



**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: 24 April 2023
3.	Number of the international registration: 1613195
4.	Our reference: 1189524 - 7136
5.	Representation of the mark: THE 1872 CLIPPER TEA CO.
6.	Name of the holder: NAVA 1872 PTE. LTD.
7.	Basis for refusal: Provisional refusal based on an opposition
8.	Name and address of the opponent: Kallo Foods Limited 2 River View, Meadows Business Park Station Approach Blackwater, Camberley Surrey GU17 9AB United Kingdom
9.	Scope of this refusal: Provisional refusal for all the goods and/ or services.
10.	Grounds for refusal: See <i>attached</i> Notice of Opposition.
11.	Information relating to an earlier mark: See <i>attached</i> print-out from the New Zealand trade marks register.
12.	Information relating to subsequent procedure: <u>Responding to this refusal</u> 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 or Australia 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 **24 June 2023**, this refusal becomes final for the specified goods and/or services.

** Due to possible notification issues, this date may change. See IPONZ case number 7136 for further information.*

13. Signature by the Office:

Intellectual Property Office of New Zealand

Elena Turusova

+64 4 897 5268

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: 24 Apr 2023 08:10:54 a.m.

Search Criteria:

Convention Priority Country: New Zealand

IP Number: 978647

Client Reference:

Status: Protected

Mark Nature: Trade Mark

Mark Type: Combined

International number: 1113470

Mark Name: CLIPPER NATURAL, FAIR & DELICIOUS

Description, Limitations, Additional Application Details:

Submission Date: 06 Jun 2013

Filing Date: 08 May 2013

Registration Date: 02 Sep 2014

Under Proceeding: No

- GSHEADEN-The subsequent designation is only for the class 30.-GSHEADEN

Conditions, Explanations, Memoranda, Transliteration, English Translation:

- Consent given by the owner of 40207 and 185666.

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

Colour Claimed As A Distinctive Feature: No

Image:



Vienna Codes: 26.4.24, 27.5.24

Basic Mark:

Designated countries:

Nice Classification Schedule: 10

Classes and Specifications:

Class	Goods and Services Descriptions	Countries
30	Beverages, tea and coffee; tea and coffee products; coffee beans; coffee substitutes; tea bags; fruit and herbal teas, fruit and herbal infusions; green tea;	

Class	Goods and Services Descriptions	Countries
	white tea; flavoured teas; iced tea; tea substitutes; instant coffee; ground coffee; chocolate and cocoa-based beverages; confectionery; chocolate based products; oat based food and drinks; malt based food and drinks; ice cream; bread, biscuits, cakes, pastries, cookies; preparations for making the aforesaid goods; muesli, sugar, sugar cubes and sticks; sauces, spices; flavourings, flavouring syrups, essences.	

Priority: None

Seniority: None

Agent:

Corrs Chambers Westgarth	Postal : GPO Box 9925, Melbourne VIC 3001, AU Physical : Bourke Place, Level 33, 600 Bourke Street, Melbourne VIC 3000, AU Service : C/- Hudson Gavin Martin, PO Box 105900, Auckland City, Auckland 1010, NZ Email Address: brooke.wright@corrs.com.au
--------------------------	--

Applicant(s):

Kallo Foods Limited	Postal : 2 River View, Meadows Business Park, Station Approach, Blackwater CAMBERLEY, SURREY GU17 9AB, , GB
---------------------	---

Contact Details: Corrs Chambers Westgarth, C/- Hudson Gavin Martin, PO Box 105900, Auckland City, Auckland 1010, NZ

Linked Cases:

Case Number	Case Type	Case Title	Submission Date	Case Status	Under Proceeding	Linked Label
35801	GR - IP Add / Change Agent	Request on International Registration 978647	30 Apr 2014	Validated	N/A	Case Maintenance

History:

