

## MADRID PROTOCOL AND AGREEMENT

### PROVISIONAL REFUSAL

Rule 17.1)

I.	Sending OFFICE : <b>Intellectual Property Office of New Zealand</b>
II.	International registration number : <b>1261461</b>  New Zealand trade mark number : <b>1026084</b>
III.	Holder: <b>SWATCH AG (SWATCH SA) (SWATCH LTD)</b>
IV.	Mark Reproduction : <b>ONE MORE THING</b>
V.	Provisional refusal based on an office check.
VI.	Official sign or seal of sending office :  Intellectual Property Office of New Zealand   <b>NEW ZEALAND INTELLECTUAL PROPERTY OFFICE</b>
VII.	Date : <b>28/01/2016</b>

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

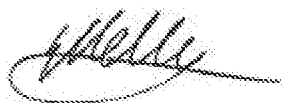
1.	<b>Office making the notification:</b> Intellectual Property Office of New Zealand
2.	<b>Date of the notification of provisional refusal:</b> 27 January 2016
3.	<b>Number of the international registration:</b> 1261461
4.	<b>Our reference:</b> NZ IP 1026084 - 2835
5.	<b>Representation of the mark:</b> ONE MORE THING
6.	<b>Name of the holder:</b> SWATCH AG (SWATCH SA) (SWATCH LTD)
7.	<b>Basis for refusal:</b> Provisional refusal based on an opposition
8.	<b>Name and address of the opponent:</b>  Apple Inc. 1 Infinite Loop Cupertino California 95014 United States of America
9.	<b>Scope of this refusal:</b> Provisional refusal for all the goods and/or services.
10.	<b>Grounds for refusal:</b>  See attached Notice of Opposition.
11.	<b>Information relating to an earlier mark:</b>  See attached print-out from the New Zealand trade marks register.
12.	<b>Information relating to subsequent procedure:</b>  <u><b>Responding to this refusal</b></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 and the response must be filed using the Commissioner's website at <a href="http://www.iponz.govt.nz">www.iponz.govt.nz</a> .

**Timeframe for responding**

If the Holder does not respond by filing a counterstatement by **27 March 2016**, this refusal becomes final for the specified goods and/or services.

**13. Signature by the Office:**

Intellectual Property Office of New Zealand



Emma Kelly

+64 4 896 5523

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: 27 Jan 2016 08:53:16 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:** 1026084

**Client Reference:** M.20203

**Status:** Accepted

**Mark Nature:** Trade Mark

**Mark Type:** Word

**International number:** 1261461

**Mark Name:** ONE MORE THING

**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:** Yes

**Consists of Colour:** No

**Submission Date:** 20 Aug 2015

**Filing Date:** 22 May 2015

**Under Proceeding:** Yes

**Basic Mark:**

**Designated countries:**

**Nice Classification Schedule:** 10

## Classes and Specifications:

Class	Goods and Services Descriptions	Countries
9	Apparatus for recording, transmission and reproduction of sound or images; electronic payment processing apparatus, apparatus for processing cashless payment transactions; magnetic recording media, sound recording disks; compact disks, DVDs and other digital recording media; apparatus enabling the playing of compressed sound files (MP3); calculating machines and data processing equipment, software; game software for mobile telephones, for computers and for digital personal stereos; electronic game software for mobile telephones, for computers and for digital personal stereos; computers, portable computers, handheld computers, mobile computers, personal computers, wrist computers, electronic tablets and computerized and mobile devices, digital personal stereos, mobile telephones and new-generation mobile telephones featuring greater functionality (smartphones); telecommunication apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images, particularly mobile telephones and new-generation mobile telephones incorporating greater functionality (smartphones); hand-held electronic apparatus for accessing the Internet and sending, receiving, recording and storing short messages, electronic messages, telephone calls, faxes, video conferences, images, sound, music, text	

Class	Goods and Services Descriptions	Countries
	and other digital data; handheld electronic apparatus for wireless receiving, storing and transmitting of data or messages; handheld electronic apparatus for monitoring and organizing personal information; handheld electronic apparatus for global positioning [GPS] and displaying maps and transport information; handheld electronic devices for detecting, monitoring, storing, surveillance and transmitting data relating to the user activity, namely position, itinerary, distance traveled, heart rate; covers for computers, portable and mobile telephones; optical apparatus and instruments, particularly spectacles, sunglasses, magnifying glasses; cases for spectacles, magnifying glasses and sunglasses; batteries and cells for computers and electronic and chronometric apparatus.	
14	Precious metals and their alloys and goods made of these materials or coated therewith included in this class, namely figurines, trophies; jewelry, namely rings, earrings, cufflinks, bracelets, charms, brooches, chains, necklaces, tie pins, tie clips, jewelry caskets, jewelry cases; precious stones, semi-precious stones; timepieces and chronometric instruments, namely chronometers, chronographs, clocks, watches, wristwatches, wall clocks, alarm clocks as well as parts and accessories for the aforesaid goods, namely hands, anchors, pendulums, barrels, watch cases, watch straps, watch dials, clockworks, watch chains, movements for timepieces, watch springs, watch glasses, presentation cases for timepieces, cases for timepieces.	

