

## 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:** 7 September 2022
3. **Number of the international registration:** 1664726

**Our reference:** 1212127

4. **Representation of the mark:**



5. **Name of the holder:** Solera Global Technology Limited
6. **Basis for refusal:** Provisional refusal based on an *ex officio* examination.
7. **Scope of refusal:** Provisional refusal for all the goods and/or services.
8. **Grounds for refusal:**

We have examined your international registration designating New Zealand with reference to the Trade Marks Act 2002 (“the Act”), the Trade Marks Regulations 2003, (“the Regulations”) and our trade mark practice guidelines.

We cannot accept your designation now, for the reasons set out in this refusal.

**Deadline to respond to this refusal: 7 September 2023**

### Goods and/or services unduly broad

Objection	Your class 42 specification includes:
	Software as a service (SaaS) services <b>featuring</b> software for database management, vehicle fleet information, electronic logging and reporting of regulatory compliance information, vehicle and parts identification and loss valuation, vehicle repair information, damage detection, guided image capturing and image analytics, and tracking information on insurance coverage, claims,

	<p>and management, all for use in connection with automotive vehicles and other motorized vehicles, and transportation and distribution industries;</p> <p>software as service (SaaS) services <b>featuring</b> software for customer data management and analysis, sales and pricing data management and analysis, accounting and inventory management, website and digital marketing tools, all relating to marketing and advertising in connection with automotive and other motorized vehicles, and transportation and distribution industries.</p> <p>The above term is too broad and vague as it does not precisely indicate the nature of the services being provided.</p> <p>Please provide a more precise description of the services. Please note, the Office does not consider <b>featuring</b> a sufficiently limiting term. The Applicant may consider replacing the term with wording similar to</p> <p style="padding-left: 40px;">Software as a service (SaaS) services <b>namely</b> software for database management, vehicle fleet information, electronic logging and reporting of regulatory compliance information, vehicle and parts identification and loss valuation, vehicle repair information, damage detection, guided image capturing and image analytics, and tracking information on insurance coverage, claims, and management, all for use in connection with automotive vehicles and other motorized vehicles, and transportation and distribution industries;</p>
Relevant law	The relevant provisions of New Zealand law are listed below at 11.

**Section 25(1)(b) -- similar trade mark**

Objection	<p>We cannot register a trade mark that is confusingly similar to a trade mark with earlier priority for the same or similar goods and/or services.</p> <p>Our search of the register has revealed at least one confusingly similar trade mark with earlier priority for the same or similar goods and/or services.</p> <p>The confusingly similar mark(s) with earlier priority are listed in the <b>attached</b> search report.</p>
Goods and/or services	This objection relates to all goods and services in the application.

Relevant law	The relevant provisions of New Zealand law are listed below at 11.
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**9. Information relating to subsequent procedure:**

**Responding to this refusal**

A response to this refusal can be made in writing via the IPONZ online case management system at [www.iponz.govt.nz](http://www.iponz.govt.nz).

To respond, you will need to appoint a **local agent** to manage your New Zealand designation.

A local agent must have:

- an address for service in New Zealand or Australia, and
- an account in the IPONZ online case management system.

**Note:** If your designation has an international representative, you will still need to appoint a local agent to manage your New Zealand designation. Your local agent may or may not be the same as your international representative. We recommend that you engage the services of a local intellectual property professional to act as your local agent.

**Timeframe for responding**

If the holder does not respond by **7 September 2023**, 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 three months from the date of advertisement 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 of the Office:**

Intellectual Property Office of New Zealand

Samantha Ludemann

Trade Mark Examiner

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For the Commissioner of Trade Marks

**11. Provisions of relevant law:**

**Trade Marks Act 2002**

**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.

## **34 Priority of applications for registration of identical or similar trade marks**

- (1) If different persons separately apply for the registration of trade marks that are identical or similar to each other and that are in respect of identical or similar goods or services, the first application received by the Commissioner has priority over all the other applications and may proceed.
- (2) If different persons separately apply for the registration of trade marks that are identical or similar to each other and that are in respect of identical or similar goods or services and their applications are received at the same time by the Commissioner,—
- (a) each application has equal priority and may proceed; and
  - (b) the Commissioner must notify each applicant of each other's application.
- (3) For the purposes of subsection (2), 2 or more applications that are received on the same day are to be treated as if they had been received at the same time.
- (4) Section 36 overrides this section.