Type	Description	Journal	Creation Date
International Registration renewed	NZ Designation renewed until 18 Jan 2022.	1712	17 Feb 2022
IP user in charge transferred	Case assigned from Charlotte Gair to Amy Boyes		19 Nov 2018
NZD Protected	International Registration Designating NZ protected.	1623	02 Sep 2014
NZD accepted	International Registration Designating NZ accepted.	1619	12 May 2014
TM Corrections of internal errors	Trade Mark Corrections of internal errors		12 May 2014
TM Corrections of internal errors	Trade Mark Corrections of internal errors		12 May 2014

Type	Description	Journal	Creation Date
Task routed to new user	Task Re-Examine NZD Application (Provisional Refusal) has been routed to Charlotte Gair		09 May 2014
Response to Provisional Refusal Report sent to IPONZ	Response to International Registration Provisional Refusal Report sent to IPONZ.		09 May 2014
Task transferred to new user	Task Respond to Provisional Refusal IR (NZD) Report has been routed from IPONZ Manual User to Tony Paton		30 Apr 2014
Agent changed	Agent changed from [nothing] to Corrs Chambers Westgarth		30 Apr 2014
Holder is replaced with new Holder as indicated in MECA Transaction	Full assignment of International Registration to Kallo Foods Limited, recorded in the International Register on 23/05/2013		05 Jul 2013
Task routed to new user	Task Examine WIPO Transaction (IR change request) has been routed to Charlotte Gair		05 Jul 2013
Task routed to new user	Task Respond to Provisional Refusal IR (NZD) Report has been routed to IPONZ		27 Jun 2013
Objections raised with no routing to QC	Provisional refusal sent to International Bureau.		27 Jun 2013
TM Corrections of internal errors	Trade Mark Corrections of internal errors		13 Jun 2013
Task routed to new user	Task Examine NZD Application (First Examination) has been routed to Charlotte Gair		07 Jun 2013
Primary examiner modified	Case assigned to Charlotte Gair		07 Jun 2013
Subsequent designation Received	Notification of Subsequent Designation received from WIPO on 6/06/2013. Notification recorded in the International Register on 24/05/2013, effective in the International Register on 8/05/2013, and officially received from WIPO on 6/06/2013.		07 Jun 2013

IP Number: 1137744
Client Reference:
Status: Protected
Mark Nature: Trade Mark
Mark Type: Combined
International number: 1505946

Submission Date: 26 Dec 2019
Filing Date: 25 Nov 2019
Registration Date: 25 Mar 2022
Under Proceeding: No

Mark Name: CLIPPER NATURAL, FAIR & DELICIOUS

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

Colour Claimed As A Distinctive Feature: Yes

Image:



Vienna Codes: 27.5.1, 29.1.12

Basic Mark:

Designated countries:

Nice Classification Schedule: 11

Classes and Specifications:

Class	Goods and Services Descriptions	Countries
30	Confectionery; ice cream; bread, biscuits, cakes, pastries, cookies; preparations for making the aforesaid goods; sugar, sugar cubes and sticks; sauces, spices.	

Priority:

Country	Priority Date	Priority Number	Class	Claims
United Kingdom	05 Aug 2019	UK00003419 050		

Seniority: None

Agent:

Spruson & Ferguson Pty Ltd	Physical : Level 24, Tower 2, Darling Park, 201 Sussex Street, Sydney 2000, AU Postal : GPO Box 3898, Sydney, NSW 2001, AU Service : PO Box 30461, Lower Hutt 5040, NZ Email Address: mail.au@spruson.com
----------------------------	--

Applicant(s):

Kallo Foods Limited	Postal : 2 River View, Meadows Business Park, Station Approach, Blackwater Camberley, Surrey GU17 9AB, , GB
---------------------	---

Linked Cases:

Case Number	Case Type	Case Title	Submission Date	Case Status	Under Proceeding	Linked Label
167426	GR - IP Extension of Time	Request on International Registration 1137744	13 Apr 2021	Validated	N/A	Extension of Time Request
161814	GR - IP Add / Change Agent	Request on International Registration 1137744	23 Dec 2020	Validated	N/A	Case Maintenance

History:

