner or a licensee of the trade mark, together with a suitable name or description open to the public use.

22 Registrability of trade mark that contains certain words

The Commissioner may register a trade mark that contains the words “copyright”, “layout design”, “patent”, “patented”, “plant variety right”, “registered”, “registered design”, or “trade mark”, or any abbreviations of those words, or any similar words.

23 Registrability of trade mark that contains person's name

If a person applies for registration of a sign as a trade mark and the sign contains the name or representation of a person, the Commissioner may require the written consent of—

- (a) that person unless the person died 10 years or more before the making of the application; or
- (b) the person's legal representative if—
 - (i) the person died within 10 years before the making of the application; or
 - (ii) the Commissioner thinks the person's consent cannot for any other reason be obtained.

24 Registrability of trade mark that contains representations of Royal Family

The Commissioner must not register a trade mark that contains a representation of Her Majesty or any member of the Royal Family, or an imitation of any such representation, unless the applicant has obtained the consent of Her Majesty or the relevant member of the Royal Family to the registration of the trade mark.

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).

27 Registrability of trade mark that contains representation of flag, etc, generally

- (1) If a person applies for registration of a sign as a trade mark and the sign includes a representation of the flag, armorial bearing, insignia, orders of chivalry, or decorations of any entity, the Commissioner may require that the applicant obtain the written consent of the person who appears to the Commissioner to be entitled to consent to the registration and use of the sign as a trade mark.

- (2) Subsection (1) does not apply if section 28 or section 29 applies.

28 Registrability of trade mark that contains flag, State emblems, etc, of convention country

The Commissioner must not, without the authorisation of the competent authorities of the country concerned, register a trade mark that contains a representation of—

- (a) the flag of a convention country unless the Commissioner considers that the use of the flag in the manner proposed is permitted without that authorisation; or
- (b) the armorial bearings or any other State emblem of a convention country that is protected under the Paris Convention or the TRIPS Agreement; or
- (c) an official sign or hallmark—
 - (i) adopted by a convention country; and
 - (ii) that indicates control and warranty in relation to goods or services of the same, or similar, kind as those goods or services in relation to which the trade mark is to be registered; and
 - (iii) that is protected under the Paris Convention or the TRIPS Agreement.

29 Registrability of trade mark that contains armorial bearings, etc, of certain international organisations

- (1) The Commissioner must not, without the authorisation of the international organisation concerned, register a trade mark that contains a representation of the armorial bearing, flag, or other emblem, or the abbreviation or name, of an international intergovernmental organisation of which 1 or more convention countries are members if the armorial bearing, flag, or other emblem, or the abbreviation or name, of the international organisation concerned is protected under the Paris Convention or the TRIPS Agreement.

- (2) Despite subsection (1), the Commissioner may register a trade mark if the Commissioner considers that the use of the armorial bearing, flag, or other emblem, or the abbreviation or name, of the international organisation concerned in the manner proposed—

- (a) is not likely to suggest to the public that a connection exists between the organisation and the trade mark; or
- (b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

30 When emblems, etc, are protected under Paris Convention or TRIPS Agreement

For the purposes of [section 28](#) and [section 29](#), the State emblems (other than the national flag) of, or the official signs or hallmarks adopted by, a convention country, or the emblems, abbreviations, or names, of an international organisation, as the case may be, are protected under the Paris Convention or the TRIPS Agreement only if, or to the extent that,—

- (a) the country or the organisation concerned has notified New Zealand in accordance with Article 6~~ter~~ (3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect the State emblem, official sign, or hallmark, or the emblem, abbreviation, or name, as the case may be; and
- (b) the notification remains in force; and
- (c) New Zealand has not objected to it in accordance with Article 6~~ter~~ (4) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

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.

54 When regulations that govern use of certification trade mark must be provided

Before the Commissioner makes a decision on an application for the registration of a certification trade mark, the applicant must provide the Commissioner with draft regulations that govern the use of the certification trade mark for the Commissioner's approval.

55 Consideration of application for registration of certification trade mark

- (1) When the Commissioner or the court deals with an application for the registration of a certification trade mark, the Commissioner or the court, as the case may be, must consider—
 - (a) the matters that are relevant to an application under [section 32](#); and
 - (b) whether or not the certification trade mark should indicate that it is such a trade mark; and
 - (c) whether the applicant is competent to certify the goods or services in respect of which the certification trade mark is to be registered; and
 - (d) whether the draft regulations are satisfactory in terms of subsection (2); and
 - (e) whether in all the circumstances the registration applied for would be in the public interest.

- (2) For the purposes of subsection (1)(d), regulations—
- (a) must contain provisions that relate to when the owner is—
 - (i) to certify goods or services; and
 - (ii) to authorise the use of the trade mark; and
 - (b) must contain, or may contain, any other provisions that the Commissioner requires or permits (as the case may be) to be inserted in them (for example, a right of appeal to the Commissioner against the owner's refusal to certify goods or services or to authorise the use of the trade mark in accordance with the regulations).

Trade Mark Regulations 2003

42 Information required in application for registration on filing

- (1) The application must contain the following information when it is filed:
- (a) the applicant's name and address or, in the case of joint applicants, the name and address of each applicant unless regulation 13(2) applies;
 - (b) a clear representation of the trade mark;
 - (c) if the application is for registration of a series of trade marks, a clear representation of each trade mark in the series;
 - (d) the goods and services for which registration is required.
- (2) The information provided under subclause 1(a) relating to the applicant's address may also contain any or all of the following:
- (a) a telephone number
 - (b) a fax number
 - (c) an email address
 - (d) an alternative address
- (3) In this regulation, **address** means a postal address that is sufficiently detailed to enable the Commissioner to contact the applicant at that address.

44 Information that must be supplied before acceptance of application

An applicant must supply the following information before the application can be accepted, and may supply it after filing the application:

- (a) the applicant's address for service
- (b) whether the application is for a certification or a collective trade mark; and
- (c) the class or classes of the edition of the Nice Classification in effect at the time of the application in which registration is sought; and
- (d) in the case of a certification trade mark, the regulations governing the use of the trade mark approved by the Commissioner; and
- (e) a transliteration of any foreign characters in the trade mark; and
- (f) a translation of any foreign words in the trade mark; and
- (g) if the trade mark is a colour or colours, a description acceptable to the Commissioner of the colour or colours; and
- (h) if the trade mark is limited as to colour, a description acceptable to the Commissioner of the colour or colours in the trade mark; and
- (i) if the applicant has made a claim for convention priority, the information specified in regulation 47; and

- (j) a statement by the applicant that the trade mark is being used or is proposed to be used.

45 Commissioner may request further information

The Commissioner may request further information from an applicant that will assist in the examination of the application.

59 Requirements for collective trade mark application

An application for registration of a collective trade mark must—

- (a) comply with the requirements of regulation 41, regulation 42, and regulation 44; and
- (b) contain a declaration that the applicant is a collective association as defined in section 5(1) of the Act.