**36 Priority of application to which convention country application relates**

- (1) A person who has applied for the registration of a trade mark in a convention country (whether before or after it became a convention country), or his or her legal representative or assignee, is entitled to registration of his or her trade mark in priority to other applicants, and the registration has the same date as the date of the application in the convention country if the application is made within 6 months after the date of the convention country application.
- (2) Subsection (1) applies only in respect of the first application for the trade mark that is made in a convention country by a person and does not apply to any subsequent applications for the trade mark by that person.
- (3) The use of the trade mark in New Zealand during the 6-month period referred to in subsection (1) does not affect the priority of the application for the registration of the trade mark to which the convention country application relates.

**Trade Mark Regulations 2003**

**45 Commissioner may request further information**

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

## Search report

Trademark Number	1033026		
Name of Owner	Solera Holdings, Inc., incorporated in the State of Delaware	Application date	03.12.2015
Status	100 Registered	Priority date	20.11.2015
Type and Nature	National Trade Mark	Deemed Registration date	20.11.2015
Client reference	T618511NZ	Renewal date	20.11.2025

Mark Name	SOLERA
Representation	N/A
Goods/ Services (Nice Classification Schedule 10)	<p>Class 9 Downloadable computer software and computer application software for mobile devices for use in the automotive, vehicle, fire, and health industries for vehicle identification and for vehicle and structural loss valuation, appraisals, damage estimation, inspection, repairs, repair workflow and tracking, customer satisfaction tracking, for interfacing with intelligent estimating system software; downloadable computer software and computer application software for analysis and control of workflow, profits, and business growth, for employee allocation; downloadable computer software and computer application software for performance tracking; downloadable computer software and computer application software for tracking inventory of vehicle parts; downloadable computer software and computer application software for managing databases for ordering vehicle parts, for sharing client data, and for processing, clearing, and reconciling financial transactions between insurers, vehicle and structural repair facilities, appraisers, salvage operators, recyclers in the automotive, vehicle, fire, and health industries, and vehicle and structure owners; downloadable electronic publications in the nature of newsletters in the field of vehicle insurance, collision repair, and vehicle salvage and recycling; downloadable manuals and recorded manuals in the field of automotive vehicle parts; downloadable instructional manuals and recorded instructional manuals in the fields of automotive vehicle repair and vehicle collision repair.</p> <p>Class 35 Cost assessment services, namely, estimating dollar value damage to automobiles and structures; providing trade information regarding the location of used vehicle parts; providing an online searchable database</p>