Type	Description	Journal	Creation Date
NZD Protected	International Registration Designating NZ protected.	1713	25 Mar 2022
NZD accepted	International Registration Designating NZ accepted.	1710	21 Dec 2021
TM Corrections of internal errors	Trade Mark Corrections of internal errors		21 Dec 2021
TM Corrections of internal errors	Trade Mark Corrections of internal errors		10 Dec 2021
Agent changed	Agent changed from Spruson & Ferguson Pty Ltd (ex Shelston IP) to Spruson & Ferguson Pty Ltd (ex Shelston IP) on GR case number 135208		01 Nov 2021
Task routed to new user	Task Re-Examine NZD has been routed to Vicki Fatu		05 Oct 2021
Task routed to new user	Task Respond to Subsequent IR (NZD) Report has been routed to SHELSTON IP PTY LTD		02 Jul 2021
Objections raised / maintained with no routing to QC	Objections raised or maintained during re-examination further to Response from Applicant		02 Jul 2021
Task routed to new user	Task Re-Examine NZD has been routed to Vicki Fatu		14 Jun 2021
Response to Provisional Refusal Report sent to IPONZ	Response to International Registration Provisional Refusal Report sent to IPONZ.		14 Jun 2021
A mark might be opposed even if accepted, after 18 months	Possible Opposition after 18 month limit notified to WIPO.		26 Apr 2021
Extension of time request granted	Extension of time request granted until 14 Jun 2021		13 Apr 2021
Task routed to new user	Task Respond to Subsequent IR (NZD) Report has been routed to SHELSTON IP PTY LTD		21 Jan 2021
Objections raised / maintained with no routing to QC	Objections raised or maintained during re-examination further to Response from Applicant		21 Jan 2021
TM Corrections of internal errors	Trade Mark Corrections of internal errors		21 Jan 2021

Type	Description	Journal	Creation Date
Task routed to new user	Task Re-Examine NZD has been routed to Vicki Fatu		23 Dec 2020
Response to Provisional Refusal Report sent to IPONZ	Response to International Registration Provisional Refusal Report sent to IPONZ.		23 Dec 2020
Task transferred to new user	Task Respond to Provisional Refusal IR (NZD) Report has been routed from IPONZ Manual User to SHELSTON IP PTY LTD		23 Dec 2020
Agent changed	Agent changed from [nothing] to Shelston IP Pty Ltd		23 Dec 2020
Change of name/address of WIPO Representative recorded in IR	Change of name/address of WIPO Representative recorded in the International Register on 21/02/2020		26 Mar 2020
Task routed to new user	Task Respond to Provisional Refusal IR (NZD) Report has been routed to IPONZ Manual User		24 Jan 2020
Objections raised with no routing to QC	Provisional refusal sent to International Bureau.		24 Jan 2020
Task routed to new user	Task Examine NZD has been routed to Vicki Fatu		07 Jan 2020
Primary examiner modified	Case assigned to Vicki Fatu		07 Jan 2020
International Registration initialised, BIRTH-ENN transaction	Notification of Designation received from WIPO on 26/12/2019. Notification recorded in the International Register on 11/12/2019, effective in the International Register on 25/11/2019, and officially received from WIPO on 26/12/2019.		27 Dec 2019

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.

NEW ZEALAND – SUBMITTED ELECTRONICALLY

SPRUSON & FERGUSON

To: **The Commissioner of Trade Marks**
Intellectual Property Office of New Zealand
PO Box 9241 Marion Square
Wellington 6141
NEW ZEALAND

Address for Service:
PO Box 30461
Lower Hutt
New Zealand
E-MAIL: mail.au@spruson.com

Correspondence Address:
GPO Box 3898
SYDNEY NSW 2001
AUSTRALIA
Phone: +61 2 9393 0100
Fax: +61 2 9261 5486

21 April, 2023

Our Ref: T0057409NZOP:DJW:DASPA

Dear Commissioner

New Zealand Trade Mark Application No 1189524 (IR 1613195)
THE 1872 CLIPPER TEA CO. in Class 30
NAVA 1872 PTE. LTD.
Opposition by Kallo Foods Limited

We lodge the following in relation to the above opposition:

1. Form 10 (Notice of Opposition)

Our address for service in New Zealand is PO Box 30461, Lower Hutt, NEW ZEALAND.