**Priority :**

Country	Priority Date	Priority Number	Class	Claims
Switzerland	27 Nov 2014	670301		

**Seniority :** None

**Applicant(s) :**

SWATCH AG (SWATCH SA) (SWATCH LTD)	Physical : Jakob-Stämpfli-Strasse 94, CH-2502 Biel/Bienne, CH Postal : Jakob-Stämpfli-Strasse 94, CH-2502 Biel/Bienne, CH
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**Contact Details :** The Swatch Group SA (The Swatch Group AG) (The Swatch Group Ltd.), 6, Faubourg du Lac, CH-2501 Biel/Bienne, CH

**Linked Cases:**

Case Number	Case Type	Case Title	Submission Date	Case Status	Under Proceeding	Linked Label
2835	Proceedings - NZD Opposition	Request on International Registration on 1026084	22 Dec 2015	In Progress	N/A	Proceedings - NZD Opposition

**History:**

Type	Description	Journal	Creation Date
Possible Opposition Lodged	Possible Opposition Lodged by Apple Inc.		22 Dec 2015
NZD accepted	International Registration Designating NZ accepted.	1635	10 Sep 2015
Task routed to new user	Task Examine NZD has been routed to Charlotte Gair		21 Aug 2015
Primary examiner modified	Case assigned to Charlotte Gair		21 Aug 2015
International Registration initialised, BIRTH-ENN transaction	Notification of Designation received from WIPO on 20/08/2015. Notification recorded in the International Register on 4/08/2015, effective in the International Register on 22/05/2015, and officially received from WIPO on 20/08/2015.		21 Aug 2015

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## NOTICE OF OPPOSITION

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### Details of the trade mark(s) to be opposed

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1. Trade mark number(s)	1026084
2. Trade mark(s)	ONE MORE THING

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### Opponent details

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3. Name of the opponent	Apple Inc.
4. Address for service of the opponent	PO Box 356 119-125 Willis Street Wellington NEW ZEALAND
5. Name of the opponent's authorised agent	Henry Hughes

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### Details of the opposition

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6. State the grounds of opposition.	<p>1. <u>Section 17(1)(a)</u>:</p> <p>The use of the trade mark for which registration is sought under Application No. 1026084 ("the Trade Mark") would be likely to deceive or cause confusion. (Continued on separate sheet.)</p> <p>2. <u>Section 17(1)(b)</u>:</p> <p>Use of the Trade Mark is contrary to New Zealand law or would otherwise be disentitled to protection in any court.</p> <p>Use of the Trade Mark in relation to the goods for which registration is sought ("the Specified Goods") would constitute passing off, and contravene the prohibitions in sections 9, 10 and 13 of the Fair Trading Act 1986. (Continued on separate sheet.)</p> <p>3. <u>Section 17(2)</u>:</p> <p>The application to register the Trade Mark was made in bad faith. (Continued on a separate sheet.)</p>
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	<p>4. <u>Section 25(1)(c)</u></p> <p>The Trade Mark is identical to a trade mark that is well known in New Zealand (ONE MORE THING), whether through advertising or otherwise, in respect of goods that are the same as or similar to the Specified Goods ... and the use of the Trade Mark ... and would be likely to prejudice the interests of the opponent. (Continued on separate sheet.)</p>
<p>7. List the class(es) and goods and/or services to which this opposition relates.</p>	
CLASS	GOODS/SERVICES
9	<p>Apparatus for recording, transmission and reproduction of sound or images; electronic payment processing apparatus, apparatus for processing cashless payment transactions; magnetic recording media, sound recording disks; compact disks, DVDs and other digital recording media; apparatus enabling the playing of compressed sound files (MP3); calculating machines and data processing equipment, software; game software for mobile telephones, for computers and for digital personal stereos; electronic game software for mobile telephones, for computers and for digital personal stereos; computers, portable computers, handheld computers, mobile computers, personal computers, wrist computers, electronic tablets and computerized and mobile devices, digital personal stereos, mobile telephones and new-generation mobile telephones featuring greater functionality (smartphones); telecommunication apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images, particularly mobile telephones and new-generation mobile telephones incorporating greater functionality (smartphones); hand-held electronic apparatus for accessing the Internet and sending, receiving, recording and storing short messages, electronic messages, telephone calls, faxes, video conferences, images, sound, music, text and other digital data; handheld electronic apparatus for wireless receiving, storing and transmitting of data or messages; handheld electronic apparatus for monitoring and organizing personal information; handheld electronic apparatus for global positioning [GPS] and displaying maps and transport information; handheld electronic devices for detecting, monitoring, storing, surveillance and transmitting data relating to the user activity, namely position, itinerary, distance traveled, heart rate; covers for computers, portable and mobile telephones; optical apparatus and instruments, particularly spectacles, sunglasses, magnifying glasses; cases for spectacles, magnifying glasses and sunglasses; batteries and cells for computers and electronic and chronometric apparatus.</p>
14	<p>Precious metals and their alloys and goods made of these materials or coated therewith included in this class, namely figurines, trophies; jewelry, namely rings, earrings, cufflinks, bracelets, charms, brooches, chains, necklaces, tie pins, tie clips, jewelry caskets, jewelry cases; precious stones, semi-precious stones; timepieces and chronometric instruments, namely chronometers, chronographs, clocks, watches, wristwatches, wall clocks, alarm clocks as well as parts and accessories for the aforesaid goods, namely hands, anchors, pendulums, barrels, watch cases, watch straps, watch dials, clockworks, watch chains, movements for timepieces, watch springs, watch glasses, presentation cases for timepieces, cases for timepieces.</p>