	<p>featuring informational listings on location and cost of used and recycled vehicle parts; online database management; collection and analysis of quality metric data for providing utilization, satisfaction, quality and financial measurements of suppliers and consumers in the field of property and vehicle repair; cost containment, referral, and auditing services for the purchase, billing and installation of products or rendering of services by others in the automotive, construction and insurance fields; advertising, marketing, direct mail and promotion services for automotive retailers, namely, providing advertising, marketing, direct mail and promotion services during the sale, post-sale, service, maintenance and repurchase of automobiles; Providing business risk evaluation information to insurance companies; providing an on-line searchable database featuring lists of the locations and costs of used and recycled vehicle parts for purchase by others; financial record-keeping of electronic payment data; electronic payment support services in the nature of electronic administrative invoice processing; insurance claims auditing of vehicle damage insurance claims for others; electronic payment support services in the nature of electronic administrative invoice processing; electronic invoice processing for bills in the automotive, construction, and insurance fields; insurance claims auditing of vehicle damage insurance claims for others; vehicle and structural damage insurance claims auditing services; providing trade information for auto technicians; collection and analysis of quality metric data, customer relationship management in the nature of providing information, and business information services in the nature of providing customer satisfaction information, all pertaining to insurance claims and vendors who complete work pursuant to those claims in the fields of automotive repair and building reconstruction and restoration, via a global network.</p> <p>Class 36 Financial services in the automotive, construction, and insurance fields, namely, electronic processing of insurance claims and payment data for damage to vehicles and structures; insurance consultation, namely, consultation in the fields of vehicle collision and structural repair claims processing and management; insurance claims administration and processing, namely, reviewing, managing, and processing vehicle and structural damage insurance claims for others; financial valuation, namely, vehicle and structural loss valuation services, repair cost appraisal, and estimating dollar value damage to vehicles and structures; providing financial information pertaining to insurance claims and vendors who complete work pursuant to those claims in the fields of automotive repair and building reconstruction and restoration via a global computer network; Insurance consultation services, namely, providing risk assessment analysis for insurance underwriting applications; providing information and on-line</p>
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	<p>computer databases for the purpose of assessing, evaluating and reporting insurance risks associated with underwriting property and casualty insurance; financial risk assessment and management services, namely, providing predictive financial risk analysis and information to insurers based on a database of public records regarding driving records pertaining to accidents, arrest and other driving violations to manage risk and providing predictive financial risk analysis and information to insurers based on a database searchable by zip code and geographic regions containing data used to assess risk variables to manage and price for risk; insurance services, namely, insurance policy verification for determining whether an individual or a business has insurance currently or had insurance as of a particular date. providing financial risk assessment analysis for insurance underwriting applications; fire and auto insurance underwriting services; providing information regarding underwriting property and casualty insurance and providing an on-line computer databases in the underwriting property and casualty insurance field for the purpose of assessing, evaluating and reporting insurance risks; analyzing and compiling data in the nature of driving records, vehicle information and information regarding drivers of motorized vehicles for use to determine financial risk of insurers; bill payment services and electronic payment processing services of bill payment data; providing insurance databases of public vehicle records regarding undisclosed motorists' driving records pertaining to accidents, arrests, and vehicle registration information for public safety and regulatory compliance purposes.</p> <p>Class 37 Providing an on-line computer database in the field of vehicle damage diagnosis, repair and maintenance for use by auto technicians.</p> <p>Class 42 Non-downloadable computer software for use in the automotive, vehicle, fire, and health industries for vehicle identification and for vehicle and structural loss valuation, appraisals, damage estimation, inspection, repairs, repair workflow and tracking, customer satisfaction tracking, and for processing, clearing, and reconciling financial transactions between insurers, vehicle and structural repair facilities, appraisers, salvage operators, recyclers in the automotive, vehicle, fire, and health industries, and vehicle and structure owners; providing temporary use of non-downloadable online computer software in the fields of automobile insurance and automobile repair for collecting and analyzing data on critical business performance indicators to increase employee efficiency and improve overall performance and profitability; providing online non-downloadable software for the tracking and reporting of the status of vehicle repairs between vehicle repair service providers and vehicle owners; platform-as-a-service (PAAS) featuring computer software platforms for tracking, updating and producing reports regarding the status of vehicle</p>
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	<p>repairs between vehicle repair service providers and vehicle owners; providing a website featuring software as a service technology (saas) that enables users to retrieve information regarding motorized vehicles, drivers and passengers of motorized vehicles, driving records and vehicle information; computer services, namely, electronic storage of information about motorized vehicles, drivers of motorized vehicles, and driving records; driver monitoring service, namely, providing online, non-downloadable computer programs allowing fleet owners and operators to track commercial drivers' traffic violations for regulatory compliance purposes.</p> <p>Class 45 Providing legal databases of public vehicle records regarding undisclosed motorists' driving records pertaining to accidents, arrests, and vehicle registration information for public safety and regulatory compliance purposes.</p>
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