We look forward to receiving confirmation that the Commissioner has forwarded a copy of the Notice of Opposition to the applicant.

Yours faithfully

SPRUSON & FERGUSON



Danielle Spath
Registered Trade Mark Attorney
Associate
danielle.spath@spruson.com



Daniel J Wilson
Registered Trade Mark Attorney
Principal
daniel.wilson@spruson.com

FEE:

K150: Opposition: NZ\$350.00

TRADE MARKS ACT 2002

NOTICE OF OPPOSITION


Notice is hereby given by Kallo Foods Limited, 2 River View Meadows Business Park Station Approach, Blackwater Camberley Surrey GU17 9AB, United Kingdom (“**Opponent**”) that it opposes registration of trade mark application No 1189524 (IR 1613195) (“**Applicant’s Mark**”) by NAVA 1872 PTE. LTD. in relation to the following:

Class Goods

30 Tea; chai tea; iced tea; black tea; fruit tea; green tea; white tea; ginger tea; oolong tea; ginseng tea; jasmine tea; rooibos tea; aromatic tea; packaged tea; rose hip tea; chamomile tea; earl grey tea; fermented tea; peppermint tea; tieguanyin tea; theine-free tea; tea bags, filled; Japanese green tea; tea leaves, processed; flowers or leaves for use as tea substitutes; herbal tea, other than for medicinal use

The grounds of opposition are as follows:

1. Deception or Confusion – Section 17(1)(a)

1.1 The Opponent has adopted, is the proprietor of and/or has used in New Zealand either by itself or through its predecessors, authorised users, subsidiaries, affiliates or licensees, the trade marks CLIPPER,  and (“**Opponent’s Marks**”) in relation to the following goods:

Class 30: Beverages, tea and coffee; tea and coffee products; coffee beans; coffee substitutes; tea bags; fruit and herbal teas, fruit and herbal infusions; green tea; white tea; flavoured teas; iced tea; tea substitutes; instant coffee; ground coffee; chocolate and cocoa-based beverages; confectionery; chocolate based products; oat based food and drinks; malt based food and drinks; ice cream; bread, biscuits, cakes, pastries, cookies; preparations for making the aforesaid goods; muesli, sugar, sugar cubes and sticks; sauces, spices; flavourings, flavouring syrups, essences

(“**Opponent’s Goods**”)

1.2 The Opponent’s Marks were adopted in or around 1984 and have been used since that time. The date of first use of the Opponent’s Marks in New Zealand is at least as early as 2015. By virtue of such use, the Opponent is the owner at common law of the Opponent’s Mark in New Zealand for the Opponent’s Goods.

1.3 The Opponent and the Opponent’s Marks are well known internationally in relation to a wide variety of goods including those listed at paragraph 1.1. As a result, the Opponent’s Marks have acquired a reputation in New Zealand, which existed at the filing date of

application no. 1189524 (IR 1613195), and the Opponent's Marks are distinctive of the Opponent including at the filing date of application no. 1189524 (IR 1613195).

- 1.4 The Opponent's rights in the Opponent's Marks in relation to the Opponent's Goods predate the date of application no. 1189524 (IR 1613195) and predates the use by the Applicant of the Applicant's Trade Mark in relation to any goods.
- 1.5 Use by the Applicant in relation to any or all of the goods sought to be covered by the application is likely to cause a substantial number of persons to be deceived or confused. In particular, a substantial number of persons are likely to:
 - (a) be deceived into believing the Applicant's Goods marked or identified by the Applicant's Trade Mark are those of the Opponent, or are likely to otherwise confuse the Applicant's Goods with the Opponent's Goods;
 - (b) be deceived or otherwise confused as to the origin of the Applicant's Goods; and
 - (c) be deceived or confused into believing that the Applicant or Applicant's Goods are those of or are in some way associated with or connected with or sponsored, approved or endorsed by the Opponent.
 - (d) Accordingly, use of the Applicant's Trade Mark, filed in relation to the Goods of the application, would be likely to deceive or cause confusion, within the meaning of, and contrary to, Section 17(1)(a) of the Trade Marks Act 2002.
- 1.6 The Opponent and the Opponent's Mark are well known internationally, including in New Zealand, in relation to a wide variety of goods including the Opponent's Goods