**Form 10**

8. Relief Sought.

- (a) refusal of Application No. 1026084;
- (b) such further and other relief as the Commissioner may think just; and
- (c) the opponent's costs in this matter.

Signature of the application or authorised agent:

*Barbara Sullivan*

Date: 26 January 2016

Please return form by mail to:

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

**Contact Telephone No:** 04 381 6050

**Contact Email Address:**

[b.sullivan@henryhughes.co.nz](mailto:b.sullivan@henryhughes.co.nz)

## Form 10

### Section 17(1)(a)

1. Use of the Trade Mark would be likely to deceive or cause confusion.
2. The opponent has used the trade mark/slogan ONE MORE THING extensively throughout the world since at least 1988 in relation to computers, mobile digital devices, accessories, and related goods and services and in relation to watches since 2014. The opponent's founder and former CEO – Steve Jobs - was famous for using the phrase "One More Thing" when introducing the last (and usually the most important) new developments of the opponent's product introductions. This tradition has been continued by the present CEO of the opponent – Tim Cook.
3. As a result of these activities, the opponent has built up a valuable goodwill and reputation in the opponent's trade mark and the slogan, which has come to be associated exclusively with the opponent and its goods.
4. The Trade Mark is the same as the opponent's trade mark. The Specified Goods are the same as or similar to those goods and/or services in relation to which the opponent has used and continues to use the trade mark/slogan ONE MORE THING.
5. By reason of the above-mentioned facts, use of the Trade Mark would be likely to deceive or cause confusion, as members of the public would be led to believe that or wonder whether the Specified Goods are those of the opponent, and/or that the applicant and/or the Specified Goods are in some way associated with the opponent, or are sponsored, endorsed or approved by the opponent.

### Section 17(1)(b)

6. Use of the Trade Mark is contrary to New Zealand law or would otherwise be disentitled to protection in any court.
7. By reason of the above-mentioned facts, use of the Trade Mark in relation to the Specified Goods would constitute passing off; would contravene the prohibitions in sections 9, 10 and 13 of the Fair Trading Act 1986; and would constitute trade mark infringement within the meaning of section 89(1) of the Trade Marks Act 2002.

### *Passing Off*

8. Use of the Trade Mark in relation to the Specified Goods constitutes a misrepresentation in the course of trade to prospective or existing customers of the opponent that the Specified Goods are those of the opponent, or that the applicant and/or the Specified Goods of the applicant are in some way associated with, or are sponsored, endorsed or approved by, the opponent.
9. The opponent has suffered or is likely to suffer damage as a consequence, including damage to its goodwill and reputation and/or erosion of the distinctiveness of the opponent's trade mark and slogan ONE MORE THING.

### *Fair Trading Act*

10. Use of the Trade Mark in relation to the Specified Goods is:

## Form 10

- i) misleading or deceptive conduct or is conduct which is likely to mislead or deceive, in breach of sections 9 and 10 of the Fair Trading Act 1986;
- ii) a false or misleading representation that the applicant and/or the Specified Goods of the applicant are sponsored or endorsed by, or affiliated with the opponent, in breach of section 13 of the Fair Trading Act 1986.

### Section 17(2)

- 11. The application to register the Trade Mark was made in bad faith.
- 12. By reason of the facts set out in paragraphs 1, 2, 3 and 4 above: the applicant has made a wrongful claim to ownership of the Trade Mark, as ONE MORE THING is well known as being the trade mark and slogan of the opponent.
- 13. At the date of its application, the applicant did not have an intention to make genuine use of the Trade Mark in New Zealand in relation to all of the Specified Goods. The Specified Goods are very board. An intention to use the Trade Mark in relation to all of the Specified Goods is not supported by the applicant's website or enquiries made in relation to the applicant's business.
- 14. The application has been made with the sole purpose of preventing or deterring the opponent from using its trade mark and slogan ONE MORE THING.

### Section 25(1)(c)

- 15. By reason of the facts set out in paragraph 1 above, the opponent's trade mark and slogan ONE MORE THING is well known in New Zealand.
- 16. Trade Mark is identical to the opponent's trade mark and slogan ONE MORE THING.
- 17. Use of the Trade Mark in relation to all or any of the Specified Goods would be likely to prejudice the interests of the opponent.