

## 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>1269362</b>  New Zealand trade mark number : <b>1029837</b>
III.	Holder: <b>"VINPROM PESHTERA" S.A.</b>
IV.	Mark Reproduction : <b>SENSE</b>
V.	Provisional refusal based on an office check.
VI.	Official sign or seal of sending office :  Intellectual Property Office of New Zealand   <p><b>NEW ZEALAND INTELLECTUAL PROPERTY OFFICE</b></p>
VII.	Date : <b>25/02/2016</b>

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

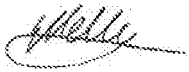
1.	<b>Office making the notification:</b> Intellectual Property Office of New Zealand
2.	<b>Date of the notification of provisional refusal:</b> 24 February 2016
3.	<b>Number of the international registration:</b> 1269362
4.	<b>Our reference:</b> NZ IP 1029837 - 2921
5.	<b>Representation of the mark:</b> SENSE
6.	<b>Name of the holder:</b> "VINPROM PESHTERA" S.A.
7.	<b>Basis for refusal:</b> Provisional refusal based on an opposition
8.	<b>Name and address of the opponent:</b>  Sensi Vigne & Vini S.R.L Via Ceraia, 107 Frazione Cerbaia Lamporecchio (PT) I-51035 Italy
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 **25 April 2016**, this refusal becomes final for the specified goods and/or services.

**13. Signature by the Office:**

Intellectual Property Office of New Zealand



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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.

**NEW ZEALAND**

**TRADE MARKS ACT 2002**

**Section 47, Regulation Nos 73, 74 and 75**

**NOTICE OF OPPOSITION**

<b>Trade Mark Details</b>	New Zealand Application No 1029837 International Registration No 1269362 SENSE class 33
<b>Applicant's Name</b>	"VINPROM PESHTERA" S.A.
<b>Opponents Name</b>	Sensi Vigne & Vini S.R.L
<b>Opponents Address</b>	Via Cerbaia, 107 Frazione Cerbaia I- 51035 Lamprecchio (PT) ITALY
<b>Opponents Address for Service</b>	PO Box 2616 Wellington, Wellington 6140, New Zealand
<b>Opponents Correspondence Address</b>	PO Box 833 Blackwood, South Australia 5062
<b>Opponent's agent's name</b>	A.P.T. Patent and Trade Mark Attorneys
<b>Opponents email address</b>	apt@aptpat.com

The Intellectual Property Office advertised acceptance of the application on 30 October 2015.

The prescribed fee of \$350.00 accompanies this notice

The Opposition relates to all of the goods covered by the application.  
GROUNDS

## ABSOLUTE GROUND FOR NOT REGISTERING TRADE MARK

### **1. Use Likely to Cause Deception or Confusion**

- 1.1 By reason of the Opponent's use (and/or use by the Opponent's predecessor in title) of the trade mark SENSI ("SENSI Trade Mark"), the Opponent has established reputation and goodwill in the SENSI Trade Mark and is the owner of the SENSI Trade Mark in New Zealand for goods the same as or similar to the goods covered by the Application.
- 1.2 The Applicant has applied for the trade mark SENSE ("Applicant's Mark") in respect of the "Alcoholic beverages (except beers), including alcoholic energy drinks" (Applicant's goods").
- 1.3 By reason of the use and the reputation of the SENSI Trade Mark, use of the Applicant's Mark by the Applicant in relation to any, some or all of the Applicant's goods is likely to cause deception or confusion as to the origin of the Applicant's goods and so be contrary to Section 17(1)(a) of the Trade Marks Act 2002.
- 1.4 By reason of a meaning or connotation that the Applicant's Mark has, its use in relation to any, some or all of the Applicant's goods would be likely to deceive or cause confusion and be contrary to Section 17(1)(a) of the Trade Marks Act 2002.

### **2. Contrary to Law: Fair Trading Act 1986**

- 2.1 By reason of the use and the reputation of the SENSI Trade Mark, use of the Applicant's Mark by the Applicant in relation to any, some of or all of the Applicant's goods would amount to engaging in conduct in the course of trade that is misleading or deceptive or likely to mislead or deceive.
- 2.2 Use of Applicant's Mark by the Applicant is contrary to New Zealand law and contrary to Section 17(1)(b) of the Trade Marks Act 2002, and such use would be contrary to provisions of the Fair Trading Act 1986.

### **3. Contrary to Law: Passing Off**

3.1 By reason of the use and the reputation of the SENSI Trade Mark, use of the Applicant's Mark in relation to any, some or all of the Applicant's goods would constitute a misrepresentation made in the course of trade to prospective or actual consumers including a misrepresentation that:

- (a) the Applicant's goods are the Opponent's goods, or are sourced from the Opponent;
- (b) there is some form of business association or connection between the Applicant and the Opponent, or that the Applicant has the Opponent's sponsorship, approval, endorsement, or affiliation; and/or
- (c) the Applicant has been licensed by the Opponent to use the Applicant's Mark in relation to the Applicant's goods.

3.2 Use of Applicant's Mark by the Applicant in relation to any, some or all of the Applicant's goods is likely to cause damage to the business and goodwill of the Opponent in New Zealand. Such damage includes the following:

- (a) damage to goodwill and reputation through mistaken association; and/or
- (b) dilution of the distinctiveness and goodwill of the SENSI Trade Mark.

3.3 Use of the Applicant's Mark by the Applicant in relation to any, some or all of the Applicant's goods would be contrary to New Zealand Law and contrary to Section 1791(b) of the Trade Marks Act 2002, as such use amount to passing off at common law.

### **4. Bad Faith**

4.1 By reason of the use and the reputation of the SENSI Trade Mark, use and intended use of the Applicant's Mark by the Applicant in relation to any, some or all of the Applicant's goods amount to an application made in bad faith contrary to Section 17(2) of the Trade Marks Act 2002.

### **RELATIVE GROUNDS FOR NOT REGISTERING TRADE MARK**

**5. Deception or Confusion with Registered Trade Mark.**

5.1 The Opponent is the proprietor of the following trade mark registrations in New Zealand:

Number	Mark	Class	Goods/Services
982491	SENSI	33	Spirits, wines.
1012436	18 K SENSI	33	Wines; aperitifs, sparkling wines, spirits and liqueurs; except beer.

## 5.2 The Application

(a) relates to goods identical with or similar to the goods covered by the Opponent's Registrations

(b) relates to a similar trade mark to the Opponent's Registrations.

5.3 Use of the Applicant's Trade Mark by the Applicant in relation to the goods sought to be covered by the application is likely to deceive or cause confusion.

5.4 Accordingly, registration by the Applicant would be contrary to Section 25(1)(b) of the Trade Marks Act 2002.

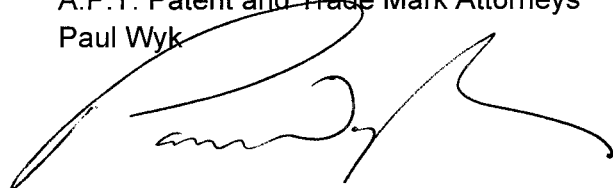
## 6. Orders Sought

1. Refusal of the Application;
2. such further and other relief that may be just; and
3. the Opponent's cost in this matter.

Dated 24th February 2015

Signed by the opponent by its agent

A.P.T. Patent and Trade Mark Attorneys  
Paul Wyk



To the Commissioner of Trade Marks  
Lower Hutt, New Zealand