2. Disentitled to Protection – Section 17(1)(b)

- 2.1 The Applicant's Trade Mark is disentitled to protection in a court of justice and accordingly registration of the Applicant's Trade Mark is not lawful under Section 17 (1)(b) of the Trade Marks Act 2002.
- 2.2 By virtue of its reputation based within New Zealand and internationally the Opponent has goodwill in the Opponent's Mark which is protected at common law.
- 2.3 Any use by the Applicant of the Applicant's Trade Mark would amount to engaging in conduct in the course of trade mark which is misleading and deceptive, in breach of the Fair Trading Act, 1996. Registration is therefore prohibited under
- 2.4 By reason of the above the Applicant's Trade Mark is disentitled to protection in a Court of Justice.



3. Bad Faith – Section 17(2)



- 3.1 The Applicant was aware at the time of filing application no. 1189524 (IR 1613195) of the Opponent's prior rights in New Zealand and internationally in the Opponent's Marks. It has chosen a mark which includes the Opponent's well-known trade mark as the

essential element of the mark. The Applicant was aware at the time of filing application no. 1189524 (IR 1613195) that it was not entitled to seek registration of the Applicant's Mark.

3.2 Application for registration of the Applicant's Trade Mark is made in bad faith.

4. **Identical or Similar trade mark – Section 25**

4.1 The Applicant's Mark is identical or similar to the Opponent's Marks registered under Nos 978647 (IR 1113470),  and 1137744 (IR 1505946)  in Class 30, in respect of the same or similar goods, and use of the Applicant's Mark is likely to deceive or cause confusion. Both of the Opponent's Registered Marks predate the filing or priority date of application no. 1189524 (IR 1613195). The Applicant's Mark is therefore not registrable under Section 25(1)(a) of the Act.

4.2 The Applicant's Mark is similar to the Opponent's Marks registered under Nos 978647 (IR 1113470),  and 1137744 (IR 1505946)  in Class 30, in respect of the same or similar goods, and use of the Applicant's Mark is likely to deceive or cause confusion. Both of the Opponent's Registered Marks predate the filing or priority date of application no. application no. 1189524 (IR 1613195). The Applicant's Mark is therefore not registrable under Section 25(1)(b) of the Act.

4.3 The Applicant's Mark 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, whether through advertising or otherwise, in respect of the Applicant's goods or similar goods or services, and use of the Applicant's Mark would be taken as indicating a connection in the course of trade between those goods and the Opponent, and would be likely to prejudice the interests of the Opponent. The Applicant's mark is therefore not registrable under Section 25(1)(c) of the Act.

4.4 The Applicant cannot claim to be, and is not the proprietor of the Applicant's Trade Mark and the claim by the Applicant continues to be an improper claim.

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 evidence is hereby given), at the discretion of the Commissioner and in the public interest, registration of the Applicant's Trade Mark should be refused.

5.2 The relief sought by the Opponent is:

- (a) Refusal of the Application;
- (b) Such further and other relief as the Commissioner might think just; and

(c) Costs.

Our address for service in New Zealand is Spruson & Ferguson, PO Box 30461, Lower Hutt, NEW ZEALAND.

Please send all correspondence to our agent: Spruson & Ferguson, GPO Box 3898, Sydney NSW 2001, Australia – SF Ref: T0057409NZOP:DJW:DASPA (Phone: +61 2 9393 0100, Fax: +61 2 9261 5486, Email: mail.au@spruson.com).

DATED this twenty-first Day of April, 2023

Kallo Foods Limited

By:



Danielle Spath
Registered Trade Mark Attorney



Daniel J Wilson
Registered Trade Mark Attorney

To: The Commissioner of Trade Marks, NEW ZEALAND